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Case No: HC05C02965

IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION

Royal Courts of Justice
Strand, London, WC2A 2LL
Date: 18 October 2007

Before :
MR ROGER WYAND QC
(sitting as a Deputy High Court Judge)

Between :

JULES RIMET CUP	
LIMITED	<u>Claimant</u>
- and -	
THE FOOTBALL ASSOCIATION	
LIMITED	<u>Defendant</u>

MR. HUGO CUDDIGAN (instructed by BRIFFA) appeared for the Claimant.
MR. MADELEINE HEAL and MR. STEVEN REED (instructed by ADDLESHAW
GODDARD) appeared for the Defendant.

Hearing dates: 18, 19, 20, 21 and 26 June 2007

Approved Judgment

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic

Mr. Roger Wyand QC

1. This is the trial of a preliminary issue pursuant to the Order of Mr Justice Mann of 11 August 2006 whereby he ordered that the intellectual property issues in this action be determined as a preliminary issue. The action arises out of a dispute concerning the ownership of rights in the trade mark WORLD CUP WILLIE and a device consisting of a cartoon type lion dressed in the England football strip.
2. The Claimant, Jules Rimet Cup Limited (“JRCL”) applied to register the words WORLD CUP WILLIE on their own and the lion device together with the words WORLD CUP WILLIE as trade marks in respect of a range of goods. The dates of the applications were 23 May 2005 and 25 February 2005 respectively.
3. When the Defendant, the Football Association Limited (“the FA”), became aware of those applications they indicated an intention to oppose them if they were not withdrawn. WORLD CUP WILLIE was the name of the mascot for the 1966 World Cup hosted in England by the FA. The mascot was a cartoon type lion dressed in a Union Flag shirt and white trousers. The FA informed at least one party that had entered into a licence agreement with JRCL that they had good grounds for opposing the trade marks and, it is alleged, threatened legal proceedings. This is alleged to have caused that party to terminate its agreement with JRCL.
4. JRCL launched these proceedings on 26 October 2005 seeking, inter alia, declarations that the two trade mark applications cannot be opposed successfully on the grounds contended for by the FA and relief for unlawful interference with the business of JRCL.
5. The FA counterclaimed alleging that it is the owner of the copyright in a drawing of the original WORLD CUP WILLIE mascot and that JRCL had infringed the copyright in that drawing through its use of the device mark. The FA also alleged that it owned the goodwill in the drawing of the 1966 mascot and in the name WORLD CUP WILLIE and that JRCL had passed itself off as the FA or a business connected with the FA. The FA said that the two trade mark applications should be refused on that ground, under section 5(4)(a) of the Trade Marks Act 1994 (TMA 1994) and also on the ground that the applications were made in bad faith under section 3(6) of the TMA 1994.
6. On the first day of the hearing before me Ms Heal, appearing for the FA, applied for permission to introduce evidence relating to a market survey that had been carried out in April and May of this year on two weekends at in excess of 40 football grounds around the country. Some 950 respondents were interviewed. Mr Cuddigan, appearing for JRCL, resisted the application. For reasons which are set out in my separate judgment given on the second day of the hearing, I refused that application and the hearing carried on without the evidence of that survey.
7. Unfortunately, no attempt was made to agree what the “intellectual property issues” in this action were before this hearing. As a result, some of the issues developed during the course of the hearing. However, in his opening skeleton, Mr Cuddigan identified the following issues which essentially cover all the relevant points to be determined:
 - i. Who owns the copyright in the original WORLD CUP WILLIE drawing;
 - ii. What is the effect of section 52 of the Copyright Designs and Patents Act 1988(“CDPA”);

- iii. Was the device mark copied from the original WORLD CUP WILLIE drawing;
 - iv. Is the device mark substantially similar to the WORLD CUP WILLIE drawing;
 - v. Has JRCL infringed copyright;
 - vi. Did the FA own any goodwill that accrued from use of the WORLD CUP WILLIE drawing in 1966/1970;
 - vii. Has any goodwill that the FA owned been abandoned since 1970;
 - viii. Was any such goodwill that remained and was owned by D sufficient for a passing off action in 2005;
 - ix. Would the fair use of the device mark and the word mark across the specifications applied for constitute passing off;
 - x. Has JRCL carried out any other acts of passing off;
 - xi. Can the FA rely upon section 56 of the TMA and if so is the WORLD CUP WILLIE drawing of the name WORLD CUP WILLIE a “well known mark”;
 - xii. Were the trade mark applications made by JRCL in bad faith
8. I shall deal with these issues in turn

Who owns the copyright in the original WORLD CUP WILLIE drawing

9. The FA obtained a vesting order on 8th June 2007 and there is now no dispute that the FA owns the copyright in the original WORLD CUP WILLIE drawing relied on. The vesting order does not give the FA any title to accrued rights of action. It should be noted that although there were a number of drawings depicting WORLD CUP WILLIE in different poses, the FA has only asserted one of these drawings against JRCL in this action and that is the drawing of WORLD CUP WILLIE in the act of kicking a football.
10. The FA relies on the copyright in this original WORLD CUP WILLIE drawing in two ways. Firstly, the FA relies on an allegation that the use of the device mark applied for by JRCL would infringe the FA’s copyright in the drawing. Secondly, the FA has counterclaimed for infringement of the copyright in the drawing.
11. Although the lack of the accrued rights would prevent the recovery of damages for past acts of infringement the copyright could prevent registration of the device mark and could entitle the FA to an injunction to prevent infringement.

What is the effect of section 52 of the CDPA

12. Section 52 of the CDPA provides:

(1) this section applies where an artistic work has been exploited , by or with the licence of the copyright owner, by-

(a) making by an industrial process articles falling to be treated for the purposes of this Part as copies of the work, and

(b) marketing of such articles, in the United Kingdom or elsewhere.

(2) After the end of the period of 25 years from the end of the calendar year in which such articles are first marketed, the work may be copied by making articles of any

description, or doing anything for the purpose of making articles of any description, and anything may be done in relation to articles so made without infringing copyright in the work.

...

(4) The Secretary of State may by order make provision-

...

(b) excluding from the operation of this section such articles of a primarily literary or artistic character as he thinks fit.

...

(6) In this section-

(a) references to articles do not include films; and

(b) references to the marketing of an article are to its being sold or let for hire or offered or exposed for sale or hire.”

13. The Secretary of State exercised the power to make provision given by section 52(4). Article 3 of the Copyright (Industrial Process and Excluded Articles) (No. 2) Order 1989 provides:

(1) There are excluded from the operation of section 52 of the Act-

(a) works of sculpture, other than casts or models used or intended to be used as models or patterns to be multiplied by an industrial process;

(b) wall plaques, medals and medallions; and

(c) printed matter primarily of a literary or artistic character, including book jackets, calendars, certificates, coupons, dress making patterns, greetings cards, labels, leaflets, maps, plans, playing cards, postcards, stamps, trade advertisements, trade forms and cards, transfers and similar articles.

14. Paragraph 20 of Schedule 1 to the CDPA provides:

(1) Where section 10 of the 1956 Act (effect of industrial application of design corresponding to artistic work) applied in relation to an artistic work at any time before commencement, section 52(2) of this Act applies with the substitution for the period of 25 years mentioned there of the relevant period of 15 years as defined in section 10(3) of the 1956 Act.

(2) Except as provided in sub-paragraph (1), section 52 applies only where articles are marketed as mentioned in subsection (1)(b) after commencement.

15. Section 10 of the 1956 Copyright Act, after amendment by the Design Copyright Act 1968¹, provides:

(2) Where copyright subsists in an artistic work, and-

¹ Neither side relied on any difference between the amended and the unamended section 10.

(a) a corresponding design is applied industrially by or with the licence of the owner of the copyright in the work, and

(b) articles to which the design has been so applied are sold, let for hire, or offered for sale or hire whether in the United Kingdom or elsewhere the following provisions of this section shall apply.

(3) Subject to the next following subsection, after the end of the relevant period of fifteen years it shall not be an infringement of the copyright in the work to do anything which at the time when it was done would, if a corresponding design had been registered under the Registered Designs Act 1949 (in this section referred to as “the Act of 1949”) immediately before that time, have been within the scope of the copyright in the design as extended to all associated designs and articles.

In this subsection “the relevant period of fifteen years” means the period of fifteen years beginning with the date on which articles, such as are mentioned in paragraph (b) of the last preceding subsection, were first sold, let for hire or offered for sale or hire, whether in the United Kingdom or elsewhere.

(4) For the purposes of subsection (2) and (3) of this section, no account shall be taken of any articles in respect of which, at the time when they were sold, let for hire, or offered for sale or hire, the design in question was excluded from registration under the Act of 1949 by rules made under subsection (4) of section one of that Act (which relates to the exclusion of designs for articles which are primarily literary or artistic in character);

(5) The power of the Board of Trade to make rules under section thirty six of the Act of 1949 shall include power to make rules for the purposes of this section for determining the circumstances in which a design is to be taken to be applied industrially.

(6) In this section, references to the scope of the copyright in a registered design are references to the aggregate of the things, which, by virtue of section seven of the Act of 1949, the registered proprietor of the design has the exclusive right to do, and references to the scope of the copyright in a registered design as extended to all associated designs and articles are references to the aggregate of the things which, by virtue of that section, the registered proprietor would have had the exclusive right to do if-

(a) when that design was registered, there had at the same time been registered every possible design consisting of that design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, and the said proprietor had been registered as the proprietor of every such design, and

(b) the design in question, and every other design such as is mentioned in the preceding paragraph, had been registered in respect of all the articles to which it was capable of being applied.

(7) In this section “corresponding design”, in relation to an artistic work, means a design which when applied to an article results in a reproduction of that work.

16. Subsection 4 of section 10 above removes from consideration any articles in respect of which the design in question was excluded from registration under the Act of 1949 by rules made under subsection 4 of section 1 of that Act.
17. Rules made under the power provided by subsection 5 of section 10 defined the circumstances in which a design is to be taken to be applied industrially as when more than 50 copies are made and they are manufactured in lengths or pieces, not being hand made goods.
18. JRCL rely on the fact that the FA are relying in their case of passing off, inter alia, on the commercialisation of the World Cup Willie character by the use of the World Cup Willie drawing in newspapers, on postcards, stickers and posters “and on numerous other souvenir articles”. This commercialisation took place in 1966. They argue that the effect of such commercialisation is to provide a defence to an action for infringement of the copyright in the original World Cup Willie drawing.
19. Mr Cuddigan argues that by reason of this commercialisation section 10 of the 1956 Act applied to the World Cup Willie drawing and therefore section 52(2) of the CDPA applies with the period of fifteen years rather than the twenty five year period. He submits that the fact of industrial application of the drawing to **any** articles which are not removed from consideration by subsection 4 of section 10 (or article 3 of the Copyright (Industrial Process and Excluded Articles) (No2) Order) has the effect, once fifteen years have passed since the date of the first sale of such articles, that it is not an infringement of the copyright in the drawing to apply the design in the drawing to any article, regardless of whether the article is one excluded from consideration by the above provisions.
20. He relies on the fact that the exclusion in subsection 4 of section 10 applies to **articles** and not to **designs**. On the basis of this distinction he submits: “*Accordingly, where the design for articles has been applied industrially and such articles have been sold, and designs for that genre of articles were registrable (i.e. not excluded from registration by the rules), the restricted protection scheme applies.*”
21. The FA counter this with two arguments. Firstly, they say that JRCL have not established that the particular artistic work relied on was applied to articles that fall within the operation of section 52 or that those articles were made by an industrial process. They say that the onus is on JRCL and they have failed to satisfy it. Secondly, they say that if section 52 does apply, it does not have the effect argued for by JRCL.
22. So far as the first of these arguments is concerned I am satisfied on the balance of probabilities that the drawing was applied to articles which fall within the operation of section 52 by reason of their being caught by section 10 of the 1956 Act. The FA has produced newspaper cuttings which show a wide range of articles which were not excluded from registration under the Registered Designs Act 1949. For those articles to be made by “an industrial process” the requirements are the same as under the 1956 Act, namely that more than fifty must have been made and they are not hand made goods. It is implicit in the FA’s allegations of passing off that more than fifty of each such article was made and they are not hand made. I reject the argument that JRCL has failed to establish the necessary facts and I hold that section 52 does apply to the original World Cup Willie drawing.

23. So far as the second argument is concerned I believe that the FA is correct. Section 10 of the 1956 Act applied in relation to the original drawing of World Cup Willie, being an artistic work, by reason of the industrial application of the design to mascots and the like. Pursuant to paragraph 20 of Schedule 1, section 52(2) applies to the original drawing. However, Article 3 of the Copyright (Industrial Process and Excluded Articles) (No. 2) Order 1989 provides that section 52 does not apply to certain specified articles including wall plaques, medals, calendars and trade advertisements. This exclusion applies whether the artistic work is covered by section 52(1) directly or whether it is brought within the scope of section 52 by reason of the fact that section 10 applied to it before the commencement of the CDPA.
24. The effect of this is that although section 52(2) applies to the artistic work it does not apply to articles which reproduce the artistic work if those articles are within the exclusion of Article 3. This means that it is an infringement of the copyright in an artistic work to reproduce that artistic work on any of the articles specified in Article 3.
25. JRCL accept that the reproduction of an artistic work, even one that falls within the operation of section 52, on paper or canvas would not constitute an article and would not be within the scope of section 52(2). Therefore, it would be an infringement of the copyright in the artistic work to reproduce it on paper or canvas. In my judgment that is enough to prevent anyone but the copyright owner from applying to register a reproduction of the artistic work as a trade mark.

Was the device mark copied from the original WORLD CUP WILLIE drawing

26. The image of the device mark was created by Peter Day, a freelance designer and artist. He put in a witness statement and was cross examined on it. I found him to be a truthful witness.
27. Mr Day was instructed by Peter Tufft, the company secretary and sales manager of JRCL at a meeting also attended by Mike and Trevor Thorley. Following that meeting Mr Day went away to produce some sketches. It is clear from Mr Day's evidence that the image went through a number of stages. The first stage was described by Mr Day in these terms:

“Since the matter was so urgent I searched on the internet for the 1966 Images and found an example of an embroidered image of the character walking along. Using Photoshop software I then produced an image of a similar lion but tried to make it look stronger, putting it in a modern looking England kit and giving it a St George crest. I then produced various versions of the image with, for example different football shirts, with and without tails etc and sent them to Peter Tufft on 16 February 2006.”

28. Those first versions were rejected by Mr Tufft:

“Peter Tufft telephoned me the same day to say that he was not happy with the designs; he was concerned that my lion was too similar to the 1966 images ...”

29. Mr Day had a second try at producing sketches for a possible lion and sent them to Mr Tufft the following day. The response was much the same:

“However, Peter Tufft telephoned me the next day to say that he still did not think the lion was right, particularly its head, and thought it was too simple and similar to the 1966 images. Peter Tufft asked me to have another attempt: to try and get completely

away from the 1966 Images: and to introduce more character – he wanted ‘a lion with attitude’.”

30. Mr Day stated that he then “*went back to the drawing board and produced something from scratch*”. He described how he collected reference material consisting of pictures from the internet, cartoon lions and the cartoon version of the lion mascot of Aston Villa F.C.. He then started to draw. He said: “*I started with just a blank piece of paper and drew numerous sketches.*” The images produced by Mr Day on this occasion were “*more what (Mr Tufft) had in mind.*” Nevertheless, Mr Tufft asked Mr Day to make some changes including making the lion “*more open and friendly*”.

31. Mr Day was cross-examined in some detail about the various different images he produced for Mr Tufft and the reasons for and details of the various changes he made to them. It was put to him that:

“You were asked specifically to keep as much of the design of the 1966 mascot in your final drawing, but make sufficient small changes so that it could never be said that you had actually copied your final image from World Cup Willie.”

Mr Day’s answer was “No”. As I have said, I found Mr Day an honest and reliable witness and I accept that denial. I accept that, having copied the original World Cup Willie at first, he made genuine attempts to move away from that design. Nevertheless, from the history of the design of the image that was subsequently to become the device, the subject of the trade mark application, I believe that Mr Day still had the original World Cup Willie image in his mind and could not do a completely independent design. Any similarities between the device and the original World Cup Willie image is due to sub-conscious copying by Mr Day. I should mention that although JRCL denied copying in its skeleton argument, in closing submissions it was accepted that there was “*a ‘chain of influence’ passing from Mr Day basing his initial designs on the WCW Drawing and the final version of the Device Mark.*” It was, however, asserted that the chain of influence came from a different, unpleaded, 1966 drawing of World Cup Willie. I do not regard that as an attractive argument and I would be prepared to hear an application to amend the pleadings even at this late date to overcome it but, in the light of my finding below, I do not need to deal with it here.

Is the device mark substantially similar to the WORLD CUP WILLIE drawing

32. Of course, the fact that there was copying does not, of itself, mean that there is copyright infringement. Copying is a necessary ingredient for infringement but the copying must result in the reproduction of a substantial part of the original drawing.

33. Reproduced below are the relevant images with the original on the left:



34. Both lions are kicking a ball (not shown) with their right foot; the body of each lion is in a different attitude, the original leaning back and the JRCL hunched forward; the arms are in different positions; the face of the original is turned in half profile whereas the JRCL lion is almost facing the viewer. The test is a qualitative and not a quantitative test. Overall I am of the view that although there are similarities the JRCL version does not reproduce a substantial part of the original.

Has JRCL infringed copyright

35. In the light of my finding above the answer is “No”.

Did the FA own any goodwill that accrued from use of the WORLD CUP WILLIE drawing in 1966/1970

36. It is not challenged by JRCL that there was goodwill in World Cup Willie arising from its use in connection with the World Cup that was held in England in 1966. However, JRCL point out that the use alleged was not by the FA but by third parties “with the consent” of the FA.
37. JRCL rely on the following passage from the speech of Lord Diplock in *Star Industrial v Yap Kwee Kor* [1976] F.S.R. 256 at 259

“A passing off action is a remedy for the invasion of a right of property not in the mark, name or get-up improperly used, but in the business or goodwill likely to be injured by the misrepresentation made by passing off one person’s goods as the goods of another. Goodwill, as the subject of proprietary rights, is incapable of subsisting by itself. It has no independent existence apart from the business to which it is attached.”

38. JRCL ask the rhetorical question: *What is the business to which the goodwill attached?* The business of manufacturing and distributing was conducted by the third parties who were operating with the consent of the FA. JRCL suggest that the only business that the FA could have been engaged in was a licensing business but say that the disclosure in the case shows that Walter Tuckwell Associates Limited (“WTA”) were in charge of licensing World Cup Willie. They accept that it was possible *“that (the FA) was at the apex of this licensing operation, and that its business consisted of receiving a proportion of licensing income.”* However, they submit that it would not be safe to conclude as much for the following reasons:

- (i) The basis for any licence is unclear since there was no goodwill to license and no evidence of an assignment of the copyright. The vesting order was inconsistent with any suggestion that the FA had legal title to the copyright at the time;
- (ii) There was no evidence other than vague statements by Mr Culley, who had worked for WTA over the relevant period, and a list of licensees with no indication of any financial benefit accruing to the FA at all;
- (iii) The only licence in evidence was in respect of the World Cup Willie song and this was said by Mr Culley to be a “unique licence”, the FA not being a party to any of the other licences.

39. I believe that the evidence points firmly to the fact that the FA were at the “apex” of the licensing operation as JRCL put it and did receive substantial benefit from it. In his witness statement Mr Culley said this:

“18 The FA (Messrs. Willson, Mears and Rous I believe) confirmed that they were happy for WTA to license WCW. I did not see a separate contract for the licensing of WCW (as opposed to the Jules Rimet Cup) as it was Walter Tuckwell who dealt directly with the FA and I never actually saw a contract. I am sure, however, that there would have been some documentation under which the FA granted WTA exclusive rights to license WCW and that WTA agreed that the FA would own the intellectual property rights in the mascot. Walter Tuckwell was a shrewd business man and would never have agreed to the deal without a contract; as far as I am aware, he rarely did business on a handshake. It also would have been unthinkable and unworkable given the shortness of time available to have two companies licensing WCW at the same time. I do not know how royalties were split between WTA and the FA, but I remember seeing some substantial cheques pass through the office.

“19 I remember that WTA had to move quickly to secure the WCW licensing deals. It turned out to be a very successful project and both Walter Tuckwell and the FA were pleased with its progress. We licensed WCW to about fifty companies, but the total number of licences would have been far greater, as each company often used WCW on a number of different products. Companies approached us requesting licences, but we also (as it was our job) approached new and existing licensees to sell them the rights to use WCW and, of course, the Jules Rimet Cup if appropriate – for example on Zippo cigarette lighters.”

40. I note also that Mr Culley describes WTA as “*a character licensing and marketing agency, whose properties included Dr Who (owned at the time by the BBC) and James Bond (owned at the time by the EON Corporation).*” (my emphasis).

41. Mr Culley was not challenged on this evidence.

42. Mr Barber, the FA’s official historian, explained in a witness statement that there was a fire in the FA’s headquarters in London on 1st July 1998 and this destroyed a large number of records. This is relied on by the FA to explain the absence of any documentary evidence relating to licensing and receipts of licence fees.

43. I am satisfied on the balance of probabilities that WTA was acting as the FA’s agent in granting licences to a large number of companies in the build up to the 1966 World Cup.

44. JRCL say that this is not the end of the matter and that the ownership of any goodwill is, in the absence of a legal agreement, a question of fact. The Particulars of Claim do not allege that there was a legal agreement determining the ownership of any goodwill in World Cup Willie established through the licensing activities, although in the passages set out above, Mr Culley suggests that there would have been an agreement between WTA and the FA agreeing that the FA would own the intellectual property rights in the mascot. The destruction of documents by the fire at the FA headquarters would make it difficult if not impossible for the FA to produce any such documents. I, therefore, have to decide the ownership as a matter of fact.

45. JRCL put forward the following three questions suggested in *The Law of Passing-Off* by Christopher Wadlow, 3rd edition:

- (i) Are the goods bought on the strength of the reputation of an identifiable trader?
 - (ii) Who does the public perceive as responsible for the character or quality of the goods? Who would be blamed if they were unsatisfactory?
 - (iii) Who is most responsible in fact for the character or quality of the goods?
46. Whilst I accept that these questions may be appropriate for the traditional type of trade mark use, I do not believe that they are relevant to merchandising cases such as this. JRCL point to an example of licensing of World Cup Willie to Watneys who produced a beer with World Cup Willie on the label. As JRCL say “*There can be no doubt that customers understand that Watneys themselves were responsible for that product. They guaranteed its quality, its character, and it would have been purchased on the back of their guarantee.*” From this they conclude “*Members of the public who were familiar with that beer would have assumed that beer bearing a picture of World Cup Willie was manufactured by Watneys (and not the FA).*” That is, of course, true, but it is not the complete story.
47. JRCL point to the fact that there was an extensive range of goods manufactured by different undertakings and marked with the World Cup Willie name or character and say that a separate factual enquiry is necessary for each line of goods. However, the fact that there was an extensive range of goods combined with the overwhelming publicity surrounding the World Cup itself would, in my view, cause members of the public to believe that, although individual companies produced the different goods, the organisers of the World Cup were responsible for selecting goods to be marked with World Cup Willie. It does not matter that the public might not be able to name the organisation responsible.
48. The questions identified above assume that goods are bought in the strength of the reputation of an identifiable trader. I do not believe that such is the case where the goods are, effectively, promotional goods. Members of the public might buy goods from a trader they had never dealt with before, because those goods had World Cup Willie on them. They would know that the manufacturer (or brewer) whose name was on them was responsible for the character or quality of the goods but they would also appreciate that the organisers had selected that manufacturer and allowed them to put World Cup Willie on the label. Watneys would get credit for a good beer but the organisers of the World Cup would also get goodwill in World Cup Willie.
49. It is difficult to attempt to go back 40 years to determine how people reacted to this type of merchandising then. Now, people are much more aware of merchandising across a wide range of goods whereas in 1966, as Mr Culley said “*When the World Cup Willie mascot was created, it was definitely a first*”. However, the scale of the activities (there is a photograph of Mr Walter Tuckwell surrounded by a wide range of merchandise) and the hosting of such a major event as the World Cup would, I am sure, have made the public realise that there was a link between the merchandise and the organisers of the event.
50. For these reasons I am satisfied that the goodwill that was created by the merchandising activities leading up to the 1966 World Cup was the goodwill of the FA.

Has any goodwill that the FA owned been abandoned since 1970

51. In a newsletter published by WTA in June 1966 it was stated: “*The FA has already made public its decision the effect of which will be that after July, World Cup Willie will become just Willie ... If you would like further information regarding ‘Willie’...*” In August and November 1965 the FA applied for registration of the trade mark WILLIE in a range of classes. In evidence, Mr Culley explained that the FA considered the words World Cup to be FIFA’s prerogative and therefore were not free for the FA to claim trade mark rights in.
52. JRCL submit that this amounted to an abandonment of any goodwill in World Cup Willie that belonged to the FA. They rely on the following paragraph in *Wadlow* suggesting a practical approach to the principles in *Star Industrial v Yap Kwee Kor* [1976] FSR 256:
- “If a business is deliberately abandoned in circumstances which are inconsistent with its ever being recommenced then the goodwill in it is destroyed unless contemporaneously assigned to a new owner. Otherwise, the goodwill in a discontinued business may continue to exist, and be capable of being protected, provided the claimant intended and still intends that his former business should resume active trading. It is not necessary that the prospect should be imminent, but the mere possibility of resumption if circumstances ever change in the claimant’s favour is not enough. The claimant’s intention to resume business may the more readily be believed where the original cessation was forced on him by external circumstances...”*
53. That is a good summary of the law as propounded in the *Star Industrial* case. However, I do not think that its application to the facts of this case is as argued for by JRCL. In this case the FA indicated that they did not intend to use World Cup Willie. They did intend to continue to exploit the figure and the goodwill in the figure and the name by continuing to use the figure and dropping “World Cup” from the name. I do not see that as an intention to abandon the goodwill or to cease the business to which the goodwill was attached. Far from it, it evoked an intention to continue to exploit the goodwill and to develop it into something that would outlive the World Cup.
54. In the event, save for some use in relation to the 1970 World Cup, the FA have not used or licensed World Cup Willie since. Furthermore, the trade mark registrations which had been obtained for WILLIE were allowed to lapse, the last of them in 1986. This, says JRCL, shows abandonment of World Cup Willie. The FA counter by saying that World Cup Willie is appropriate for use in conjunction with a World Cup in this country. That was unlikely shortly after the 1966 World Cup but is now becoming more likely again. World Cup Willie was not abandoned, merely put on the shelf until such time as he became relevant again. There is some force in this argument. This is not a run of the mill situation. The World Cup is cyclical and the period of the cycle is unpredictable. Although the competition is run every four years the choice of host nation has no set formula but is a matter of voting by FIFA. The FA has never abandoned its licensing business. Mr Johnson, Director of Corporate Affairs and Company Secretary of the FA, indicated that the FA entertains the possibility of hosting the World Cup again, possibly in 2018, and if it did then World Cup Willie would be used in one way or another.
55. The FA have, over the last few years, received approaches by interested parties for licences to use World Cup Willie. Although no such licences have been granted, the FA has considered each application on its merits.

56. Taking all the evidence into consideration, I do not believe that the FA have abandoned their goodwill in World Cup Willie.

Was any such goodwill that remained and was owned by D sufficient for a passing off action in 2005

57. In order to oppose successfully the JRCL application for registration of the two trade marks under section 5(4)(a) of the Trade Marks Act 1994 the FA must establish that it could have prevented the use of the trade marks by JRCL at the date of the applications in 2005. That is almost 40 years since the last activities which created the goodwill. That is a long time for the goodwill to survive. It is a question of fact as to whether the goodwill has survived and, because I rejected the FA's application to be allowed to adduce evidence of a survey, there is very little evidence to assist me. This says JRCL with some force, means that the FA must fail. The onus is on the FA to prove their case.

58. I must, however, look at all available evidence. There were several documents in JRCL's disclosure that were put to their witnesses, Mr Tufft, Mr Sutton and Mr Thorley with the suggestion that they showed that they were aware of the fact that the FA had goodwill in the name and character World Cup Willie in 2005. I shall refer specifically to 5 of them. The first was written by Mr Tufft in about February 2005. This was produced as sales literature to be used to encourage potential licensees to sign up. It was headed JULES RIMET COMPANY RATIONALE – KEY FEATURES AND BENEFITS. I set out below extracts from this document:

“By taking a Licence with The Jules Rimet Company you gain contractual permission to use this powerful brand in association with your choice products for a specific time in a defined territory.

...

In 2006 England will play in Germany 40 years from their finest footballing victory.

This is an opportunity to tap into the emotional power that will sweep the country during 2006. The patriotic fervour shown in 2004 with the progress of England through the European championships indicates the power of marketing – Jules Rimet can propel your product into this limitless marketplace. (T)he brand does not dat(e) and offers longevity as a Licence to the prospective licensee.

...

this brand has universal appeal and is your chance to celebrate and profit from England's finest hour.”

The next page is headed JULES RIMET CUP COMPANY COMPANY PROFILE and extracts from this page are set out below:

“Licensable Marks: Jules Rimet Cup, Jules Rimet Trophy and World Cup Willie

...

Description:

The Jules Rimet Cup and World Cup Willie represent some of the most valuable sports rights in the UK. These marks are available only through The Jules Rimet Cup Company and England's qualification for World Cup 2006 in Germany will make them even more desirable.

The success of England as a brand throughout the 2004 Euro Championships indicates the strength that Jules Rimet will bring to product marketing in the lead up to the tournament during and well beyond.

...

Jules Rimet and World Cup Willie are official trade marks of the Jules Rimet Company and are subject to extensive trade mark registration.

59. This document was produced before the JRCL World Cup Willie drawing had been produced and before the trade marks had been registered. Mr Tufft was cross-examined on this document and, in particular, as to what he meant by the suggestion that World Cup Willie was one of the most valuable sports rights in the UK. Mr Tufft was adamant that he was referring to JRCL's World Cup Willie even though it had not been drawn at that stage. He said that he remembered the name from 1966 and had a vague recollection of the image but didn't believe that it would be recollected by others.
60. The next document is an email Mr Tufft had sent to Mike and Trevor Thorley on 7th March 2005 attaching some drawings of World Cup Willie and two other cartoon lions "Wilma" and "Wez". In his email Mr Tufft said: "*Please see attached WORLD CUP WILLIE FAMILY ETC. this should be more than enough image wise to show to prospective customers etc. As agreed at our recent meeting do not get to(sic) carried away with Willies(sic) associated characters i.e. family, please remember World Cup Willie is what people associate with and not his family...*" Mr Tufft was asked what he had meant when he said that "World Cup Willie is what people associate with" since there had been no public disclosure of JRCL's World Cup Willie. Mr Tufft was again adamant that he was referring to the JRCL lion and not to the original World Cup Willie or the name World Cup Willie itself. He said he was not saying that the association was there already.
61. The third document is an article from the Daily Star of 10th March 2005 which quoted: "*Spokesman for the group Scott Sutton, 38, insisted last night: "the Germans can't use World Cup Willie because we own him. We have protected him for the English people and the Germans can keep their hands off. We have been in touch with our patent attorney and he is advising us on how we should handle this," The pals decided to adopt Willie after discovering that no-one owned the rights to the mascot. Scott said : "Back in 1966, football wasn't big business like it is today and it seems no one thought to register World Cup Willie. We have put him in a St George's cross and think England fans will love him. We want him out there in Germany to show our Willie is the real deal." German football chiefs admitted they couldn't think of a mascot of their own, so stole Willie.*" A picture of the original World Cup Willie appeared with the article but this was not provided by JRCL. Mr Tufft said that he would have liked to have had their picture with the article.

62. Next there is an article from the Birmingham Evening Mail entitled “Lion’s share of ’66 glory” with a picture of Bobby Moore holding up the Jules Rimet trophy and a photograph of Mr Tufft and Mr Sutton holding their image of World Cup Willie with the name World Cup Willie across the top of the image. The article states:

“Two city Villa fans have snaffled up the defining images of England’s greatest football moment – the Jules Rimet Cup and World Cup Willie.

...

Now they have added the rights to World Cup Willie, the mascot who inspired England’s 1966 triumph.

...

“Everyone remembers World Cup Willie and he is closely linked to the 1966 success, said father of four Peter Tufft, of Sutton Coldfield.

“No one, not even the Football Association, had registered his image so we just added him to our collection. Football just wasn’t big business then.

“We have updated his image and gone for a St George’s flag, rather than the Union Jack he wore in 1966.”

63. The final document I shall refer to appears to be another draft of the first document above. It appears as an email from Mr Tufft to a Simon Elston and is dated 15 February 2005. This contains the statement:

This countries(sic) biggest sporting achievement occurred in 1966 when we won the World Cup. All footy fans up and down the country have never let this achievement fade; it is still talked about and featured in the media

...

2006 World Cup in Germany – 40th anniversary of England’s finest hour 1966-2006

Marketing opportunity to tap into the emotional power that will sweep the country during the year 2006.”

64. When these documents were put to JRCL’s witnesses they all denied that these showed that the reason they chose the name World Cup Willie and had a cartoon lion designed with that name was because they thought that there was any residual goodwill in the original World Cup Willie. I did not find their explanations for the wording of these documents, for which they were responsible, satisfactory. I realise that these are marketing documents and should not be taken too literally but describing an unknown brand as “some of the most valuable sports rights in the UK” only makes sense if it is actually a reference to the value of the original World Cup Willie. I shall return to this below when I consider the issue of “bad faith” but for the moment I am considering whether there is any evidence to establish that there was sufficient residual goodwill in World Cup Willie in 2005.

65. There is another relevant document that was not produced by JRCL but by Granada, who was JRCL’s licensee at the time. This is a Brand and Sports Licensing Source Book 2005 and has an entry about World Cup Willie:

“ World Cup Willie

We all remember 1966 as the year England won the World Cup. It was also the first time a World Cup mascot was ever used. That mascot was World Cup Willie. Now, four decades on, he is back! On the 40th anniversary of perhaps England’s greatest ever sporting achievement, World Cup Willie will once again don his boots and become the symbol of English pride. Next summer the England team heads to Germany, the nation who they beat in THAT final, to compete for football’s ultimate prize, and World Cup Willie will be helping to get the nation behind our team. We are going to make World Cup Willie famous again. He is already known and loved by older generations, and now younger generations will come to know and love him too.”

66. Again this was put to Mr Sutton of JRCL whose response was that he didn’t agree with what the entry said but that it was Granada that was in control of that entry.
67. In addition, there are a number of references to World Cup Willie in the press from time to time and the odd approach from potential licensees seeking a licence.
68. Taking into account all of this material I think that it does establish that there was residual goodwill in the name and character World Cup Willie in 2005 and that this would have been enough for the FA to have succeeded at that time in a passing off action. The documents show that JRCL and its licensee Granada clearly believed that there was a residual value in World Cup Willie from 1966 that would enable them to establish a very strong brand quickly. That residual value could only be a residual goodwill which belonged to the FA.

Would the fair use of the device mark and the word mark across the specifications applied for constitute passing off

69. Fair use of the device mark and the word mark would encompass use of the marks in a merchandising campaign connected with a major footballing event such as a World Cup or European championship. This was clearly envisaged by JRCL’s marketing documents. In that context, there is a clear likelihood of confusion, resulting in passing off.
70. JRCL relies on the *Corgi* case, [1999] RPC 15 in which Geoffrey Hobbs QC sitting as the Appointed Person said:

“On the evidence before me I am prepared to accept that at the date of the application for registration of the later CORGI trade mark: (i) the applicant was the proprietor of a substantial and valuable goodwill built-up and acquired in connection with the promotion and sale of CORGI model vehicles over many years; (ii) the applicant could be damaged in its use and enjoyment of that goodwill if people were deceived or confused by use of the later CORGI trade marks as a trade mark for outer wear, sport and leisure wear. There is a question as to whether the word CORGI has been used by the applicant in a manner and to an extent sufficient to cause it to be misleading when used as a trade mark for the goods of interest to the respondent. This is the point at which I begin to have difficulty with the applicant’s objection under section 5(4). I do not regard it as self-evident that people would be misled (with a concomitant risk of damage to the applicant in its use and enjoyment of the goodwill built up and acquired in connection with the promotion and sale of CORGI model vehicles) if the word

CORGI was used by the respondent as a trade mark for outer wear, sport and leisure wear. The applicant's evidence leaves me in doubt on these matters. I think it is quite possible that people would perceive or assume correctly that the same mark was being used by separate undertakings trading independently of one another."

71. As one would expect from Mr Hobbs QC, those observations are clearly correct on the facts of that case. Here, however, the facts are very different. I have already held that the FA's goodwill is in licensing goods and those goods will be expected to be of a promotional nature connected in some way with the England team and a football competition. That is precisely the nature of the use that is intended by JRCL. If JRCL had applied for registration in respect of industrial motors, there might be similar issues to the *Corgi* case.

Has JRCL carried out any other acts of passing off

72. The only particulars relied upon relate to the Brand and Sport Licensing Source Book referred to above. That was a publication from Granada not JRCL. No other act of passing off has been alleged so the answer to this question is "No".

Can the FA rely upon section 56 of the TMA and if so is the WORLD CUP WILLIE drawing and the name WORLD CUP WILLIE a "well known mark"

73. Originally the FA relied upon the "well known mark" provisions of section 56 of the Trade Marks Act 1994. However, this provision does not apply to individuals or organisations who or which are domiciled in the United Kingdom. This argument was abandoned during the course of the trial.

Were the trade mark applications made by JRCL in bad faith

74. The test for bad faith was established by the Court of Appeal in *Harrison's Trade Mark Application* (CHINAWHITE) [2005] FSR 10. Sir William Aldous, with whom Arden and Pill LLJ agreed, expressed it as follows (at paragraph 29):

"The words 'bad faith' suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as in bad faith by persons adopting proper standards."

75. This was referred to by Sir William Aldous as the 'combined' test of bad faith, in that it contains both a subjective element, what did the applicant know, and an objective element, what would the ordinary person adopting proper standards think. It is based on the combined test of dishonesty applicable in cases of dishonest assistance (*Twinsectra v Yardley* HL [2002] 2 AC 164, as later explained in *Barlow Clowes v Eurotrust* PC [2006] 1 WLR 1476).
76. The applicable objective standard is acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area being examined,

per Lindsay J in *Gromax v Don & Low* [1999] RPC 367 as approved by the Court of Appeal in CHINAWHITE.

77. The combined test of bad faith was considered by Professor Annand, sitting as the Appointed Person, in *Ajit Weekly Trade Mark* [2006] RPC 25:

“[35] ...Bad faith is to be judged according to the combined test of dishonesty for accessory liability to breach of trust set out by the majority of the House of Lords in Twinsectra Ltd v Yardley, with Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd providing the appropriate standard, namely acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area being examined.

...

[41] ... the upshot of the Privy Council decision in Barlow Clowes is: (a) to confirm the House of Lords’ test for dishonesty applied in Twinsectra, i.e. the combined test; and (b) to resolve any ambiguity in the majority of their Lordships’ statement of that test by making it clear that an enquiry into a defendant’s views as regards normal standard of honesty is not part of the test. The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of that knowledge, the defendant’s conduct is dishonest judged by ordinary standard of honest people, the defendant’s own standards of honesty being irrelevant to the objective element...”

78. During the course of the hearing before me the FA applied to amend their Particulars of Claim to insert particulars of bad faith. Without this amendment, the allegation was bound to fail as the case against JRCL was not pleaded with sufficient particularity for such a serious allegation. This was done before the JRCL witnesses went in to the witness box and Mr Cuddigan had an opportunity to take instructions from his clients and to get his witnesses to deal with the amended particulars in evidence in chief. Accordingly, I gave permission to the FA to make the amendments.

79. The amendments are as follows:

“Particulars of Bad Faith

The Defendant relies upon:

- (I) The Claimant’s knowledge that the Defendant owned a significant reputation in the World Cup Willie design and/or name as at January 2005;*
- (ii) The Claimant’s knowledge that the World Cup Willie design and name were widely known by the UK public;*
- (iii) The Claimant’s knowledge that the Applications once registered would result in confusion and deception in the minds of the public to the detriment of the Defendant;*
- (iv) The Claimant’s knowledge that the effect of the Claimant’s Applications once registered would be to enable them to prevent the Defendant from using the World Cup Willie design and name;*

- (v) *The Claimant's knowledge at the time it filed the Applications that if it asked for clearance from the Defendant before filing the Applications such permission would be refused by the Defendant;*
- (vi) *The Claimant's knowledge that the World Cup Willie design and name of the Defendant was the official mascot in 1966 and the Claimant's intention to describe the marks in the Claimant's Applications as an official mascot and name for the 2006 World Cup;*
- (vii) *The Applications were made in the same or a highly similar pose to the World Cup Willie design in order to trigger the connection in the mind of the public between the Claimant's Application and the World Cup Willie design and name."*

80. Each of Mr Tufft, Mr Sutton and Mr Thorley were taken to each of these allegations in their evidence in chief and each denied the knowledge alleged in (i) to (vi) and the intention alleged in (vii). JRCL is the joint creation of these three gentlemen and the knowledge of any one of them is, effectively, the knowledge of JRCL. I shall take each one of these allegations in turn to see whether the facts alleged are established. I shall then assess their conduct by the ordinary standard of honest people.

- (i) *The Claimant's knowledge that the Defendant owned a significant reputation in the World Cup Willie design and/or name as at January 2005*

81. Mr Sutton and Mr Thorley denied any knowledge of World Cup Willie in 2005. They were too young to remember him and I believe them when they say they were not aware of him before Mr Tufft suggested World Cup Willie was an idea they should explore. Mr Tufft had a vague recollection of World Cup Willie but thought that the FA had no reputation with the general public in World Cup Willie. As I have indicated above, Mr Tufft was cross-examined on the documents from disclosure which suggested that JRCL were marketing World Cup Willie as a valuable brand, which suggested that there was a pre-existing goodwill left over from 1966. I did not regard Mr Tufft's explanation for those documents as satisfactory.

82. I believe that Mr Tufft was well aware of World Cup Willie and had more than a vague recollection. I bear in mind the fact that the company is called Jules Rimet Cup Limited, which is the name of the World Cup that was won by England in 1966. The clear focus of the company was 1966 and they were attempting to capitalise on the nostalgia for that time. The documents referred to above show that JRCL clearly believed that there was residual goodwill that they could tap into and develop.

83. Mr Day was clearly told about the original World Cup Willie, although he was not given an example of it, and was told to make his design of World Cup Willie different. This suggests an awareness by Mr Tufft that someone owned rights in the original World Cup Willie design.

84. I note the use in the pleading of the words "significant reputation". I take that to mean a valuable reputation, I find that Mr Tufft was aware that there was a valuable residual reputation in the World Cup Willie design and name as at January 2005. Although Mr Sutton and Mr Thorley were not aware of this prior to being introduced to World Cup Willie by Mr Tufft in December 2004, by the time of the trade mark applications, they too were aware of the residual reputation.

85. Mr Tufft said that he was not aware that World Cup Willie belonged to the FA. Nevertheless, he rang the FA at an early stage to see whether they claimed any rights. Thus, although he may not have known for certain who owned any residual reputation, he had a good idea to whom it might belong. Having said that, I believe that Mr Tufft genuinely thought that the FA had no continuing interest in World Cup Willie.

(ii) The Claimant's knowledge that the World Cup Willie design and name were widely known by the UK public

86. This follows from my findings under (i) above. JRCL was aware that the World Cup Willie design and name were widely known by a sector of the relevant public.

(iii) The Claimant's knowledge that the Applications once registered would result in confusion and deception in the minds of the public to the detriment of the Defendant

87. This is more a question of opinion than knowledge. Having seen Mr Tufft, Mr Sutton and Mr Thorley in the witness box I do not believe that any of them thought that there would be confusion or deception. They thought of it simply in terms of rebuilding the residual goodwill in World Cup Willie. I do not find this allegation of knowledge proved.

(iv) The Claimant's knowledge that the effect of the Claimant's Applications once registered would be to enable them to prevent the Defendant from using the World Cup Willie design and name

88. As I have said above, Mr Tufft believed that the FA had no continuing interest in World Cup Willie. I do not think that it was in his mind that the registrations would enable JRCL to prevent the FA from using the World Cup Willie design and name. I do not find this allegation of knowledge proved.

(v) The Claimant's knowledge at the time it filed the Applications that if it asked for clearance from the Defendant before filing the Applications such permission would be refused by the Defendant

89. Again this is more a question of opinion than knowledge. Mr Tufft did ring the FA to try to find out whether they were claiming any rights. He did not get an immediate response. Someone in the Rights Department said they would get back to him: they never did. I accept Mr Tufft's evidence that he did not think that he needed to ask permission. He made a simple inquiry as to whether the FA was claiming rights and got no answer.

(vi) The Claimant's knowledge that the World Cup Willie design and name of the Defendant was the official mascot in 1966 and the Claimant's intention to describe the marks in the Claimant's Applications as an official mascot and name for the 2006 World Cup

90. Mr Tufft clearly had the knowledge that the World Cup Willie design and name represented the official mascot in 1966. He, and JRCL, did not intend to describe the marks in the Claimant's applications as an official mascot and name for the 2006 World Cup.

91. This allegation arises out of a document produced by Mr Day which uses the words Official Mascot in respect of the design he produced for JRCL. Mr Day's evidence was

clear that this was not something suggested by JRCL but was something he did off his own bat. When Mr Tufft saw it he told Mr Day to remove the suggestion that it was official.

92. I do not find this allegation of intention proved.

(vii) The Applications were made in the same or a highly similar pose to the World Cup Willie design in order to trigger the connection in the mind of the public between the Claimant's Application and the World Cup Willie design and name

93. The pose chosen by JRCL is a typical footballing pose. I do not find that it was chosen for the reason suggested in the pleading. There are, I am told, a large number of drawings of the original World Cup Willie. I was not shown them but, presumably, they are in a number of different poses. If JRCL had chosen a different pose for their lion I am sure that the FA would have relied on a different drawing with a different pose and would have made the same allegation.

The Moral Judgment

94. I have found that JRCL made their trade mark applications knowing that there was valuable residual goodwill in World Cup Willie. Is that "dishonest" as judged by the ordinary standards of honest people?

95. First of all, one must look to see what steps JRCL took to see whether they could make their applications. As I have said, Mr Tufft rang the FA to see whether they claimed any rights. They did not get back to him and he did not contact them further. JRCL carried out internet searches to see whether anyone was using World Cup Willie and found that no one was. Finally they engaged the services of a firm of Trade Mark Attorneys. The first firm they went to also acted for the FA so they subsequently had to instruct a different firm. They carried out a search of the Trade Marks Register to see whether anyone had registered relevant trade marks. There were no relevant trade marks. They were advised that they could go ahead and apply for registration. In fact, the word mark was applied for on the advice of the Trade Mark Attorney.

96. It is said by Mr Cuddigan that the fact that they sought legal advice is a complete answer to the allegation of bad faith. The difficulty that one has is knowing what advice was sought and what facts were given to the Trade Mark Attorney. Clearly, so far as the state of the Trade Marks Registry is concerned, there would be no reason why the trade mark applications should not be made. Bad faith can only arise if one knows that there is a residual reputation that belongs to someone else. I do not know whether JRCL told their Trade Mark Attorney the relevant facts or whether he saw the proposed publicity claiming that it represented one of the most valuable sporting rights. If he had seen this his advice might have been different.

97. If a defence is going to be run on the basis that legal advice has been sought and followed I think it is incumbent on the party running that defence to disclose all the relevant facts including the instructions given and the full advice received. In the absence of that, the fact of legal advice having been sought is relevant but cannot be conclusive in a case such as this.

98. I conclude that, in spite of having sought the advice of Trade Mark Attorneys, applying for the trade mark registrations, knowing that World Cup Willie had a residual goodwill in the United Kingdom, does amount to bad faith.
99. I should add that on the authorities, the opinions of the individuals is not relevant since it is an objective test. However, I would like to record the fact that I think that Mr Tufft, Mr Sutton and Mr Thorley did not think that they were doing anything wrong. They thought that they had found something that no one else was interested in and felt that they were entitled to claim it for themselves. Similarly, although I found Mr Tufft's explanations for the documents I have referred to above unsatisfactory, I do not believe that Mr Tufft was trying to mislead the Court.

Summary

100. So far as copyright is concerned I find that the FA owns copyright in the original World Cup Willie drawing and that section 52 of the CDPA provides a defence to an infringement action in respect of some articles but not those primarily of a literary or artistic nature or other articles excluded from the effect of section 52(1) and (2).
101. JRCL's World Cup Willie was copied from the original World Cup Willie but does not reproduce a substantial part of the World Cup Willie drawing and so does not infringe the copyright therein.
102. The FA could have prevented the use of the trade marks applied for by JRCL in 2005 by an action for passing off.
103. JRCL's trade mark applications were made in bad faith.

Case Management

104. I must mention a problem that arose during the course of the hearing. Time was wasted during the hearing because the FA ran out of witnesses who were available at Court. I appreciate that witnesses are often busy people and they should not be kept hanging around Court on the chance that they might be required. In my experience this is usually avoided by the parties agreeing a timetable, counsel indicating how long they are likely to be cross-examining each witness. This can only ever be an approximation but it is a useful guide for the Court and the other side. Unfortunately, it appears this was not done in this case.
105. The FA ran out of witnesses because counsel for JRCL did not cross-examine some witnesses for as long as counsel for the FA had anticipated. This is precisely why a timetable should be agreed. In the absence of a timetable, the party calling the witnesses is responsible for ensuring the attendance of witnesses at the appropriate time and takes the risk of running out of witnesses.
106. In this case costs were wasted by reason of the lack of witnesses and I propose to reflect this in any award of costs I make.