

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2227520
by CDW Graphic Design Limited**

AND

**IN THE MATTER OF Opposition thereto under
No 51354 by Manchester United Merchandising Ltd**

INTRODUCTION

1. On the 29 March 2000, CDW Graphic Design Limited applied to register the trade mark 'www.standupifyouhateamanu.com' in respect of:

Class 16

Car stickers/bumper stickers; posters; paper door hangars

Class 21

Mugs

Class 25

T shirts; polo shirts; sweat shirts; baseball caps; bobble hats; scarves and underwear.

2. On 1 September 2000, Manchester United Merchandising Ltd filed Notice of Opposition. The grounds of opposition are, in summary that:

- i) the trade mark is the address of a website promoting hatred of the players and supporters of Manchester United Football Club, and use of the trade mark is tantamount to an incitement to violence;
- ii) as such registration of the trade mark would be contrary to public policy and ought therefore to be refused under section 3(3)(a) of the Trade Marks Act 1994 ("the Act");
- iii) the trade mark applied for contains the element MAN U being a distinctive abbreviation of Manchester United Football Club, which is similar to registered UK trade mark No 1548123 - MAN.U.CAN, No 2135938 - MAN-U-NET, No 2135939 - MANUSEUM, and No 2202058 - MANUFREE.NET;
- iv) these marks are registered for goods and services which are not similar to those in respect of which the applicant seeks registration;
- v) use of the applicant's mark would take unfair advantage of, and be detrimental to, the distinctive character or repute of the earlier trade marks;

vi) registration should therefore be refused under section 5(3) of the Act.

3. The applicant filed a Counterstatement:

- i) admitting the existence of the earlier trade marks cited in the Notice of Opposition;
- ii) putting the opponent to proof of the claimed reputation of the earlier trade marks;
- iii) requiring proof of use of the marks by the proprietor or with his consent and denying that any alleged use of the marks by the public is relevant;
- iv) denying that use of the applicant's mark goes beyond the "tradition of competitive behaviour" in football, and that use of the mark will encourage hatred or violence;
- v) denying that the respective marks are similar;
- vi) denying that registration of the mark would be contrary to sections 3(3)(a) or 5(3) of the Act.

4. Both sides seek an award of costs.

5. The opponent filed a statutory declaration by John Heaton, who is the Company Secretary of Manchester United Merchandising Limited. Mr Heaton's declaration has 14 exhibits, one of which consists of a witness statement by Darren Jonathan Berman, who is the Company Solicitor of The Football Association.

6. The applicant sought and was granted two extensions to the three month period allowed for filing evidence (giving the applicant nine months altogether), but in the end no evidence was received.

7. The matter came to be heard on 18 July 2002, when the applicant was represented by one of its officers, a Mr N Wayne, and the opponent was represented by Mr J St Ville of Counsel, instructed by William A. Shepherd & Son. During the hearing, Mr Wayne sought to introduce evidence about the origins of the phrase "Stand up if you hate Man U", and about the applicant's use of that term as part of the name of a web site. Given the extended period allowed for the applicant to file its evidence, and the lateness of the request, I did not consider that it would be appropriate to exercise the Registrar's discretion to allow the late evidence into the proceedings. In reaching this decision, I also took into account that, from Mr Wayne's brief description of it, the evidence that the applicant wished to have admitted did not appear very likely to have a major impact on the outcome of the matter.

SECTION 5(3)

8. Section 5(3) is as follows:

“5.-(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and*
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,*

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

9. I indicated during the hearing that the ground of opposition under section 5(3) was bound to fail. These are my reasons for coming to that conclusion.

10. Mr St Ville was content to rely on the earlier trade mark MANUFREE.NET, *“as the example which best expounds the case the applicant has to answer”*. The mark is registered in the name of Manchester United Plc as one of a series of two trade marks under No 2202058 in respect of:

Class 9

Software for searching and retrieving information across a computer network; a directory of information available on a computer network recorded on compact disk; diskette, tape, or other machine-related media; search engines; parts and fittings for all the aforesaid goods.

Class 42

Providing of access to a directory of information available on a computer network; search engine services.

11. It is common ground that these goods and services are not similar to any of the goods listed in the opposed application.

12. Before it becomes necessary to determine whether the marks are sufficiently similar for use of the applicant’s mark to positively or negatively exploit the earlier trade mark, it is first necessary to determine whether the earlier mark enjoys a reputation in the United Kingdom.

13. The opponent relies upon Mr Heaton’s evidence to support its claim that this mark enjoys a reputation. In fact, as Mr St Ville was constrained to accept, Mr Heaton does not specifically say anything at all about the use of the mark MANUFREE.NET. The only brand name he specifically states has been used is MANCHESTER UNITED. One has to turn to exhibit JH12 to his declaration to find any evidence of the use of the mark MANUFREE.NET. This is one of

eleven exhibits to Mr Heaton's declaration which he says "*consist of a selection of merchandising catalogues from previous years, which clearly show usage of various of the Trade Marks owned by Manchester United Plc, in relation to a wide range of products*".

14. Despite how Mr Heaton describes it, exhibit JH12 in fact consists of copies of the front pages, and what appears to be two unnumbered internal pages, of the August and December 1999 issues of the Manchester United fans magazine. The internal pages carry an advertisement for MANUFREE.NET, which appears to be a software product which gives the user free internet access to the Official Manchester United On-Line News Server.

15. Mr St Ville asked me to infer that:

- a) these two magazines would have been seen by a very large number of Manchester United fans;
- b) a significant proportion of whom would have noted the announcement of a free internet access service with associated software under the mark MANUFREE.NET prior to the date of the application in March 2000;
- c) that once the service was announced, the massive reputation of MANCHESTER UNITED as a football club with associated merchandising activities would have attached itself to the mark MANUFREE.NET and quickly resulted in that mark acquiring a reputation for the free internet service and associated software described above.

16. There can be little doubt that Manchester United has a huge reputation as a football club, and I am sure that many people would have heard of their merchandising activities, which according to Mr Heaton resulted in a turnover in excess of £21M in 1999 alone. In **Premier Brands UK v Typhoon Europe** [2000] FSR 757, the claimant argued that the distinctive character of its TY.PHOO trade mark, which was registered for kitchenware, and been used on only a small scale for such goods, had been significantly enhanced by the reputation that the same trade mark had acquired as a result of a much greater trade in tea. Neuberger J. said this:

"I accept that the three decisions of the ECJ to which I have referred support the proposition advanced by Mr Arnold on behalf of Premier. However, it seems to me that they do not detract from what may be said to be the fundamental point made by Mr Bloch on behalf of TEL on this aspect, namely that, in connection with a particular registered mark, the less use it has had in connection with the goods for which it is registered, the less distinctiveness it is likely to have acquired, and, therefore, the more protection claimed for it has to be limited to its inherent distinctiveness."

17. In this case the mark which undoubtedly has a substantial reputation (MANCHESTER UNITED) is not even the same mark as the mark for which the opponent seeks to invoke the exceptional protection available under section 5(3). The reputation of MANCHESTER UNITED as a provider of football entertainment, and arguably as a seller of merchandise,

should not be elided with the registration of MANUFREE.NET for, inter alia, internet access services and associated software, with the artificial result that this mark is deemed to have a reputation for these goods and services.

18. The only use of the mark MANUFREE.NET shown in the evidence is in two fans magazines published the year prior to the application. The opponent has not provided circulation figures for these magazines. Nor has it provided any evidence about the number of persons who subsequently used the service. In fact there is no concrete evidence that the service ever got off the ground.

19. In **General Motors Corp v Yplon S.A.** [2000] RPC 572, the European Court of Justice (ECJ) found (in paragraph 26 of its judgement) that a trade mark has a 'reputation' for the purposes of section 5(3) when it is known by a significant part of the public concerned for the products or services covered by the trade mark. The public in this case must be considered to be all users of software and internet access services and not merely the users of these goods and services who are also fans of Manchester United.

20. Once one appreciates the extent of the requirement for 'reputation' for the purposes of section 5(3) it is inevitable that the evidence provided in this case was wholly inadequate to support the claim that the mark MANUFREE.NET has a relevant reputation.

21. The opponent is no better off with any of the other three earlier trade marks listed in the Notice of Opposition.

SECTION 3(3)(a)

22. Section 3(3)(a) is as follows:

“3.-(3) A trade mark shall not be registered if it is -

(a) contrary to public policy or to accepted principles of morality, or

(b)”

23. The provision comes from EU Directive 104/89.

24. Mr St Ville drew my attention to Case C-377/98, **Netherlands v Commission and Council** [2001] 3 CMLR 49, a case concerning the lawfulness of the Biotechnology Patents Directive. The opinion of Advocate General Jacobs provides an explanation of the origin of the term in the 1911 Washington revision of the Paris Convention, and he describes the role in Community Law of the term 'public policy', or 'ordre public' as it appears in French texts.

25. He notes (at paragraph A101) that:

“...the Court’s approach is essentially similar to that of the European Patent Office, whose guidelines for substantive examination state that the purpose of the ordre public and morality provision is ‘to exclude from protection inventions likely to induce riot or public disorder, or to lead to criminal or other generally offensive behaviour’.”

26. The court found that the Directive was lawful, and in so doing noted that such a provision allows the administrative authorities and courts of the Member States scope for manoeuvre in applying the exclusion in order to take account of the particular difficulties to which use of the rights under consideration may give rise in the social and cultural context of each Member State.

27. The judgement which must therefore be made is whether in the social and cultural context of the UK, use of the applicant’s mark is liable to lead to, inter alia, criminal or other offensive behaviour. This conclusion is consistent with paragraph 9.1 of Chapter 6 of the Registrar’s Work Manual, which suggests that trade marks which encourage or promote drugs, counterfeiting, and criminal activity will be refused under section 3(3)(a) of the Act as being contrary to public policy.

28. Mr St Ville accepted that it was not the applicant’s intention to incite violence or offensive behaviour amongst football fans, but he argued that this would be the result of the use of the mark. In this connection, I note that section 3(4) of the Act expressly prohibits the registration of trade marks that in use would be contrary to law. If the same requirement were to be applied as a pre-condition for a successful objection under section 3(3), the provision would become otiose. I am therefore prepared to proceed on the basis that the opponent does not have to show that use of the applicant’s mark would, of itself, be contrary to law. It is not therefore necessary for me to take a view on whether use of the applicant’s mark in relation to the goods at issue would amount to a criminal act of incitement to violence. It is enough if normal and fair use of the applicant’s mark is likely to lead to criminal or other offensive behaviour, even if that is not the applicant’s intention.

29. In making the necessary assessment, I must have regard to the context in which the mark is likely to manifest itself in normal and fair use: **Ghazilian’s Trade Mark** [2002] RPC 33. It is true that that case concerned an objection based upon morality, but as Advocate General Jacobs indicates in the case referred to above, objections based upon public policy and morality are closely related. According to Mr S Thorley Q.C. , who acted as the Appointed Person in the Ghazilian case, I am entitled to rely upon my own knowledge of words and upon my own perception of the ways in which those words can be used in making the necessary judgement about whether the registration of the mark would be contrary to section 3(3) of the Act. However, I can, of course, be assisted by relevant evidence.

30. The opponent relies upon the evidence of Darren Jonathan Berman, who is the Company Solicitor of The Football Association. He says that:

“3. THE FOOTBALL ASSOCIATION is keen to promote football as a sporting

*activity that can be enjoyed by all, and to prevent any animosity between the supporters of rival football teams, which in the past has led to football hooliganism, and which of course only leads to damage the reputation of the game. **THE FOOTBALL ASSOCIATION** is a supporter of initiatives such as the work of the Home Office Working Group on Football Disorder which published its findings on 16 March 2001. It is the objective of **THE FOOTBALL ASSOCIATION**, the Home Office, Supporters Organisations and others to promote good relations amongst supporters. All these parties are opposed to any behaviour that might prejudice this.*

4. *We have been referred to the trade mark www.standupifyouhatemanu.com by **MANCHESTER UNITED MERCHANDISING LIMITED**. Any usage of this trade mark to engender animosity between the supporters of **MANCHESTER UNITED FOOTBALL CLUB** and supporters of other football teams, whether in England or otherwise, would offend against the principles outlined above. The promotion of hatred is contrary to the aims of **THE FOOTBALL ASSOCIATION** and is against the interests of football and its supporters.”*

31. I understand Mr Berman to be expressing general concern about the possible effects of the use of the trade mark under opposition. He does not, however, appear to me to express any definite view on the likelihood of the mark actually promoting hatred, animosity or violence.

32. The applicant has filed no evidence. I am therefore left to form my own view on the likelihood of normal and fair use of the applicant's mark encouraging violent or other offensive behaviour.

33. The connection between football and the violent behaviour of some fans is, of course, well known. Furthermore, even though the applicant's mark is plainly presented as an internet domain name, the use that I must consider is as a trade mark used in relation to goods. The goods listed in the application are of a sort typically used to carry images or messages and I therefore think it safe to assume that the applicant's mark will appear prominently upon them.

34. Mr St Ville submitted that the applicant's mark would function as a “badge of antagonism” likely to affect the behaviour of a crowd of like-minded individuals, and also the groups of people (presumably Manchester United fans) that the trade mark is likely to goad and antagonise.

35. Mr Wayne sought to persuade me that football fans would regard the mark merely as friendly banter recognising the longstanding tradition of rivalry between football clubs. He explained that the mark was to be used to sell merchandise through an established internet site of the same name. He pointed out that the mark applied for was not just ‘stand up if you hate man u’ but ‘www.standupifyouhatemanu.com.’ For the reasons I have already explained, there is no evidence that the name has been used as the name of an internet web site, although simply judging from the nature of the trade mark itself, one would naturally expect it to serve both as the name of a web site and as a trade mark for the goods that the applicant intends to sell. I do not, however, accept the suggestion that the use of the name in connection with a web site

should be regarded as being no more likely to give rise to violent or offensive behaviour than use of the name as a trade mark for goods.

36. The chief distinction appears to me to be that people usually visit web sites intentionally, and so are unlikely to be goaded by the name when used for an internet web site. And even if Manchester United fans come across the web site by accident, as may sometimes happen, the user will not be in the (sometimes highly charged) atmosphere of a football game.

37. I have difficulty in accepting the applicant's submission that use of the name as a trade mark would be seen as no more than friendly banter. The inclusion in the mark of the word "hate" appears anything but friendly. The reference in the mark to "manu" would, I believe, be readily understood in a football context. Indeed the applicant's plans must be based upon this assumption. Further, the invitation to "stand up", which may have a relatively innocuous meaning when used merely as part of the name of a web site, is liable to be viewed as an encouragement to others to actively express their hatred of Manchester United when worn or otherwise sported by fans of rival teams at, or en route to or from, a match with Manchester United.

38. Further, although the basis of the objection may be less obvious in respect of a few of the items in the specification, such as paper door hangars in Class 16, mugs in Class 21 and underwear in Class 25, I bear in mind that if the applicant's mark becomes successful there is nothing to prevent such goods from being sold and promoted in the immediate vicinity of football grounds.

39. Normal and fair use of the applicant's mark in any of these contexts is liable to function, as Mr St Ville submitted, as a "badge of antagonism." In my judgement, such use is liable to increase the incidence of football violence or of other offensive behaviour. Consequently, I find that the application to register the trade mark is contrary to public policy, and the objection under section 3(3)(a) of the Act therefore succeeds.

COSTS

40. The opposition has succeeded. In these circumstances I think it is appropriate for the applicant to pay the opponent a contribution towards its costs. I therefore order the applicant to pay the opponent the sum of £1500 within 7 days of the end of the period allowed for appeal.

Dated this 20th Day of November 2002

**ALLAN JAMES
for the Registrar
the Comptroller-General**