

O-345-17

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2655880
BY THE RANGERS FOOTBALL CLUB LIMITED
TO REGISTER THE FOLLOWING SERIES OF MARKS IN CLASSES 14, 24 & 25:**

RFC & R.F.C

AND

**AN OPPOSITION THERETO (NO. 400756) BY
MR RUSSELL CAMPBELL**

Background, pleadings and procedural history

1. The trade marks **RFC** and **R.F.C.** were filed by The Rangers Football Club (“the applicant”) on 12 March 2013. They were published for opposition purposes on 31 May 2013. Save for where it is necessary to distinguish between them, I will refer to the marks in the singular, using the mark **RFC** as the point of reference.

2. The specification of the mark reads as follows:

Class 14: Jewellery; necklaces, chokers, pendants, chains, bracelets, bangles, earrings, rings, toe-rings, anklets, tiaras, studs and rings for navel piercing; articles of precious metals and their alloys; goods made of precious metals and their alloys or coated therewith not included in other classes; badges, buckles, hair ornaments, keyrings, key fobs, cups, jewellery boxes, trinket boxes, boxes, money clips; badges, buckles, hair ornaments and keyrings made of precious stones; watches; stopwatches; horological and chronometric instruments; cuff-links; tie-pins; silver and gold tankards; pitchers made of precious metals and their alloys; flasks of precious metals and their alloys; precious stones; candelabras, candle sticks; statues and statuettes made of precious metals and their alloys; goblets made of precious metals and their alloys; vases and vessels made of precious metals and their alloys; works of art made of precious metals and their alloys; paper knives made of precious metals and their alloys; napkin rings made of precious metals and their alloys; gems, precious and semi-precious stones; tableware made of precious metals and their alloys; parts and fittings for all the aforesaid goods; **all of the aforesaid goods relating to or for the promotion of football (soccer).**

Class 24: Rugs; travelling rugs; lap rugs; towels; flags and pennants; plastic pennants; bed linen, blankets, bedspreads, brocades; cloth; fabric; table covers and table linen; place mats; napkins, serviettes and table runners; curtains; curtain holders of cloth; banners; handkerchiefs of textile; bath linen; bunting; household linen; mats of linen; coverings of textile and of plastic for furniture; covers for toilet lids of fabric; covers for cushions; loose covers for furniture; textile wall hangings; shower curtains; fabric of imitation animal skins;

upholstery fabrics; hemp and jute fabric; textile piece goods; lingerie fabric; **all of the aforesaid goods relating to or for the promotion of football (soccer).**

Class 25: Clothing, headwear and footwear; clothing of leather and of imitation leather; money belts; t-shirts, polo shirts, rugby shirts, jackets, ties, bow ties, pullovers, trousers, socks, shirts, skirts, dresses, sweaters, sweatshirts, pants, jerseys, jumpers, waistcoats, kilts, pyjama suits, night suits, night shirts, night dresses, dressing robes; underwear; boxer shorts, briefs, bras, lingerie, garters, hosiery, corsets, bodices; romper suits, bibs; children's clothing; clothing for babies; outer clothing; blazers, coats, fleeces, padded jackets; sports clothing; track suits, training suits, football tops, football shorts, leotards, bathing suits, bikinis, swimming trunks, beachwear; swimwear; sleepwear; sports bras, jock straps; sports clothing for children and for babies; track suits, training suits, football tops, football shorts; waterproof jackets, wax jackets, oilskins, waterproof trousers, outer trousers, galoshes, waterproof coats, anoraks, wet suits for surface water sports; braces; hats and caps; shoes, sandals, slippers, training shoes, boots, football boots, ski boots; gloves, mittens and scarves; belts (clothing); **all of the aforesaid goods relating to or for the promotion of football (soccer).**

3. The qualification I have highlighted in bold was added to the specification at examination stage. The purpose of the amendment was to overcome an objection raised by the IPO's examiner under sections 3(1)(b) and (c) of the Act, an objection based on RFC being an abbreviation for RUGBY FOOTBALL CLUB. The qualification had an apparent intention to limit the goods to the field of soccer (association football) and, therefore, avoid the rugby football objection.

4. Mr Russell Campbell ("the opponent") opposes registration of the mark. The grounds identified in his TM7 (Notice of Opposition) are based on sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994 ("the Act"). The central theme of the grounds as pleaded is that RFC is an abbreviation for "rugby football club" and that the mark is, consequently, devoid of distinctiveness, descriptive and commonly used. The opposition was lodged on the rugby football basis despite the soccer qualification highlighted above.

5. The opponent filed evidence in support of his opposition, the applicant filed only written submissions. The applicant has been professionally represented throughout the proceedings, by Ancient Hume Limited. The opponent initially had legal representation, but now represents himself.

6. The proceedings were initially determined on 30 July 2014 in a written decision issued by a hearing officer of this Tribunal, Ms Al Skilton. She rejected the opposition in its entirety and awarded costs of £800 to the applicant. That decision was then appealed to the Appointed Person. The Appointed Person, Mr Geoffrey Hobbs QC, issued his decision on 25 August 2016. He dealt with the qualification which had been added to the specification and its effect, or otherwise (I will say more about this later). In terms of the grounds of opposition themselves, Mr Hobbs decided that the hearing officer had not given full consideration to them and, consequently, a full and stringent examination of the grounds of opposition had not been conducted. He remitted the case back to the Tribunal for further processing and determination by a different hearing officer. I am that hearing officer and this is my decision on the remitted case.

7. Before moving on, I need to deal with some further procedural issues that have arisen since remittal of the case. After remittal, a letter was issued to the parties indicating that a fresh decision could be made from the papers (albeit written submissions could be filed) or following a hearing. Ten days were permitted for a response. The applicant responded (on time) on 5 October 2016 indicating that it was content for a decision to be made from the papers, although it asked for an opportunity to file written submissions. The opponent responded (also on time) on 4 October 2016 in which he indicated that a decision from the papers was preferable. However, the rest of the opponent's comments related to an unpleaded allegation of bad faith (on the basis of the applicant having no intention to use the mark), together with prints of the applied for mark and ten pages of prints taken from the applicant's website where merchandise is sold, but the subject mark not used.

8. Further, on 21 November 2016, the applicant wrote to the Tribunal in which it put forward a further qualification to be added to the specifications, namely:

“...; all relating to Glasgow Rangers Football Club”

9. On 25 November 2016 directions were issued to the opponent, seeking answers to the following questions:

“- Whether the information contained in your letter of 4 October 2016 is a formal request to seek leave to amend the pleadings;

- If so, you should complete the relevant part of the form TM7 so that the tribunal and the other party can see a concise explanation for the ground. You should ensure that you identify what the claimed objective of the bad faith application was;

- If leave is granted to add the ground, whether you additionally seek leave to file further evidence and, if so, what you intend to show;

- If leave is granted to add the ground, whether you still wish to pursue the grounds of opposition under section 3(1) of the Act;

- If leave is refused, whether you still wish to pursue the grounds of opposition (and the case itself);

- Whether the latest request to amend the specification would enable the opposition to be withdrawn, irrespective of any of the above.”

10. The opponent was given until 9 December 2016 to respond.

11. Also on 25 November 2016, a direction was issued to the applicant asking it to confirm “..whether the latest request to amend the specification is simply something for the hearing officer to consider as part of his decision, as a fall back, or whether the applicant is asking for its addition regardless of this dispute”. The applicant was given the same date to respond.

12. The applicant responded (on time) to its direction stating that the qualification was simply something for the hearing officer to consider as part of the decision.

13. The opponent failed to respond to the directions given to him.

14. On 16 March 2017 the parties were informed that given the opponent's lack of response to the directions given to it, the proceedings would continue on the basis of the original pleadings made under section 3(1) of the Act. A period of 13 April 2017 was set for any written submissions on those grounds.

15. On the 18 April 2017 a further letter was received from the opponent. It is dated 12 March 2017, although this may have been a dating error as it is logical to conclude that it was written in response to the letter from the Tribunal dated 16 March. It did not contain any submissions about the originally pleaded grounds under section 3(1) of the Act. Instead, the opponent referred, again, to section 3(6) of the Act and the claim that the application was made in bad faith as a mechanism to squat/stockpile marks in order to stop others from using them. More pages (17 in total) from the applicant's merchandise website were attached. The opponent stated that the applicant's qualification was "trivial, an irrelevance and superfluous". He states that if the applicant's mark was granted then he, and other traders, who are using the mark, would be faced with criminal proceedings. The context appears to be that the opponent produces memorabilia connected with Rangers Football Club. The opponent asks for the application to be refused and costs awarded to him.

16. The applicant did not respond to the letter from the Tribunal dated 16 March 2017, so it is taken as filing no new submissions about the section 3(1) grounds.

17. The Tribunal responded to the opponent's letter received on 18 April. It was explained that the purpose of the last letter sent to him (which was responded to late, or at least the response was received late) was to seek written submissions about the section 3(1) grounds, it having already been directed that the case would proceed on those grounds only. The Tribunal considered that it would be disproportionate to re-open the pleadings issue again now, noting that, even now, the opponent had still failed to comply with the specific directions placed upon it on 25 November 2016, and also highlighting that the proceedings had been ongoing for a number of years before any mention of section 3(6) was made. The opponent was advised that a decision on the section 3(1) grounds only would follow. As a decision to proceed in this way was

potentially adverse to the opponent, he was given until 13 June 2017 to request a hearing if he wished to challenge the preliminary view on how the case should proceed.

18. On 9 June 2017 the opponent responded. No request to be heard was made. Instead, the opponent repeated many of the points he had made previously about the bad faith allegation and the criminal consequences on him (and others) if the application was registered. He states that the previous letter sent to the Tribunal was posted on 12 April 2017 via next day delivery, therefore, if it was received outside the deadline then that is no fault of his. Reference is made to trade mark attorneys in Glasgow who cannot be trusted, so he used an attorney in Liverpool who failed to follow his instruction that the opposition should be made under section 3(6). Reference is made to the 3(1) "ground only". The opponent appears to believe that this is some form of reference to a football ground. The opponent considers that the IPO is treating him unfairly as trivialities such as late delivery are being relied upon. The opponent states that under no circumstances should a decision be drafted registering the opposed marks - he instead expects the marks to be refused and costs awarded to him.

19. A further letter dated 12 June 2017 was received from whom I initially assumed was the opponent (the letter has a similar look and feel to previous letters from the opponent), but was actually submitted by an individual named Joseph Gallagher. He says that he has an interest in this dispute and, therefore, wishes to submit his observations, observations which focus on criminal proceedings he had been engaged with [in connection with the sale of Rangers memorabilia] and which would result from the registration of the application.

How should the case proceed?

20. I have considered all of the above in determining how these proceedings should move forward. I am extremely mindful of the fact that the subject trade mark was filed over four years ago and that the opposition itself was lodged only one month shy of four years. In terms of communicating with the Tribunal, it was not until after the case had been remitted back by the Appointed Person that the opponent made any

reference to section 3(6) of the Act (although I note that reference was made to it at the appeal hearing).

21. The opponent states that his intention was to oppose on section 3(6) grounds all along, but that his representative in Liverpool (McEntegart Legal Limited) did not follow his instruction. I find it highly improbable that a firm of legal representatives would simply ignore an instruction from a client. It is also highly improbable that the opponent would not have seen the letters/forms submitted on his behalf. This raises the question as to why, if it was not his intention, he allowed the proceedings to continue on a false basis for a number of years. This does not make a fertile basis for a request to amend the pleadings so late in the day.

22. I accept that the registrar has discretion to amend pleadings (and to accept further evidence in relation to them), even at this very late stage in proceedings. I also accept that the opponent is currently without legal representation and that trade mark proceedings are not always the easiest to follow. This is why the opponent was sent a number of very clear directions (on 25 November 2016) so that the Tribunal (and the applicant) could clearly and concisely understand the opponent's intentions and what impact they would have on the proceedings. However, the opponent simply did not respond. It only responded when a subsequent letter was sent to it, although that response still did not comply with the directions and it merely contained more of the same (as per the opponent's original letter).

23. Directions were then issued as to how the case would proceed (the original grounds only) but the opponent was given an opportunity to be heard. No request to be heard was made. The only response was more (or similar) of the same. The letter from Mr Gallagher does not assist – he is not a party to the proceedings.

24. The opponent may be of the misapprehension that the Tribunal can simply allow his new ground and accept what he has filed as evidence and then issue a decision in his favour. Whereas, in fact, even if some form of amendment was permitted, time periods would have been required for the other side to amend its counterstatement, for the opponent to file evidence (none of his submissions were in evidential form), for the applicant to be given a chance to file its evidence on the new ground and then for

the opponent to reply. This would then have led to another chance to request a substantive hearing or file submissions in lieu. Effectively, the proceedings would have to start again from scratch.

25. In circumstances where the opponent failed to respond to the Tribunal's directions when first set, together with the fact that he has yet to do so, nor requested a hearing to challenge the preliminary view to proceed upon the basis of the original grounds only, I find that it would be disproportionate and inequitable for the applicant to have to face further delay and give any further credence to the section 3(6) ground. I will proceed on the original grounds only.

26. For the benefit of the opponent, the reference to "grounds" has nothing to do with football (or rugby) grounds. It is a reference to the legal grounds (or reasons) for opposition.

Points to note from the appeal decision

27. Although Mr Hobbs has remitted the case back to the Tribunal for further processing, certain aspects of the proceedings have been resolved on appeal. For example, in terms of the evidence, Mr Hobbs found that that the original hearing officer was wrong to have excluded the opponent's evidence and to treat it merely as submission. Mr Hobbs stated:

"12. I do not agree with the Hearing Officer's determination that the document was disqualified, either for lack of a relevant signature or for lack of a statement of truth with an applicable date, from being filed and treated as the Witness Statement of Mr Francis McEntegart."

28. In terms of Mr Hobbs' decision, it is also useful to record at this stage what he said at paragraph 15 in relation to the abbreviation RFC:

"As illustrated by the evidential material filed on behalf of the Opponent and further as borne out by entries in mainstream dictionaries and moreover as a matter of common general knowledge, the signs in question are indeed apt to

be used and recognised as abbreviations for ‘rugby football club’. At paragraph [25] the Hearing Officer accepted the Applicant’s submission to the effect that in order for the letters **RFC** to function in that way, it is necessary that they be used as a suffix with another identifier preceding the letters. However, this was not an accurate encapsulation of the position: the true position is that the letters **RFC** are apt to be perceived as an abbreviation for ‘rugby football club’ if and when the context and manner in which they are used is, for whatever reason, conducive to them being perceived in that way. As Lord Hoffmann observed in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46 at paragraph [64]: ‘No one has ever made an acontextual statement. There is always some context to any utterance, however meagre’. For the purpose of determining whether a sign is registrable as a trade mark, it is commercial activity in the area(s) of trade encompassed by the wording of the list of goods and services in the application for registration which provides the relevant context.”

29. Thus, the position is that the grounds of opposition must be determined upon the basis that the letters RFC will not only be recognised as an abbreviation for “rugby football club” when accompanied by a preceding word (more often than not a geographical name) but that the letters may also be recognised as the abbreviation for those words when the manner in which they are used are conducive for such a perception to arise.

30. One of the other issues that was resolved on appeal was the effect of the qualification that had been applied to the specification. The original hearing officer found that it was ineffective save in relation to “football clothing” and “kits” in class 25. However, Mr Hobbs said this:

“In my view, the Hearing Officer’s reasoning in this connection is incomplete. The wording of the limitation does not have the effect of confining the list of goods in class 25 of the application for registration to *‘football clothing or “kit” which relates to or promotes soccer’*. With regard to all of the various goods listed in class 25 and not least in relation to *‘clothing’* in the form of *‘polo shirts’* and *‘rugby shirts’*, it sets a puzzle (just as it does with regard to all of the various goods listed in classes 14 and 24) as to what qualifying requirements it places

upon the nature, function or purpose of goods of the kind specified. Do the words '*relating to*' necessarily require '*the aforesaid goods*' to be physically customised in one way or another with respect to '*football (soccer)*'? Should the limitation be read as referring to '*goods relating to ...football (soccer)*' or as referring to '*goods relating to ... the promotion of football (soccer)*' or both? Is the word '*football*' effectively qualified by the word '*soccer*' so as to define a yardstick by reference to which goods relating to or for the promotion of '*football (soccer)*' can be objectively identified and differentiated from goods relating to or for the promotion of '*rugby football*' or other sporting activities or events?

23. Taken together, these considerations lead me to conclude not only that the Hearing Officer was right to find that the wording of the limitations was unacceptable with regard to the totality of the application for registration in classes 14 and 24, but also that it was unacceptable with regard to the totality of the application for registration in class 25. It follows that the Applicant did not add any limitations by amendment to its lists of goods which could be taken to have validly and effectively excluded use of the letters **RFC** in a context and manner conducive to them being perceived as an abbreviation for 'rugby football club'. Therefore, to the extent that the wording of the application (untrammelled by the legally ineffective limitations) encompassed such use of the letters **RFC** in the course of trade in relation to goods of the kind listed in classes 14, 24 and 25, the Opponent's objections to registration had to be examined with due and proper regard for the propensity of those letters to serve as an abbreviation for the words 'rugby football club': see the case law noted in NMSI (above) at paragraphs [12] and [13]."

31. Thus, the scope of my decision must be based upon the specifications as if the qualifications were not there. That said, that does not prevent a further (acceptable) qualification being added or a restriction of some form being made to the specification to overcome any grounds which I decide are *prima facie* applicable, not least due to

the applicability of article 13 of the Directive¹, the effect of which is that I may only refuse an application to the extent that the pleaded grounds apply.

32. Whilst on the subject of qualifications, I can briefly comment on the further amendment put forward for consideration by the applicant, which reads:

“...; all relating to Glasgow Rangers Football Club”

33. Put simply, I regard the above qualification to be no better than the already rejected one. It is not clear how the goods themselves can relate to a specific football club any more precisely than they can relate to football (soccer). Whilst I can see the objective of the qualification, it does not assist and, due to lack of clarity, should not be added to the specification.

The opponent’s evidence

34. As touched on earlier, Mr Hobbs found that the original hearing officer had erred by not considering the opponent’s evidence filed by Mr McEntegart. I must, therefore, take it into account.

35. Mr McEntegart is a barrister at the legal firm which represented the opponent up until the point of appeal. I can summarise his evidence relatively quickly. It shows that the letters RFC are used by a large number of clubs who participate in the sport of rugby. The abbreviation stands for rugby football club, something which I would likely have accepted on the basis of judicial notice in any event. The evidence shows RFC being used as part of the full names of such sporting clubs (e.g. Aberdeenshire RFC, Dundee Wasps RFC and Melrose RFC). There is also some use of the letters as part of longer abbreviations (e.g. GRFC which is an abbreviation for Gala Rugby Football Club). Uses shown in evidence include use in a general sense (relating to the club) but also uses on items of clothing such as sweatshirts, sweaters, shirts, ties, fleeces,

¹ “Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.”

hats, replica jerseys, t-shirts, polo shirts, and, also, other types of club merchandise such as toys, umbrellas and mugs.

36. I should add that when filing his notice of appeal on Form TM55, the opponent filed further evidence consisting of a series of photographs of scarves and similar items which, amongst other insignia, contain the letters RFC. The context is that these are items which have been sold by the opponent, items which are, essentially, sold on the basis of goods for sale to the supporters of Rangers Football Club in order to demonstrate their allegiance to that team. Mr Hobbs did not feel it necessary to deal with this evidence on appeal. However, despite the directions mentioned earlier, no further reference to this material has been made by the opponent. In any event, the evidence does not go to the rugby football objection which I am considering.

Decision – sections 3(1)(b), (c) and (d)

37. These provisions prevent, respectively, registration of trade marks which are “..devoid of any distinctive character”, “..consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services” or “consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade”.

38. Even if a mark falls foul of any of these provisions, there is a proviso to section 3(1) which means that a registration shall not be refused if the trade mark has acquired a distinctive character through use. However, as the proprietor has filed no evidence of use, this is not pertinent. I must simply determine whether the trade mark is, *prima facie*, objectionable under either section 3(1)(b), (c) and/or (d).

39. It must be borne in mind that these grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(b) of the Act. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union (“CJEU”) stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

Section 3(1)(c) of the Act

40. I will begin with the ground under section 3(1)(c) of the Act. This is the equivalent of Article 7(1)(c) of the Community Trade Mark Regulation, the case-law of which was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C- 191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, *inter alia*, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkuniei*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the

same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality,

quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

41. I can deal with this ground relatively briefly. The ground of opposition is pleaded as follows:

"The letters "RFC" are used as an abbreviation to describe the services of rugby/football clubs. The letters have been used as an abbreviation since the late 19th century including with Langholm RFC which was founded in 1871. The letters are used as an abbreviation for rugby/football clubs by hundreds of clubs both professional and amateur to indicate that they are a rugby football club including without limitation Aberdeen RFC....."

42. Thus, even on the pleaded case, it is not even claimed that the abbreviation RFC is used (or is capable of being used) as a description of the goods of the application. Whilst I fully accept that RFC describes the nature of a sporting club, it does not follow that it describes the goods in classes 14, 24 and 25. Even in respect of the worst case scenario (rugby clothing in class 25, which would fall within various of the broad terms listed), I struggle to see what characteristic RFC would be describing. Whilst the word RUGBY would clearly describe a characteristic of rugby clothing – indicating its suitability for use in playing that sport – RFC does not do the same because the letters relate to a club not the sport itself. One would not describe the clothing as suitable for RFC. The ground under section 3(1)(c) is dismissed.

Section 3(1)(d) of the Act

43. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case-law of the CJEU under the equivalent of s.3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably

observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40)."

See also: *Merz & Krell GmbH & Co* [2002] ETMR 21 (CJEU) and *Stash Trade Mark* – BL O/281/04 (AP)

44. The evidence shows use of the letters RFC as a part of a longer name (or part of a longer series of letters). There is no use of RFC alone. Even when the letters are used, in it is not in a manner which designates the goods of the application. It is being used in a manner which designates the nature of the particular sporting club. For a mark to fall foul of the objection it must be the mark put forward for registration that has become customary – RFC alone. If the ground could apply to the use of the trade mark as part of longer expressions then that would render a large number of perfectly good trade marks vulnerable. For these reasons, shortly stated, the objection fails.

Section 3(1)(b) of the Act

45. In terms of section 3(1)(b), this is the equivalent of article 7(1)(b) of the Regulation, the principles of which were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case

C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37).”

46. It is worth pausing briefly to consider again some of the guidance provided by Mr Hobbs where he noted:

“24. The examination had to be stringent and full: Technopol (above) at paragraph [77]. It had to be carried out in relation to each of the goods listed in the application for registration, with collective assessment being appropriate only with respect to goods which are interlinked in a sufficiently direct and specific way to the point where they form a sufficiently homogenous category or group: Case C-597/12P *Isdin SA* EU:C:2013:672 at paragraphs [22] to [30]. The fact that various kinds of goods can, from a commercial point of view, be classified as ‘merchandising goods’ is not sufficient, without more, to enable them to be treated as constituents of a homogenous category or group: Case T-501/13 *Karl-May-Verlag GmbH* EU:T:2016:161 at paragraphs [8] and [64] to [75].

25. The exploitation of name, badge and image ‘rights’ is (and there is an abundance of case law relating to registered and unregistered trade marks demonstrating that it is) a widespread and well-established commercial practice. The limitations added by amendment (albeit legally ineffectively) to the application for registration in the present case are premised upon the proposition that all of the various kinds of goods listed in classes 14, 24 and 25 can be endowed with characteristics that will render them marketable under prevailing marketing conditions as ‘*goods relating to or for the promotion of*’ sporting activities and events. I would not expect the Registrar, with his immense experience of applying trade mark law to real world commercial activities, to dismiss that as an entirely undeliverable proposition. And if, as specifically envisaged by the limitations, it can realistically be regarded as a deliverable proposition, within the coverage of the application, in areas of trading activity linked to ‘*football (soccer)*’, it would be counter-intuitive to assume that it could not also be realistically regarded as a deliverable proposition, within the scope of the application, in areas of trading activity linked

to *'rugby football'*. Thus embracing the likelihood of the letters **FC** functioning commercially as a reference to 'football club' in the name or emblem of an entity trading in the area of goods relating to or for the promotion of *'football (soccer)'* and the likelihood of the letters **RFC** functioning commercially as a reference to 'rugby football club' in the name or emblem of an entity trading in the area of goods relating to or for the promotion of *'rugby football'*.

47. I must, therefore, ensure that I fully consider the objection against each of the goods in question (or a "sufficiently homogenous category or group") and must countenance the probability that if the mark were used on such goods (all of them) in an area of trading activity linked to the sport of rugby football then the letters will be perceived in that commercial setting as a reference to RUGBY FOOTBALL CLUB. However, the question that remains to be answered is whether, in such a setting, the mark RFC will function as an indication of trade origin.

48. Having found that the mark is not descriptive of, or generic for, the goods, the possibility of a sign such as this being devoid of distinctive character is most likely to be on the basis that it will be perceived as indicating a person's allegiance to the sport of rugby – e.g. that he/she is a fan of rugby. This would most obviously be relevant for goods such as t-shirts, hoodies, key rings etc., as such goods are often used for carrying messages of one form or another. However, RFC, as stated earlier, describes the club not the sport. Therefore, whilst signs such as RUGBY or RUGBY FOOTBALL would signify an allegiance to the sport, I have difficulty in accepting that RFC does likewise. I accept that the letters will be known and recognised, but it does not follow that the mark is not capable of performing the essential distinguishing function. Familiarity does not necessarily equate to non-distinctiveness. As I have already said, there is no evidence of RFC being used alone in a rugby football context. The unusualness of seeing the letters alone (without a preceding word or letter) instead of with reference to (as part of) a specific club, and that the letters do not reference the sport per se, suggests to me that the relevant public (even in the context suggested by Mr Hobbs) would regard the mark as a badge of trade origin. It is clearly allusive, but it is still capable of denoting trade origin and will, essentially, be seen as the RFC brand.

49. I acknowledge that the specification covers not just the type of goods mentioned in the preceding paragraph which are apt to carry messages of one form or another, but also goods which have a clear rugby purpose (rugby kit for example). However, even from that perspective, and absent an additional name/letter, I see no reason why the mark would not indicate the trade origin of such goods irrespective of its allusive qualities. Without a preceding name, the letters RFC alone are unlikely to be regarded as part of the formal name of a rugby football club. In that case, the use would be out of its usual context and therefore unusual. Used in that way I see no reason why such a sign would not be taken as a fancy mark designating the goods of a particular undertaking. If, on the other hand, RFC is seen as an abbreviation for Rangers Football Club, as the opponent appears to envisage, then I note that the names of football clubs have been found to be distinctive as trade marks, irrespective of whether they also function as badges of allegiance for fans of the club: see Kerly's Law of Trade Names and Trade Marks 15th Ed. at paras 14-108 and 18-143.

50. I have made the above findings with regard to the particular types of goods as outlined in the preceding two paragraphs. I am mindful of Mr Hobbs comments about ensuring that a full and stringent examination of the ground of opposition is conducted with reference to all of the goods. However, if the opponent cannot succeed with the goods I have mentioned thus far, it is in no better position with regard to the other goods of the application. The ground of opposition under section 3(1)(b) is dismissed.

Outcome

51. The opposition fails. Subject to appeal, the applicant's mark may proceed to registration.

Costs

52. The opponent lost the first decision, but succeeded on appeal. It has now lost again. £800 was originally awarded against the opponent, but this is offset by the successful appeal. In terms of what to award now, I consider the same £800 to be appropriate, in the applicant's favour.

53. I order Mr Russell Campbell to pay The Rangers Football Club the sum of £800 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of July 2017

Oliver Morris

For the Registrar,

The Comptroller-General