

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2130740
BY TOTTENHAM HOTSPUR PLC
TO REGISTER A TRADE MARK
IN CLASSES 6, 9, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 39, 41 & 42**

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER No. 47905
BY PATRICIA HARD O'CONNELL AND MICHAEL O'CONNELL**

**AND IN THE MATTER OF AN APPEAL
TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST THE DECISION OF MR. D. W. LANDAU
DATED 8 APRIL 2002**

DECISION

The application

1. By an application dated 24 April 1997, Tottenham Hotspur plc (“the Applicant”) sought to register the trade mark TOTTENHAM in a number of Classes. The goods and services in Application No. 2130740 as amended are set out in Annex A to this decision.
2. Following its publication on 10 September 1997, Patricia Hard O’Connell and Michael O’Connell (“the Opponent”) filed notice of opposition to the application on 10 December 2002. The Opponent is a match day trader who sells football memorabilia outside Premier League grounds in London and Wembley Stadium. The Opponent has also applied to register the trade mark TOTTENHAM in Classes 6, 24 and 25 but with a later filing date of 8 May 2002.
3. According to the statutory declaration of Michael O’Connell dated 20 May 1999, the Opponent has sold goods bearing the word TOTTENHAM since 1969. Being unable to obtain a licensed pitch from Haringey Council outside Tottenham Hotspur Football Club ground, the Opponent has operated stalls on leased premises in Park Lane, Tottenham and the High Road, Tottenham since 1993 and 1995 respectively. One of the Opponent’s suppliers is Paul Myers. Mr. Myers states that he has been manufacturing and supplying football souvenirs including those with the word TOTTENHAM for 30 years (statutory declaration of Paul Myers dated 20 May 1999). Mr. Myers exhibits examples that predate the application. One is a copy newspaper article picturing Messrs.

Sugar and Venables waving a scarf printed with the word TOTTENHAM at the 1991 FA Cup Final. Anthony O’Gorman is another supplier of football merchandise both official and unofficial. Mr. O’Gorman states that he has sold (unofficial) goods bearing the word TOTTENHAM since 1988/89 (statutory declaration of Anthony O’Gorman dated 20 May 1999) and exhibits a copy catalogue and price list to this effect. The evidence in support of the opposition is completed by a statutory declaration of Reginald Richard Hart dated 19 May 1999. Mr. Hart is the Senior Shops Inspector in the Directorate of Environmental Services for the London Borough of Haringey. Mr. Hart explains that Tottenham makes up about one third of the London Borough of Haringey and is a mixed area of residential and commercial use. Mr. Hart provides an extract from the London Telephone Directory showing businesses that use “Tottenham” as their first name. Mr. Myers adds that Haringey Council supplies souvenir or commemorative items with the word TOTTENHAM on them in order to indicate the origin and to provide an association with the town of Tottenham.

4. The notice of opposition raised various absolute and relative grounds on which it was alleged registration of Application No. 2130740 should be refused. In the event, the Opponent proceeded with only two of those grounds at the hearing of the opposition, namely that the mark should be refused registration under section 3(1)(b) and (c) of the Trade Marks Act 1994 (“the TMA”) which provide:

“The following shall not be registered –

- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which 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.”

5. The Applicant’s evidence in support of the opposed application was not filed in due time. The Registrar’s refusal to the Applicant of an extension of time within which to file such evidence was confirmed on appeal to Mr. Geoffrey Hobbs QC sitting as the Appointed Person on 29 October 2001. The parties do not challenge Mr. Landau’s assumption that as a consequence the Applicant could not pray in aid the proviso to section 3(1) to the effect that at the date of application TOTTENHAM had in fact acquired a distinctive character as a result of the use made of it. Nor do they dispute Mr. Landau’s findings on the Opponent’s evidence that:

- (a) Tottenham Hotspur Football Club is known as Tottenham; and
- (b) TOTTENHAM is well known as a name that is used in relation to the Tottenham Hotspur Football Club.

The Hearing Officer's decision

6. The opposition came to be heard by Mr. D. W. Landau, Principal Hearing Officer, acting on behalf of the Registrar on 26 February 2002. In a written decision dated 8 April 2002, the Hearing Officer dismissed the Opponent's grounds of opposition under section 3(1)(b) and (c) of the TMA.
7. In holding that TOTTENHAM was not devoid of any distinctive character for the goods and services in question, Mr. Landau said:

“26) [The Opponent] argued that the trade mark in suit is devoid of distinctive character in that the goods and services, for which it has been applied, relate to the football club Tottenham Hotspur. [...] [The Opponent] referred me to the following cases: *AD2000* [1997] RPC 168, *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 and *Unilever's Application* [1999] ETMR 406. I am doubtful as to the relevance of these authorities in relation to this issue owing to various decisions of the European Court of Justice and the Court of First Instance which post date them. However, the various authorities do not need to trouble me as I have the good fortune to be able to consider a judgement that deals with the same issues. The issue of the use of the name of a football club as a trade mark was dealt with by Laddie J in *Arsenal Football Club Plc v Reed* [2001] RPC 922 at 942 where he stated [at paragraph 68]:

“I have come to the conclusion that Mr Roughton's alternative argument also fails. He says that any trade mark use of the Arsenal signs is swamped by their overwhelming acquired meaning as signs of allegiance to the football team. Therefore they are not and have never been distinctive. He says that this argument applied with particular force to the word “ARSENAL”. I think this fails on the facts. I do not see any reason why use of these signs in a trade mark sense should not be capable of being distinctive. When used, for example, on swing tickets and neck labels, they do what trade marks are supposed to do, namely act as an indication of trade origin and would be recognised as such. There is no evidence before me which demonstrates that when so used that they are not distinctive of goods made for or under the licence of AFC. The fact that the signs can be used in other, non-trade mark, ways does not automatically render them non-distinctive.”

[The Opponent] argued that the above case was not on a par with the instant case as Laddie J. had evidence before him. However, there is nothing in the above passage that rests upon any evidence that was filed. If one substitutes the name of Arsenal's North London rivals, TOTTENHAM, for ARSENAL in the above passage the question of whether the trade mark in suit is devoid of distinctive character is answered. The answer is that it is not devoid of distinctive character.”

8. As to the objection under section 3(1)(c) that Tottenham is a geographical name, Mr. Landau instructed himself by reference to the relevant part of the ruling of the Court of Justice of the European Communities (ECJ) in *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v. Boots- und Segelzubehör Walter Huber*, Cases C-108/97 and C-109/97 [1999] ECR I-2779:

“1. Article 3(1)(c) of the First Council Directive 89/104/EEC of 21 December 1988 [equivalent to section 3(1)(c) TMA] to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that:

- it does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question; it also applies to geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods;
- where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods;
- in making that assessment, particular consideration should be given to the degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned;
- it is not necessary for the goods to be manufactured in the geographical location in order for them to be associated with it.”

9. In *Windsurfing*, the ECJ noted (at para. 26) the public interest that geographical names remain available “not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response”. That public interest basis for art. 3(1)(c) (section 3(1)(c)) was arguably put in doubt by the later judgment of the ECJ in *Procter & Gamble v. OHIM (BABY-DRY)*, Case C-383/99 [2001] ECR I-6251. However, Mr. Landau reminded himself that more recently in *Koninklijke KPN Nederland NV v. Benelux-Merkenbureau*, Case C-363/99, 31 January 2002, Advocate General Colomer expressed the view that the *Windsurfing* recognition of a certain need to leave free remained valid in Community trade mark law. That need to leave free is not coextensive with the German concept of “Freiheitbedürfnis” – rejected by the ECJ in *Windsurfing*. The objection in

art. 3(1)(c) (section 3(1)(c)) does not depend on there being a real, current or serious need amongst the trade for the word in question to be left free.

10. Having discussed the applicable legal principles, Mr. Landau continued:

“31) I have two issues to consider. Whether TOTTENHAM at the moment is likely to be seen as an indicator of geographical origin and if not whether it would be likely so [to] be seen in the future – does it need to be kept free? The evidence of the opponents demonstrates that TOTTENHAM is well-known as a name that is used in relation to the Tottenham Hotspur Football club. There is nothing in the evidence that indicates that use of TOTTENHAM in relation to the goods and services of the application in suit would be seen as an indicator of geographical origin. Indeed the opposite is the case, the evidence indicates that it is much more likely to be associated with the football club. The evidence suggests to me that that the football fame is likely to subsume any geographical association. The only indications of commercial activity in the locality known as Tottenham are of the vaguest nature. I, therefore, do not consider that at the moment that TOTTENHAM would be seen as an indicator of geographical origin. In considering this issue I take into account what is likely to be the perspective of the average consumer; the practice that the Advocate General advocates at paragraph 41 of *Koninklijke KPN Nederland NV v. Benelux-Merkenbureau*. As the Advocate General and the jurisprudence of the European courts state the average consumer is presumed to be reasonably well-informed, reasonably attentive and intelligent. I do not believe that this average consumer of the goods and services encompassed by the application in suit will see the use of TOTTENHAM as an indicator of geographical origin.

32) In considering the position in the future I must set the issue firmly within the facts before me. I am sure that the European Court of Justice is not expecting competent national authorities to be practising clairvoyance. Tottenham is the name of an area of the borough of Haringey, it is part of a larger entity, which in itself is part of the larger entity of London. As such it is twice removed from the main geographical area of which it forms part. The larger an area – by population and/or size – the more likely that its name might be seen in the future as being an indicator of geographical origin. In the instant case all that I know is that Tottenham is a third borough of Haringey. That it is part of Haringey which in turn is part of London means that its identity is to some extent subsumed by the larger areas. Tottenham’s boundaries are defined, it cannot expand outwards like a city. As an urban area, and also absent evidence, it is unlikely that Tottenham will become a supplier of natural resources such as coal, forestry, metal ores. The future is, therefore, unlikely to see Tottenham gaining renown for the supply of primary products. There is nothing in the evidence to suggest that Tottenham is a large industrial or commercial centre. The area is contained in and contained by the surrounding areas and the development that is already

there. It is far more difficult for an enclosed urban area to change the nature of its economy than for a green field area. There is nothing in the evidence that suggests that the nature of Tottenham is likely to change greatly in the future. All the indicators are that, owing to the nature of the place, it is unlikely to change its industrial or commercial basis other than in limited ways.

33) The evidence of the opponents shows no indication that Tottenham has a concentration of any particular trades or businesses. Nor have the opponents adduced any development plans or the like from the borough of Haringey which indicate that the commercial and industrial base of the area is likely to change e.g. there is no indication that a technology park is being or has been set up.

34) Taking into account the above I can see nothing that indicates that the consideration of TOTTENHAM as a trade mark in the future will be different to any great extent to that at the present. I, therefore, do not consider that TOTTENHAM needs to be left free because of possible use in the future.

35) In reaching these conclusions in relation to section 3(1)(c) I have taken into account that the specification encompasses a wide category of goods and services. However, of key importance to me has been the characteristics of the name. It is not the name of a locality that would naturally lend itself to being seen as an indicator of geographical origin. Indeed, the evidence of the opponents indicates that the first and foremost TOTTENHAM is likely to be recognised as the name of a football club, which happens to be in the locality of that name. I do not believe that the average consumer will see TOTTENHAM as being an indicator of geographical origin. I, therefore, dismiss the ground of opposition under section 3(1)(c)."

The appeal

11. On 7 May 2002, the Opponent gave notice to appeal to an Appointed Person under section 76 of the TMA. The grounds of appeal were in summary stated to be:

Under section 3(1)(b)

- (a) The Hearing Officer took insufficient account of any geographical significance in the word "Tottenham" including the practices of local traders when determining whether the Applicant's mark was devoid of any distinctive character within the meaning of section 3(1)(b).
- (b) In *Arsenal Football Club Plc v. Reed* [2001] RPC 922, the defendant counterclaimed for invalidity of the claimant's ARSENAL registration under section 3(1)(a) of the TMA. The defendant argued that ARSENAL was incapable of distinguishing products of the claimant because it would overwhelmingly be viewed by members of the

relevant public as a badge of allegiance to the Arsenal Football Club. In dismissing the defendant's argument, Laddie J. took into account evidence of the manner of use by the claimant on swing tickets, packaging and neck labels. The Hearing Officer erred in relying on paragraph 68 of the judgment because Laddie J. did not deal with the issue of whether ARSENAL was inherently distinctive for section 3(1)(b) only whether ARSENAL was capable of distinguishing, that is, of being a trade mark within section 3(1)(a). The substitution exercise performed by the Hearing Officer was further unjustified because in *Arsenal* Laddie J. had no cause to consider any geographical significance in the word "Arsenal". In any event, the claimant's evidence of use in *Arsenal* (unlike in the present opposition) would have triggered the proviso to section 3(1) and overcome any objection under section 3(1)(b) on the basis of distinctiveness acquired through use.

Under section 3(1)(c)

- (c) Because of the word "may", it is enough that a word merely denotes a geographical place in order to fall foul of section 3(1)(c) of the TMA. The Hearing Officer applied the wrong test under *Windsurfing*. The ECJ ruled in that case that registration must be refused under art. 3(1)(c) of Directive 89/104/EEC where it cannot be ruled out that the sign of which a mark exclusively consists may in future be used to designate the geographical origin of the products concerned.
 - (d) The Hearing Officer erred in failing to rule on the Opponent's objection that the mark indicates other characteristics of the goods and services namely the allegiance of the bearer of the product to Tottenham Hotspur Football Club. The limitations to the Applicant's specifications reinforce that indication.
12. At the hearing of the appeal, the Opponent was represented by Mr. Ashley Roughton of Counsel. Mr. George Hamer appeared as Counsel for the Applicant. Mr. Roughton informed me that in view of recent case law, the Opponent no longer relied upon its last ground of appeal namely that the Hearing Officer failed to determine whether TOTTENHAM indicates other characteristics of the goods and services in question contrary to section 3(1)(c) of the TMA.

The nature of the appeal

13. The appeal is by way of review of the Hearing Officer's decision only. I should show real reluctance to interfere in the absence of a distinct and material error of principle (*Bessant v. South Cone Inc.* [2002] EWCA Civ 763, 26 May 2002). Nevertheless, in a case such as the present, which involves an evaluation of primary facts that does not absolve me from reconsidering the inferences and conclusions, which the Hearing Officer arrived at (*Assicurazioni Generali SpA. V. Arab Insurance Group (B.S.C.)* [2002] EWCA Civ 1642, 13 November 2002).

Section 3(1)(b) – Arsenal

14. I believe there is substance in Mr. Roughton’s argument that Laddie J. was dealing with a different issue on the counterclaim for invalidity in *Arsenal* namely the nature of the registered proprietor’s use of the mark. In the past it has been difficult to differentiate English tribunals’ discussions of distinctiveness for the purposes of section 3(1)(a) and (b). That may be due to a tendency to treat sections 1(1) and 3(1)(a) of the Act as imposing a separate test for distinctive character of the mark applied for in relation to the specific goods or services (*Philips Electronics NV v. Remington Consumer Products Ltd* [1999] RPC 809, *BACH and BACH FLOWER REMEDIES Trade Marks* [2000] RPC 513 (CA)). The ECJ made clear in *Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd.*, Case C-299/99 [2002] 2 CMLR 1329, paragraph 37 that to the contrary, arts. 2 and 3(1)(a) of Directive 89/104/EEC (sections 1(1) and 3(1)(a) TMA) state a general requirement for distinctiveness to be exhibited by the type of sign in question abstractly and without reference to particular goods or services. The ECJ has not yet ruled upon the issue dealt with by Laddie J. in *Arsenal* whether a registration can be refused or declared invalid under arts. 2 and 3(1)(a) of Directive 89/104/EEC because the use or intended use of a sign is not as a trade mark. Any evidence that Laddie J. might have taken into account for that purpose did not go to any acquired distinctiveness of ARSENAL which in any event would have been irrelevant to section 3(1)(a) of the TMA.
15. Is the Opponent’s appeal advanced by my accepting that Laddie J.’s conclusion on invalidity in *Arsenal* was inappropriate to the present opposition? The answer is no insofar as the Opponent has not sought to argue on appeal that TOTTENHAM is devoid of any distinctive character because it indicates support of Tottenham Hotspur Football Club. The ECJ confirmed in *Arsenal Football Club plc v. Matthew Reed*, Case C-206/01, 12 November 2002 that distinctive character subsists when a sign enables the consumer to distinguish goods and services of the applicant and the applicant is in turn able to guarantee to the consumer the quality of products bearing that sign. The fact that the consumer might be motivated to buy the product to show support for his or her football team does not detract from that distinctive character. Instead, the Opponent argues that Mr. Landau should have taken into account when determining whether TOTTENHAM is devoid of any distinctive character under section 3(1)(b), the nature of the geographical area known as Tottenham and the fact that a number of traders in the area of Tottenham trade by reference to that word. I prefer to return to these criticisms of Mr. Landau’s decision after I have considered the Opponent’s grounds of appeal under section 3(1)(c).

Section 3(1)(c)

16. The Opponent contends that the Hearing Officer applied the wrong test under *Windsurfing*. Mr. Roughton conceded on behalf of the Opponent that there was currently no association in the mind of the relevant public between the geographical name Tottenham and the goods and services in question. In other words Mr. Roughton does not challenge Mr. Landau's application to the

present facts of the first limb of the *Windsurfing* test (set out by the ECJ at paragraph 31 of the Judgment):

"Thus, under Article 3(1)(c) of the Directive, the competent authority must assess whether a geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned."

Mr. Landau's conclusions in particular on Mr. Hart's evidence were that:

"The evidence ... shows but a few names [entries in the London Telephone Directory showing businesses with Tottenham as their first name] and many of those are for clubs and associations rather than conventional businesses. Mr. Hart's comment that Tottenham contains retail and commercial premises tells me very little; most localities could make the same claim. There is no evidence that that Tottenham has a reputation for anything, other than the football team."

Mr. Landau therefore answered the first limb of the *Windsurfing* test in the negative.

17. Mr. Roughton says that TOTTENHAM must nevertheless be refused registration under section 3(1)(c) because:

"Geographical names which are liable to be used by undertakings must remain available to such undertakings as indications of the geographical origin of the category of goods concerned" (*Windsurfing*, paragraph 30).

Mr. Roughton argues that under the second limb of the *Windsurfing* test any geographical name must prima facie be refused registration where it cannot be ruled out that in future the name may be used to designate the geographical origin of the goods and services in suit. Absent acquired distinctiveness, the only type of geographical name that falls outside section 3(1)(c) is one that is purely fanciful in relation to goods or services like North Pole for bananas. Mr. Landau posed the wrong question when he asked whether TOTTENHAM would be likely to be seen as an indicator of geographical origin in the future: Did it need to be kept free?

18. I believe it clear that the ECJ in *Windsurfing* did not intend to confine the class of geographical names that are prima facie registrable under art. 3(1)(c) of Directive 89/104/EEC to purely fanciful geographical names (see the similar view expressed by Mr. Simon Thorley QC sitting as the Appointed Person in *Nordic Saunas Limited Trade Mark* [2002] ETMR 210). When a geographical name is not currently associated in the mind of the relevant consumer with the category of products concerned, the second limb of the *Windsurfing* test requires the competent authority to assess whether it is reasonable to assume that such an association may be established in the future. In performing that objective assessment the competent authority must take into account all the

relevant circumstances in each case including the degree of familiarity amongst the relevant consumer with the geographical name, with the characteristics of the place designated by the name, and with the category of products.

19. Mr. Roughton originally cited no authority in favour of his contention. During his reply at the appeal hearing, Mr. Roughton stated that he wished to rely on paragraph 34 of the ECJ's judgment in *Windsurfing*, which reads:

"However, it cannot be ruled out that the name of a lake may serve to designate geographical origin within the meaning of Article 3(1)(c), even for goods such as those in the main proceedings, provided that the name could be understood by the relevant class of persons to include the shores of the lake or the surrounding area".

20. When paragraph 34 is read in context, it is plain that the ECJ was not restricting the category of permissible geographical names as suggested by Mr. Roughton but merely qualifying its earlier statement that (paragraph 33, emphasis added):

"In that connection [the second limb of the *Windsurfing* test], Article 3(1)(c) of the Directive does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons – or at least unknown as the designation of a geographical location – or of names in respect of which, *because of the type of place they designate (say, a mountain or a lake)*, such persons are unlikely to believe that the category of goods concerned originates there".

21. The Hearing Officer correctly instructed himself as to the first and second limbs of the *Windsurfing* test by reference to paragraph 1 of the ECJ's ruling in that case. It is perhaps unfortunate that when addressing the second limb of the test he paraphrased the relevant question, i.e., whether TOTTENHAM would be likely to be seen as an indicator of geographical origin rather than whether it was reasonable to assume that TOTTENHAM was, in the mind of the relevant consumer, capable of designating the geographical origin of that category of goods and services. Nevertheless, I am satisfied that Mr. Landau had the words of the ECJ firmly in view. In answering the second limb of the *Windsurfing* test, Mr. Landau took into account the familiarity of relevant consumers with the area known as Tottenham, with the characteristics of that area and with the goods and services in question. I did not understand Mr. Roughton to challenge the Hearing Officer's analysis of the Opponent's evidence nor the inferences, which the Hearing Officer drew from that evidence. In those circumstances, I believe that Mr. Landau's findings under section 3(1)(c) must stand.

Section 3(1)(b) – geographical signification

22. Especially since the ECJ decision in *Procter & Gamble v. OHIM (BABY-DRY)*, Case C-383/99 [2001] ECR I-6251, it has been thought appropriate to enquire whether descriptive marks that are not barred from registration under

section 3(1)(c) of the TMA are nevertheless devoid of any distinctive character for section 3(1)(b) (*Cycling IS ... Trade Mark Applications* [2002] RPC 729). That approach was most recently endorsed by Rimmer J. in *HAVE A BREAK Trade Mark* [2002] EWHC 2533 (Ch) although the judge seemed to acknowledge that further enquiry under section 3(1)(b) might be redundant in some cases. I believe the present appeal provides an example of the latter.

23. Mr. Landau held that TOTTENHAM did not presently indicate geographical origin to the relevant consumer when viewed in relation to the goods and services concerned and it was unreasonable to assume that TOTTENHAM would be an indicator of geographical origin in the future. TOTTENHAM was therefore not barred from registration by section 3(1)(c). Mr. Roughton argues that that was not the end of the matter. Mr. Landau should also have considered whether the mark was devoid of any distinctive character for the purposes of section 3(1)(b) because, being the name of a geographical area, it could not acquire secondary meaning for goods and services of the applicant in the absence of use. Mr. Roughton referred me to the Court of Appeal's discussion of section 3(1)(b) in *Philips Electronics NV v. Remington Consumer Products Limited* [1999] RPC 809 at page 818-819, per Aldous L.J. But as Mr. Hamer pointed out, the Court of Appeal was speaking to the example of an entirely different type of mark – WELDMESH – in the context of the relationship between sections 1(1), 3(1)(a) and (b), which was subsequently clarified by the ECJ ruling in that case. I find Mr. Roughton's "geographical" argument under section 3(1)(b) circular. The Hearing Officer held that at the date of application TOTTENHAM neither had nor would have in the mind of the relevant consumer any geographical signification for the goods and services concerned. For the same reasons as I upheld the Hearing Officer's decision under section 3(1)(c), I uphold his decision under section 3(1)(b).
24. The Opponent has not sought to argue either in its grounds of appeal or at the hearing before me that TOTTENHAM is devoid of any distinctive character under section 3(1)(b) because it indicates similar goods, i.e. goods relating to Tottenham Hotspur Football Club produced by unofficial traders. Whether such circumstances are relevant to the absolute grounds of refusal or, as the scheme of the harmonised trade marks legislation suggests, more pertinent to the relative grounds for refusal (which for reasons unbeknown to me were abandoned in the present opposition) remains to be decided on some future occasion.

Conclusion

25. In the result this appeal fails. Mr. Landau ordered that the Opponent should pay the Applicant the sum of £335 in respect of the opposition and I direct that a further sum of £335 be paid to the Applicant towards the costs of this appeal to be paid on the same basis as indicated by Mr. Landau.

Professor Ruth Annand, 6 January 2003

Mr. Ashley Roughton instructed by Lloyd Wise Tregear appeared as Counsel on behalf of the Opponent

Mr. George Hamer instructed by Trade Mark Owners Association Ltd appeared as Counsel on behalf of the Applicant.

ANNEX A

Class 6

Ironmongery, small items of metal hardware; pipes and tubes of metal; safes; emblems for vehicles; signs, nameplates; badges; keys, key blanks, key rings and key chains; locks, ornaments all made of common metals and their alloys; all relating to Tottenham Hotspur Football Club

Class 9

Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; computer programs; computer hardware; computer software; computer firmware; computer software and publication in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); computer software and telecommunications apparatus (including modems) to enable connection to databases and the Internet; computer software to enable searching of data; computer games; video cassettes, audio cassettes, compact discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; sunglasses, goggles, visors; cameras; fire extinguishing apparatus; oven gloves; magnets, fridge magnets; all relating to Tottenham Hotspur Football Club

Class 14

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; watches, clocks; all relating to Tottenham Hotspur Football Club

Class 16

Paper, cardboard; posters, drink mats, stickers, labels, decalcomanias, postcards, picture cards, diaries, notebooks, address books, business card holders, cheque book covers; printed matter; book-binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching materials (except apparatus); calendars, bookmarks; programmes, magazines; coasters, personal organisers; plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks, prints; cigarette cards; pens, pencils; cards, gift tags, wrapping paper; all relating to Tottenham Hotspur Football Club

Class 18

Leather and imitations of leather, and goods made from these materials and not included in other classes; animal skins, hides; bags, holdalls; suit carriers; swim bags, trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; all relating to Tottenham Hotspur Football Club

Class 20

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, and wood substitute or of plastics; embroidery frames; figurines; plaques (made of plastic); lunch boxes; all relating to Tottenham Hotspur Football Club

Class 21

Household or kitchen utensils and containers (not of precious metals or coated therewith); combs and sponges; brushes (except paint-brushes); glassware, porcelain and earthenware not included in other classes; mugs, bowls, plates, saucers, glasses and tankards; figurines; flasks; water bottles; all relating to Tottenham Hotspur Football Club

Class 24

Textiles and textile goods, not included in other classes; bed and table covers, table mats, tea towels, handkerchiefs; towels; pennants, flags; all relating to Tottenham Hotspur Football Club

Class 25

Clothing, footwear, headgear, aprons, hats, scarves, wristbands; suit carriers; belts, bibs; all relating to Tottenham Hotspur Football Club

Class 26

Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; badges; artificial flowers, tea cosies; embroidery kit; all relating to Tottenham Hotspur Football Club

Class 27

Carpets, rugs, mats and matting; linoleums and other materials for covering existing floors; wall papers and wall hangings (non-textile), table mats (non-textile); car mats; all relating to Tottenham Hotspur Football Club

Class 28

Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; teddy bears; toy cars; golf balls; all relating to Tottenham Hotspur Football Club

Class 39

Transport; arranging of travel; travel tour agency services; travel agency services for booking accommodation; rental of vehicles; travel reservations; escorting of travellers; packaging and storage of goods; travel arrangement; all relating to Tottenham Hotspur Football Club

Class 41

Education; providing of training; entertainment; all related to sports; sporting and cultural activities; all relating to Tottenham Hotspur Football Club

Class 42

Provision of food and drink; public house services; bar services; restaurant services; cafeteria, cafe, canteen, snack bar and catering services; accommodation and hotel room booking and reservation services; medical, hygienic and beauty care; legal services; computer programming; providing access to and leasing access time to computer data bases; computer rental; design, drawing and commissioned writing, all for the compilation web pages on the Internet; information provided on-line from a computer database or from the Internet; all relating to Tottenham Hotspur Football Club