

O-057-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2288325
BY WEST HAM UNITED FOOTBALL CLUB PLC
TO REGISTER A SERIES OF TRADE MARKS
IN CLASSES 14, 16, 18, 20, 24, 25, 27, 28 AND 38**

AND

**IN THE MATTER OF OPPOSITION No. 90620
BY PATRICIA HARD O'CONNELL AND
MICHAEL O'CONNELL**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2288325
By West Ham United Football Club Plc to register a
Series of trade marks in Classes 14,16,18,20,24,25,27, 28 and 38**

and

**IN THE MATTER OF Opposition No. 90620
by Patricia Hard O'Connell & Michael O'Connell**

BACKGROUND

1. On 17 December 2001 West Ham United Football Club Plc applied to register the following series of seven marks:

WEST HAM UNITED FOOTBALL CLUB
WEST HAM
WEST HAM UNITED
WEST HAM UTD
WEST HAM UNITED F.C.
WEST HAM UTD F.C.
WEST HAM UTD FOOTBALL CLUB

2. Application was made in classes 14, 16, 18, 20, 24, 25, 27, 28 and 38. Full details of the goods and services requested are given in the Annex to this decision. The application is numbered 2288325.

3. On 24 May 2002 Patricia Hard O'Connell and Michael O'Connell filed notice of opposition to this application. They did so in the following terms:

“1. The marks applied for should be refused protection pursuant to Section 3(1)(b) and (c) of the Act. West Ham is a sizeable area of London and the sign WEST HAM may serve, in trade to designate geographical origin or some form of link or association with the area of West Ham. They are, therefore, lacking in distinctive character.

2. The marks applied for should be refused protection pursuant to Section 3(1)(b) and (c) of the Act to the extent that the application covers goods which bear a badge of allegiance to West Ham Football Club. The marks applied for

may serve, in trade, to designate the fact that such goods bear such a badge of allegiance. They are, therefore, lacking in distinctive character.

3. The marks applied for do not constitute a series and should not, therefore, be allowed to proceed to registration, Section 41(1)(c) of the Act allows for registration of marks in a “series”. Section 41(2) of the Act states what marks can constitute a “series”. The marks applied for do not fall within the definition given in Section 41(2) of the Act as the 2nd; and 1st, 5th, 6th and 7th; and 3rd and 4th marks differ from each other as to their material particulars and as to matter which substantially affect their identities. The addition of “United” to “West Ham” changes the overall impression and meaning of the mark. The further addition of “Football Club” further changes the overall impression and meaning of the mark.

4. The marks applied for should be refused registration pursuant to Section 5(4)(a) of the Act. The Opponents have used the mark WEST HAM BY O’CONNELL since approximately 1995 and use of the plain mark WEST HAM or any of the other marks in the series would be liable to be prevented by virtue of the law of passing off.

5. The marks applied for should be refused registration pursuant to Section 3(6) of the Act. The applicants have no intention to use the marks applied for in a trade mark sense in relation to the goods and services covered by the application. The opponent will either use the marks as badges of allegiance on the goods applied for or will use composite marks which may contain the element WEST HAM or other of the marks contained within this application but will also contain other distinctive elements such as a distinctive device or other distinctive wording.”

4. The applicants denied the above grounds in a counterstatement filed on 13 September 2002.

5. Both sides ask for an award of costs in their favour.

6. Both sides filed evidence. At the conclusion of the evidence rounds a Registry Hearing Officer reviewed the papers and indicated that he considered the matter could be dealt with having due regard to the statutory provisions and the relevant jurisprudence and without the need for oral submissions. The parties were nevertheless reminded of their right to be heard or to offer written submissions. Neither side has asked to be heard or filed written submissions though a substantial part of the applicants’ evidence is in effect submissions. Acting on behalf of the Registrar I give this decision.

7. The evidence in the case is as follows:

Opponents’ evidence in chief:

Witness Statement of Sarah Kate Szell

Exhibits SKS1 – SKS3

Applicants' evidence in response:

Witness Statement of Robert James Hawley

Exhibits RJH1 – RJH11

8. Ms Szell was the opponents' professional representative at the time the evidence was filed. Mr Hawley is the applicants' professional representative. The opponents' evidence is very limited in scope and deals with West Ham's significance as a geographical area including in a business context. The applicants' evidence focuses on decisions in other cases involving the names or indicia of football clubs including an unrelated action between the current opponents and Tottenham Hotspur Plc. Mr Hawley's evidence also goes to support the claim that the fame of WEST HAM as a football club subsumes any geographical indication. I will deal with the evidence in rather more detail in considering the individual grounds of objection below.

9. Section 3(1)(b) & (c)

3.-(1) The following shall not be registered -

- (a)
- (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,
- (d)

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

10. Two objections are raised under this head, firstly that the marks simply designate geographical origin (that is to say the area known as West Ham) and secondly all the marks will simply be seen as badges of allegiance to the football club. On both accounts the marks are said to be lacking in distinctive character.

11. By way of general comment on the opponents' grounds it will be noted that the statement of grounds generally refers to 'marks' which I take to mean a reference to all seven marks of the series and that the opponents consider that their objections apply with equal force to each and every mark. In relation to the geographical origin objection the opponents appear to recognise that it only arises in relation to the second mark in the

series though, somewhat confusingly, they ask that all the marks be refused. I propose to consider the objection against the mark WEST HAM solus. Section 3(1)(c) deals with marks which consist exclusively of signs or indications that may serve to designate geographical origin. That cannot be said of the other 6 marks in the series.

12. This is the only ground of opposition in relation to which the opponents have filed evidence. It consists of:

- SKS1- the results of an internet search for companies called “West Ham” in London. Ms Szell says that it shows the words being used in the name of a number of businesses as an indicator that these businesses are located within the area of West Ham;
- SKS2- pages from the website www.newham.info designed by or on behalf of the Chief Executive’s Department at Newham Town Hall and giving information on the area of Newham which incorporates West Ham;
- SKS3- pages from the website www.neighbourhood.statistics.gov.uk giving various statistics for areas including West Ham. Ms Szell notes that this shows the resident population of the area of West Ham to have been in the order of 8,000 in mid 1998.

13. Mr Hawley’s evidence for the applicants deals with the objection itself and the above evidence in two ways. Firstly, I have been referred to the decision of a Registry Hearing Officer and the Appointed Person on appeal in a case involving the mark TOTTENHAM which also involved the O’Connells as opponents and where similar issues arose. I will deal with the outcome of that case and its relevance below. Secondly Mr Hawley exhibits (RJH 5 to 9) the results generated from enquiries using a variety of commonly-used and widely available internet search engines in relation to the name West Ham.

14. The decisions referred to above involving the mark TOTTENHAM applied for by the football club can be found under reference BL O/150/02 (the Registry Hearing Officer’s decision) and BL O/024/03 (the Appointed Person’s decision on appeal). It was accepted in each case that the correct starting point for considering the issue of geographical names was 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.”

15. It is clear from this judgment that Section 3(1)(c) of the Act (Article 3(1)(c) of the Directive) applies both where the name designating a place is in the minds of the relevant public already associated with the goods and also where it is liable to be used in the future by undertakings to indicate the geographical origin of their goods or services.

16. To assist in applying these principles Mr Hawley has referred me to the following passage from Mr Landau’s (the Registry Hearing Officer) decision as referred to by the Appointed Person:

“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 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 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 of the 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 that suggests 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).”

17. Mr Hawley submits that the logic and outcome of the above can effectively be transposed to this case. In effect he says that I can substitute WEST HAM for TOTTENHAM in paragraph 31.

18. On the face of it the opponents have submitted a good deal less evidence in this case. I turn to the material exhibited to Ms Szell’s evidence. Much of the content of SKS1 has nothing to do with West Ham at all. The ‘business finder’ search conducted against the name has thrown up several pages of West Hampstead (or West Hamstead) references. Of the other entries a number are, or relate to, the football club. The remainder consist of schools, a park, a vicarage, a museum, a cemetery, a local Conservative Association, a fish bar, a TV and video shop and a hotel. Only the last 3 appear to be conventional businesses and are in essence local services. There is nothing in this part of the opponents’ evidence that suggests WEST HAM is currently used to designate goods of the kind applied for.

19. Exhibits SKS2 and 3 place West Ham in context as a ward within the London borough of Newham. There is some information on the history, culture and development of the borough but little if anything that tells me about the industrial base (past, present or projected) of West Ham itself. The Hearing Officer in the Tottenham case observed that that area did not appear to be noted as a significant industrial or commercial centre and that there was nothing to indicate that that position was likely to change. The same can be said of West Ham. Moreover, if the information in SKS3 is taken at face value, the area of West Ham is relatively small (population of 8,000 in 1998, 1,500 jobs in 1998 and 125 VAT registered enterprises at March 2000).

20. In considering whether the name of a particular location is liable to be used in the future as an indication of geographical origin for goods or services I do not believe it was the intention of the ECJ to suggest that the mere fact that it may be possible to produce or trade in goods from a particular location should be sufficient to found an objection to registrability. There must be a reasonably foreseeable likelihood that such circumstances will arise. Hence the guidance in *Windsurfing Chiemsee* that 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 the name, and with the category of goods concerned”.

21. The list of goods and services applied for is an extensive one and the opponents have not addressed individual items in the specification or put it to me that the mark may be registrable for some items but not others. I can see no basis for objection in relation to the vast majority of items in the specification. There is a limited exception to the generality of that finding. In relation to the mark WEST HAM it seems to me that it is the natural and apt term to use in relation to a local newspaper serving the community and that the mark is objectionable to that extent in relation to ‘newspapers’ and the broad term

'printed matter' which encompasses that narrower term. The words would also appear to be entirely descriptive of the subject matter of 'books', 'photographs', 'prints' and 'pictures' which may be of the area concerned.

22. Objection has also been taken under Section 3(1)(b) linked to West Ham's significance as a geographical location. The point has not in my view been properly explained, I note that in Professor Annand's decision on appeal in the Tottenham case she dealt with geographical signification under Section 3(1)(b) as follows:

"22. Especially since the ECJ decision in *Proctor & 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. I am not aware that any separate ground of objection is available to the opponents based on geographical signification beyond the point considered above in relation to specific goods.

24. The second basis on which the opponents object under Section 3(1)(b) and (c) goes to the claim that the application covers goods which bear a badge of allegiance to West Ham Football Club. Thus, it is said, "the marks applied for may serve in trade to designate the fact that such goods bear such a badge of allegiance" and are lacking in distinctive character. Again a similar point was considered in the Tottenham case. The Hearing Officer noted that:

"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 recognized 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 license of AFC. The fact

that the signs can be used in other, non-trade mark, ways does not automatically render them non-distinctive.”

25. On appeal the Appointed Person also noted that:

“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.”

26. Accordingly, the fact that a sign may serve as a badge of allegiance does not in and of itself mean that it is lacking in distinctive character. However, whilst I reject the generality of the opponents’ attack on this account it seems to me that the objection on distinctiveness grounds is not without merit in a narrow respect in relation to the 6 marks in the series which are clearly indicative of the football club rather than the area. The objection arises in relation to those items which may be about, or may relate to, the club itself. In particular I have in mind ‘printed matter’, ‘magazines’, ‘books’, ‘photographs’, ‘posters’ (mentioned twice in the specification), ‘calendars’, ‘prints’, ‘pictures’, ‘poster magazines’, ‘stickers’ and ‘decalcomanias’. It seems to me that this group of goods can be distinguished from other items of merchandising in that the name WEST HAM UNITED FOOTBALL CLUB (and its variants) used in relation to such goods would do no more than describe the content or subject matter. As this case has not been the subject of a hearing or written submissions I have not had the benefit of the parties’ views on whether the above list of goods should be further extended or refined. It, therefore, represents my own appraisal of the scope of the objection. I will deal with the consequences later in the decision.

Section 3(6)

27. Under Section 3(6) of the Act “a trade mark shall not be registered if or to the extent that the application is made in bad faith”.

28. There appear to be two legs to the opponents’ claim. The first is based on a lack of intention to use the marks applied for in relation to the goods and services concerned. Alternatively it is said that the mark applied for will be used with other distinctive elements. The second is in part an attempt to re-run the badge of allegiance argument considered above within the context of a bad faith claim.

29. I do not propose to repeat the points already made in relation to badges of allegiance. Furthermore, the claim that the applied for marks will be used with other distinctive matter seems to be posited on the presumption that the marks applied for are not themselves distinctive. The latter has not been shown to be the case (save to the extent identified above) and I have no reason to suppose that the marks will not be used on their

own or, even if they are on occasions used with other matter, that that constitutes a valid basis for an objection under Section 3(6).

30. The other claim is that the applicants have no intention to use the marks in relation to the goods and services. The claim is, I assume, based on Section 3(6) read in conjunction with Section 32(3). No specific evidence or argument has been advanced in support of the objection. The most that can be said is that the applicants have put forward a very extensive range of goods and services. Equally, it is no secret that football clubs, particularly the well known ones, have a substantial trade in merchandising. Mr Hawley has also reminded me that the necessary declaration has been made on the application Form TM3 confirming that the mark is being used or that there is a bona fide intention that it shall be used. In all the circumstances I can see no basis for a finding of bad faith.

Section 5(4)

31. The objection under this head is based on the law of passing-off and use of the mark WEST HAM BY O'CONNELL since 1995. However, as no evidence of use has been filed the objection does not get off the ground as no protectable goodwill has been demonstrated.

Section 41(2)

32. The final issue is whether the applied for marks constitute a series.

33. Section 41(2) reads:

“(2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

34. I understand from the punctuation used by the opponents (with a semi-colon after ‘2nd’ and ‘7th’ in the relevant paragraph of their grounds) and the subsequent elaboration of the objection that they regard the mark WEST HAM as being in a category of its own and that they also regard the marks WEST HAM UNITED and WEST HAM UTD as not being a series with the four FC/FOOTBALL CLUB marks.

35. Mr Hawley's evidence deals with the point in two ways. Firstly he says that Section 41(2) is not a valid ground for refusing to register a mark being neither an absolute nor a relative ground. Secondly, he in any case refutes the suggestion that it is not a series. He offers no detailed reasoning for this view but notes that the Registry's examiner did not raise the objection. He also comments on the consequences of an adverse finding on the point. I will deal with this separately below.

36. The provisions relating to series of marks are not derived from the Council Directive (89/104). They are purely part of the domestic law. The provisions have been considered in some detail in recent decisions of the Appointed Persons on appeal from ex parte

refusals by the Registry – see, particularly Logica’s application BL O/068/03, Digeo Broadband Inc’s application BL O/305/03 and Gateway Inc’s application BL O/322/03. The appeals in those cases proceeded on the basis that the Registrar was fully entitled to raise objections to claimed series if he considered that the qualifying criteria were not met.

37. I am aware of only one case where a series issue has been considered on appeal in an inter partes action. This occurred in *Dualit Ltd’s Trade Mark Applications* [1999] RPC 890 where Lloyd J appears to have accepted that series objections can both form the substance of an objection and can in principle be considered in the context of an opposition because his observations were in essence directed at the procedural mechanisms available for dealing with the matter. I do not detect in these decisions from appeal tribunals any concerns about the vires for, or correctness of, considering objections on series grounds. To the extent, therefore, that the applicants claim that Section 41(2) is not a valid ground for refusal I reject it.

38. The Registry Practice Amendment Notice dealing with applications to register a series of trade marks (PAN 1/03) contains the following:

“3. In *Logica’s Trade Marks* [BL O/068/03] Professor Ruth Annand as the Appointed Person stated that Section 41(2) of the Act contains three conditions. She said that:

“First, the marks in the series must resemble each other in their material particulars. Second and third, the differences between the trade marks must not comprise matter, which when considered:

(a) *as a separate element of the trade mark would be regarded as having distinctive character;*

and

(b) *in the context of the trade mark as a whole, substantially affects the identity of the trade mark.”*

4. The over-riding requirement is that the differences between the marks does not substantially affect their identity. The test is NOT simply whether the marks in the series would be regarded as confusingly **similar** to each other if used by unrelated undertakings. Any variation in the non-distinctive features in the marks must leave the visual, aural and conceptual identity of each of the trade marks substantially the **same**. Further, it is not enough for marks to share the same conceptual identity if there are substantial differences in the visual or aural identities of the marks. The matter must be assessed by reference to the likely reaction to the marks of an average consumer of the goods/services in question.”

39. Applying these principles to the seven marks before me I have little hesitation in singling out the WEST HAM mark as not constituting a series with the other 6 marks. West Ham may be an abbreviation of the name of the football club but it is equally and more obviously the name of a district or ward in the London borough of Newham. In circumstances where one mark may mean a geographical area and the others a football club it seems to me an inescapable conclusion that the identity of the trade mark has been affected.

40. I find it less easy to say whether the remaining six marks can be considered a series. I accept for present purposes that UTD is a reasonably common and well understood abbreviation for UNITED and that FC is an accepted abbreviation for football club.

41. On that basis I regard WEST HAM UNITED FOOTBALL CLUB, WEST HAM UNITED F.C., WEST HAM UTD F.C. and WEST HAM UTD FOOTBALL CLUB as a series. The more difficult issue is whether WEST HAM UNITED and WEST HAM UTD can legitimately be placed in the same series. The absence of an overt reference to FOOTBALL CLUB or F.C. may be said to cast doubt on the matter. On the other hand I am not aware that either of these two marks would be taken to mean anything other than the club so with some hesitation I am prepared to accept these marks also form a series with the other four.

42. I have found that the series objection is partially successful. It is clear from the Appointed Person's decisions in BL O/305/03 and BL O/322/03 that the appropriate course in these circumstances is to refuse acceptance of the application under Section 41(2) of the Act and Rule 31(1) of the Trade Marks Rules 2000. However the applicants must be given an opportunity to deal with the consequence of the decision. That brings me to the procedure available to an applicant to do so at this stage. Rule 21(2) and (3) reads as follows:

“(2) At any time before preparations of publication of the application have been completed by the Office, the applicant under paragraph (1) above may request on Form TM12 the division of the application into separate applications in respect of one or more marks in that series and the Registrar shall, if she is satisfied that the division requested conforms with Section 41(2), divide the application accordingly.

(3) At any time the applicant for registration of a series of trade marks or the proprietor of a registered series of trade marks may request the deletion of a mark in that series, and the Registrar shall delete the mark accordingly.”

43. As by definition an opposed case has passed through the publication stage the option of dividing the application under Rule 21(2) is no longer available to the applicants. Nor is it open to the applicants to achieve a similar result by using Rule 19(1) (see *Dualit Ltd's Trade Marks Application* [1999] RPC 890 at paragraph 56). Under Rule 21(3) it remains open to the applicants to delete a mark or marks so as to leave either the mark WEST HAM or the series of six “football club” marks identified above.

44. I have also found that the WEST HAM mark and the “football club” series of marks attract separate objections in relation to certain items in the Class 16 specification. Depending on how the applicants choose to proceed they will also need to file a Form TM21 deleting the goods concerned from the specification.

45. Accordingly, the application will be allowed to proceed in accordance with the above options if, within 28 days of the expiry of the appeal period from this decision, the applicants file the necessary Form TM21 amending their specification and elect to proceed in relation to either the mark WEST HAM or the series of 6 “football” club marks. In doing so the applicants should take particular note of the findings contained in paragraphs 21 and 26 above. If no Form TM21 is filed within the period set and no election is made in relation to the marks the application will be refused in its entirety. If an appeal is filed the period for filing the Form TM21 and making the necessary election in relation to the marks will be 28 days from the final determination of the case.

COSTS

46. The opponents have achieved a small measure of success. But the applicants will have preserved the bulk of the applied for goods and services. In the circumstances I propose to make an award of costs which reflects as best I can the applicants’ relatively greater success but falling short of a full award. I order the opponents to pay the applicants the sum of £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of March 2004

**M REYNOLDS
For the Registrar
the Comptroller-General**

NO ANNEX ATTACHED