

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2356798B
IN THE NAME OF MR KEVIN SCRANAGE**

**AND IN THE MATTER OF AN APPEAL
TO THE APPOINTED PERSON
AGAINST THE DECISION OF MR R. A. JONES
DATED 21 JUNE 2007**

DECISION

Introduction

1. By an application dated 26 February 2004 under number 2356798, Mr. Kevin Scranage requested registration of THERE AIN'T NO F IN JUSTICE for use as a trade mark in respect of the following goods and services:

Class 25

Clothing, footwear, headgear

Class 35

Advertising; business management; business administration; office functions

Class 36

Insurance; financial affairs; monetary affairs; real estate affairs

2. The Examination Report, dated 15 April 2004, raised an objection against the entire application under section 3(3)(a) of the Trade Marks Act 1994 on the ground that THERE AIN'T NO F IN JUSTICE contravened accepted principles of morality.
3. The mark was additionally objected to in Class 25 only under section 3(1)(b) and (c) of the Act: "because the mark consists exclusively of the words THERE AIN'T NO F IN JUSTICE, being a sign which may serve in trade to designate the intended purpose of the goods e.g. t-shirts that display a slogan which express the views of the wearer. It is felt that this mark is not capable of distinguishing the goods of one trader from another and therefore is not acting as a badge of origin."

4. There followed a hearing and substantial correspondence between Mr. Scranage and the Registry on the subject of accepted principles of morality. In the result, by a letter dated 7 April 2006, the Registry informed Mr. Scranage that the section 3(3)(a) objection had been waived.
5. The Registry's letter of 7 April 2006 also impliedly waived the objection in Class 25 under section 3(1)(c) of the Act¹. Moreover, the objection in Class 25 under section 3(1)(b) was limited to: "T-shirts, baseball caps and the like". Mr. Scranage was invited to submit a revised Class 25 specification.
6. In a subsequent round of correspondence, the Registry elaborated on its viewpoint (letter to Mr. Scranage, dated 25 April 2006): "whilst it is likely that the statement THERE AIN'T NO F IN JUSTICE would work as a brand in the neck label of a garment, notional and fair use of the mark also covers use emblazoned across the front of garments, and it is in this context that the mark is considered to lack distinctive character for the goods detailed previously". Mr. Scranage was sent a copy of the Registry's Practice Amendment Notice 1/06 concerning the Examination and Classification practice about Slogans issued on 5 January 2006 and his attention was drawn to the following paragraph in that PAN²:

"32.1.11 Statements by/about the user of goods/wearer of clothing

Slogans such as "I ♥ My Boy Friend" or "Here comes Trouble" are often used to decorate goods, particularly clothing – T-shirts, sweatshirts or baseball caps. In this context, consumers are unlikely to perceive this type of slogan as a sign of trade origin. When seen on the front of a T-shirt, a mug, a necklace or a keyring, for example, they are likely to be seen as a personal statement by/about the wearer/user rather than indicating the trade origin of the product. Slogans which are likely to be seen as such will therefore be open to objection under Section 3(1)(b) of the Act.

Where it is equally or more plausible that such a slogan is capable of being seen as a fancy trade mark, such as "Lanky Bird", no objection should be raised on this ground. If the mark is not subsequently used as a trade mark it will become liable to revocation for non-use."

7. There was a second hearing on 13 November 2006, at which the section 3(1)(b) objection was maintained in respect of: "tee shirts, sweatshirts and baseball caps".
8. Mr. Scranage opted to divide his application and THERE AIN'T NO F IN JUSTICE proceeded to registration on 29 June 2007 under number 2356798A in relation to the unobjectionable goods and services in Classes 25, 35 and 36. The Class 25 specification of Registration number 2356798A covers:

¹ Confirmed on appeal, transcript, p. 3, lines 20 – 23.

² In fact the letter referred to para. 32.1.1, which was in the context clearly a typographical error. Mr. Scranage realised that 32.1.11 was the relevant paragraph (his letter to the Registry, dated 16 May 2006).

“Clothing, footwear and headgear; but not including tee shirts, sweat shirts and baseball caps”.

9. On 29 June 2007, Mr. Scranage filed notice of appeal to an Appointed Person under section 76 of the Act against the decision of the Hearing Officer, acting for the Registrar (BL O/177/07), to refuse the second part of the application, numbered 2356798B, for registration of THERE AIN'T NO F IN JUSTICE in relation to tee shirts, sweatshirts and baseball caps. At the hearing of the appeal before me, Mr. Scranage appeared in person and Dr. Bill Trott represented the Registrar.

The Hearing Officer's decision

10. After noting that section 3(1)(b) precludes the registration of trade marks, which are devoid of any distinctive character, the Hearing Officer referred to the guidance of the Court of Justice of the European Communities (“ECJ”) in Joined Cases C-53/01 to C-55/01 *Linde* [2003] ECR I-3161, paras. 37, 39 – 41 and 47:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods or services of one undertaking from those of other undertakings.

[...]

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning 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 products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

[...]

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

11. The Hearing Officer also referred to the Registrar’s examination practice on slogans at Chapter 3 of the Trade Marks Registry Work Manual, para. 32 (corresponding to PAN 1/06):

“32 Slogans

Slogans are registrable as trade marks provided they have the capacity to individualise the goods or services of one undertaking because they are not comprised of signs or indications which directly describe the goods or services or their essential characteristics, and are not devoid of distinctive character for any other reason.

In ‘Das Prinzip Der Bequemlichkeit’ [“The Principle of Comfort”] C-64/02 P, the ECJ stated that slogans serving a promotional function which is not obviously secondary to any trade mark meaning will be objectionable because:

“ ... average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans” (paragraph 35).

Whilst confirming that there is no justification for applying stricter examination criteria to slogan marks, the ECJ confirmed that slogans may fall alongside other non-conventional trade marks in being a category of mark that the relevant public is slower to recognise as indicating the product of a single undertaking.

However, that is not to say that a slogan has to contain an additional element of imagination or an additional element of originality to be acceptable; in fact, the ECJ expressly said such criteria should not form part of the assessment of a slogan’s capacity to distinguish the goods of one undertaking from those of another.

Slogans are, by their very nature, adapted for use in advertising and examination should take full account of notional and fair use in that context. It should be borne in mind that the absence of use of the slogan (or similar) by unrelated parties (e.g. during a search of the Internet), does not, in itself, mean that the mark is acceptable (that would be the focus of 3(1)(d), see the above decision, paragraph 46).”

12. Given that the application concerned tee shirts, sweat shirts and baseball caps the Hearing Officer took particular account of the Registry’s additional guidance provided at Chapter 3, paragraph 32.1.11 (reproduced earlier in this decision at paragraph 6).

13. Finally the Hearing Officer referred indirectly to certain passages in the judgment of the ECJ in Case C-64/02 P *OHIM v. Erpo Möbelwerk GmbH (DAS PRINZIP DER BEQUEMLICHKEIT)* [2004] ECR I-10031³. I believe that is helpful here to set out those passages in full:

“33. It is clear from the case-law of the Court of Justice that, as far as assessing distinctiveness is concerned, every trade mark, of whatever category, must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings (see, to that effect, in relation to Article 3(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), which is identical to Article 7(1)(b) of Regulation 40/94, *Linde and Others*, paragraphs 42 and 47).

34. The Court of Justice has also held that, although the criteria for assessing distinctiveness are the same for the various categories of marks, it may become apparent, in applying those criteria, that the relevant public’s perception is not necessarily the same for each of those categories and that, therefore, it may prove more difficult to establish distinctiveness for some categories of mark than for others (see Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraph 38; Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble v OHIM* [2004] ECR I-0000, paragraph 36; and Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] ECR I-0000, paragraph 36).

35. The possibility cannot be excluded that the case-law mentioned in the foregoing paragraph of this judgment is also relevant to word marks consisting of advertising slogans such as the one at issue in this case. That could be the case in particular if it were established, when assessing the distinctiveness of the trade mark in question, that it served a promotional function consisting, for example, of commending the quality of the product in question and that the importance of that function was not manifestly secondary to its purported function as trade mark, namely that of guaranteeing the origin of the product. Indeed, in such a case, the authorities may take account of the fact that average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans (see, to that effect, *Procter & Gamble*, paragraph 36).”

14. The Hearing Officer’s conclusions on how the mark was likely to be perceived by the average consumer, accepted to be the general public, in relation to goods in question were as follows:

“16. Firstly, taking the slogan itself, it appears to be a statement about the justice system, arguing that there is no justice. The double

³ Through an earlier decision of mine in *YOU WON’T BELIEVE YOUR EYES*, BL O/010/06, para. 11.

entendre of 'F IN' in place of the somewhat allusively vulgar expression "effing" is not particularly new. By way of example, from my own knowledge as a follower of football I became familiar, many years ago, with the fans' chant 'There's only one F in Fulham'. I do not think there is, therefore, anything about the use of 'F IN' in this way which, of itself, is capable of sending the message that the mark is anything more than a moral statement. The message will be self evident to the average consumer who, as I indicated earlier, is likely to see it as a statement criticising the justice system.

17. Secondly, I must consider normal and fair use of the mark applied for on the goods at issue. If used on a label on the goods the reaction to the sign is, in my view, likely to be ambiguous since labels are often used to indicate trade origin. However, for the goods covered by the present application I consider normal and fair use would include placing the sign on the exterior of the goods. I consider it is a matter of public knowledge that this is standard practice in the trade. Some tee-shirts, sweat shirts and baseball caps carry the 'designer' name prominently. It is easy to recognise brands like Nike or Reebok as indicators of origin even when used in this way. However, slogans used as trade marks are not always easy to identify as such when used as what appears to be decoration. This is because for many years the public has chosen to put personal statements on their tee-shirts, sweat shirts and baseball caps. 'Ban the Bomb', 'Kiss me Quick', 'Stop the Iraq War' have been seen across tee-shirts, sweat shirts and baseball caps on any high street and, in my view, are unlikely to be seen as indicators of trade origin by the average consumer. I consider the mark at issue to fall into the same category. The public are likely to see the slogan, when used in this way, as a statement by the wearer about the justice system, unless educated to the idea that it is an indicator of trade origin through use. Therefore, with reference to the guidance above [32.1.11], I do not consider it 'equally or more plausible' that this slogan is likely to be seen as a 'fancy trade mark'.

18. I do not consider that other forms of clothing such as suits, dresses, trousers, pullovers and most headgear are usually decorated in the same way. Consequently, the public has not been educated to the probability that moral statements appearing on the goods are likely to be just decoration. Nor are they usually used as message carriers by the public. It is for this reason that that the other items of clothing have been allowed to proceed to publication in the other divisional part of the original application.

19. Use in advertising is also likely to be seen as a moral statement on the goods, intending to attract those who wish to associate with the sentiments expressed. Therefore, the statement is, in my view, unlikely to be seen as an indicator of trade origin by the average consumer.

20. In my view, the mark applied for will not be seen as a trade mark without first educating the public that it is one. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from acceptance, prima facie, under Section 3(1)(b) of the Act.”

Arguments on appeal

15. Mr. Scranage, who is after all a member of the general public, fails to comprehend why his trade mark should be considered distinctive for clothing, footwear and headgear generally but non-distinctive for tee shirts, sweat shirts and baseball caps specifically. He regards as fatally flawed the argument that his mark is capable of being an indication of origin in relation to the former but not the latter. At the hearing he demonstrated his point graphically by producing a range of different clothing and hats.
16. Mr. Scranage acknowledges that his mark originates from his own personal experience of the justice system. He remarks that if he or anyone else wished to express that personal opinion (by writing it across a tee shirt or otherwise) they would be free to do so. By contrast, he stresses that his aim in seeking registration of THERE AIN'T NO F IN JUSTICE is to establish a brand identity under the mark in the goods in question. He points to the grammatical correctness of his designation, i.e., its double entendre. He relies on the final sentences of paragraph 32.1.11, Chapter 3 of the Registry Work Manual:

“Where it is equally or more plausible that such a slogan is capable of being seen as a fancy trade mark, such as “Lanky Bird”, no objection should be raised on this ground. If the mark is not subsequently used as a trade mark it will become liable to revocation for non-use.”
17. Dr. Trott on the other hand defends the Hearing Officer’s decision especially the Registry practice at 32.1.11. He referred to the ECJ decision in *Erpo* (see para. 13 above), which he regards as having wider import than for advertising slogans only. He observed that there is a great deal of confusion among registries in the world concerning the acceptability of slogans in particular cases. As I understood him, he believes the key lies in the strength of the message (advertising or more generally) contained in the slogan.
18. Regarding 32.1.11, Dr. Trott says that notional and fair use would include use on the exterior of goods, here across the front of tee shirts, sweatshirts and baseball caps. Although he accepted that notional and fair use would also include use on labels or swing tickets, he remarked that one had to consider the worst case (i.e., use on the front of tee shirts etc.). There was no authority but this (worst case) was a rule of thumb, which the Registry applied⁴.

⁴ Transcript, p. 8, lines 22 – 25 and p. 9, lines 1 – 8.

Merits of the appeal

19. The ECJ has consistently held that the test for distinctive character is the same across the various categories of signs of which trade marks can consist. The question to be addressed is whether consumers would identify goods or services marketed under the trade mark as originating from a particular undertaking. In the case of goods intended for the general public (including tee shirts, sweatshirts and baseball caps), the relevant consumer is deemed to be reasonably well informed and reasonably observant and circumspect. No different or additional criteria are to be employed depending on the type of trade mark in suit (see, e.g., Case C-144/06 P, *Henkel KgaA v. OHIM*, 4 October 2007, paras. 34 – 36, Case C-329/02 P, *SAT.1 SatellitenFernsehen GmbH v. OHIM* [2004] ECR I-8317, para. 24).
20. Nevertheless, the ECJ has recognised that with certain types of trade marks including those consisting of advertising slogans it may be more difficult to establish distinctive character because the public is unaccustomed to making assumptions about the origin of products based on those types of signs (see *Erpo*, paras. 34 – 35, and the cases referred to therein and Case C-104/02, *Nichols plc v. Registrar of Trade Marks* [2004] ECR I-8499, para. 28).
21. However, both the ECJ and the Court of First Instance (“CFI”) have cautioned against over-extensive application of that recognition as it can result in *a priori* refusal of registration to certain categories of trade marks (*Nichols*, para. 29, Case T-460/05, *Bang Olufsen A/S v. OHIM*, 10 October 2007, paras. 21 and 38 – 45, Case T-441/05, *IVG Immobilien AG v. OHIM*, 13 June 2007, para. 40).
22. Instead the capacity of the mark to distinguish must be specifically assessed in any particular case. Thus, in *IVG*, which concerned an application to register a Community trade mark consisting of a single letter “I”, the CFI said (para. 42):
“It was therefore appropriate in the present case to examine, in the context of a specific examination of the potential capacity of the sign proposed for registration, *whether there appeared to be no possibility* that that sign may be capable of distinguishing, in the eyes of the public to which it is addressed, the goods or services referred to from those of a different origin (*EASYBANK*, paragraph 17 above, paragraph 40), since a minimum degree of distinctiveness is sufficient to prevent application of the absolute ground for refusal provided for in Article 7(1)(b) of Regulation 40/94 [the equivalent to section 3(1)(b) of the Act] (*Torch shape*, paragraph 17 above, paragraph 34)” (emphasis added).
23. In another context (registration of famous names), this tribunal has queried the Registrar’s practice of drawing a distinction between goods on the basis of their perceived message or image carrying capacity (*Linkin Park LLC’s Application* [2006] ETMR 1017, para. 68, *Sir Alexander Chapman Ferguson’s Application*, BL O/094/06, p. 10, lines 14 – 22).

24. Moreover, I note that the Examination Guidelines of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”)⁵ contain no equivalent to paragraph 32.1.11, Chapter 3 of the Registry Work Manual. The OHIM practice in relation to slogans reads:

“A slogan is always registrable if it contains a word (or words) which is (are) distinctive on its (their) own. A slogan can be descriptive ... if it is limited to highlighting desirable characteristics of the goods or services. Examples of descriptive slogans: “Mehr für Ihr Geld”, (CFI T-281/02) “Looks like grass feels like grass, plays like grass” (CFI, T-130/01) “Real people, real solutions” (CFI T-130/01).

Descriptive slogans are also non-distinctive. Furthermore, those slogans are non-distinctive which are limited to general invitations to buy, laudatory statements or seek to promote superior knowledge, client friendliness, economic success or availability of the trade mark applicant. On the other hand, slogans are distinctive if they contain an element of fancifulness, for example by playing with words, using an element of irony, by alliteration and rhyme, or by conveying subliminal messages.”

25. The distinctive character of a trade mark must be assessed in relation to the goods or services for which registration is sought (*Linde*, para. 41). However, the manner of use (on a label or swing ticket, or on the front of a tee shirt) is a matter of choice for the trade mark owner (*Bang Olufsen*, para. 31). Its relevance is to use of the trade mark (*Arsenal Football Club plc v. Reed* [2001] ETMR 860, paras. 66 – 68). The possibility that a trade mark might be used in a non-trade mark manner does not *per se* detract from its distinctive character.
26. THERE AIN’T NO F IN JUSTICE is not an advertising slogan. Nor does it commend the quality or any other characteristic (e.g., price) of the goods concerned. There is a question of whether *Erpo* is applicable in this case (i.e., whether it was correct to start with the presumption that there would be greater difficulty in establishing distinctiveness). Additionally, in my judgement, the Hearing Officer brought different/stricter criteria into his assessment of the distinctive character of the mark. First, his assessment was based on a “worst case” assumption of manner of use. Second, he appeared to regard as material previous use of the football chant “There’s only one F in Fulham”. As Dr. Trott acknowledged novelty, or imaginativeness or creativity on the part of the proprietor is not a requirement for distinctive character (*Erpo*, paras. 31 – 32, *SAT.1*, para. 41, *IVG*, paras. 49 – 50).

⁵ Draft, December 2007, para. 7.3.6.

27. In assessing the distinctive character of a trade mark, it is appropriate to take account of practices in the marketplace including in the present case the well known use of slogans as clothing brands, e.g., FRUIT OF THE LOOM, CITIZENS OF HUMANITY and 7 FOR ALL MANKIND (*SAT.1*, para. 44, Case C-273/05 P, *OHIM v. Celltech R&D Ltd* [2007] ECR I-2883, para. 39).
28. The mark in suit THERE AIN'T NO F IN JUSTICE, has no meaning in relation to the goods, is grammatically correct and contains an element of irony in its double entendre. I believe it has the necessary capacity to distinguish in relation to tee shirts, sweatshirts and baseball caps in the same way as it has already been found by the Registry to be distinctive for other items of clothing, footwear and headgear. Like any other trade mark, if THERE AIN'T NO F IN JUSTICE is not used in accordance with its essential origin function then it will be liable to revocation under section 46 of the Act.

Conclusion

29. In the result the appeal succeeds and the application is remitted to the Registry so that it can proceed to advertisement. In accordance with normal practice, I make no order as to costs.

Professor Ruth Annand, 31 March 2008

Mr. Kevin Scranage appeared in person.

Dr Bill Trott appeared on behalf of the Registrar.