

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2130740
BY TOTTENHAM HOTSPUR PLC
TO REGISTER THE TRADE MARK:
TOTTENHAM
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**

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IN THE MATTER OF Application No 2130740
by Tottenham Hotspur plc
to register the trade mark:
TOTTENHAM
in classes 6, 9, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 39, 41 and 42
and
IN THE MATTER OF Opposition thereto under No 47905
by Patricia Hard O'Connell and Michael O'Connell

Background

- 1) On 24 April 1997 Tottenham Hotspur plc applied to register the trade mark **TOTTENHAM**. The application was published on 10 September 1997.
- 2) On 10 December 1997 Patricia Hard O'Connell and Michael O'Connell filed notice of opposition to this application.
- 3) During the opposition proceedings the specification of the application was amended so that it now reads as follows:

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

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

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

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 house hold 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

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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

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

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

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

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

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

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

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

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

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

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 of web pages on the Internet; information provided on-line from a computer database or from the Internet; all relating to Tottenham Hotspur Football Club

4) In the statement of case the opponents raised various grounds of opposition. However, at

the hearing the grounds of opposition were limited to sections 3(1)(b) and (c) of the Trade Marks Act 1994.

5) The opponent filed a counterstatement denying the grounds of opposition. At the hearing an amended counterstatement was admitted. The amended counterstatement denied the grounds of opposition.

6) The opponent filed evidence. The evidence of the applicant was not admitted into the proceedings as it was not received timeously. Both parties seek an award of costs.

7) The matter came to be heard on 26 February 2002 when the applicant was represented by Mr Baker of Trade Mark Owners Association and the opponents by Ms Szell of Lloyd Wise, Tregear.

Opponent's evidence

Statutory declaration dated 20 May 1999 by Michael O'Connell

8) Mr O'Connell states that he and his family have been selling football memorabilia for thirty years. He states that he and his family operate stalls around the Premier League grounds in London and also at Wembley Stadium. Mr O'Connell states that he and his family are part of the football scene. He states that traders such as himself and his family have received recognition as a result of local authorities designating licensed pitches for the sale of goods to football supporters under the London Local Authorities Act 1990. He states that he and his wife operate licensed pitches outside the grounds of West Ham United, Chelsea, Queens Park Rangers and Arsenal. However, they were not successful in an application to Haringey Council for licensed pitches outside the ground of Tottenham Hotspur Football Club. Exhibited at MOC1 are copies of correspondence with Haringey Council relating to this. The correspondence indicates that the failure to obtain a license was due to not appearing high enough in the waiting list. As a result of the failure to obtain a license Mr O'Connell and his wife purchased a lease on a property in Park Lane, Tottenham in 1993. Since that time they have run a stall there. He has also run a stall on the High Road, Tottenham for which he has had a lease since 1995. Exhibited at MOC2 and MOC3 are copies of the leases. Mr O'Connell's family and himself have used the word TOTTENHAM to adorn goods in relation to the football team since 1969. He has used a variety of suppliers from whom he has obtained goods. He states that Mr Paul Myers is one such supplier. Exhibited at MOC4 is a copy of a letter from Mr Myers which states that his company has produced football souvenirs since 1971. They have produced various items bearing the word TOTTENHAM on products such as hats, scarves, badges, flags and t-shirts. Mr Myers writes that Mr O'Connell has been a customer of his since the formation of his company.

9) Mr O'Connell exhibits at MOC5 copies of accounts of his wife, Mrs Patricia Hard O'Connell trading as MOC Supplies for three years and also his own accounts as a commission agent for MOC Supplies for three years. All but the accounts for Mr O'Connell for the years 1997-1998 predate the filing of the application in suit. Mr O'Connell did not keep detailed accounts for many of the earlier years. The accounts do not make any distinction between goods bearing the word TOTTENHAM and goods which might have been sold outside the grounds of West Ham, Chelsea, Queens Park Rangers and Arsenal. Mr O'Connell believes that sales outside Tottenham Hotspur Football Club (THFC) will have amounted to half the total. He reaches this conclusion owing to the greater size of his pitches

and stalls in relation to THFC. Mr O'Connell has sold goods such as badges, scarves, hats, flags and t-shirts. Exhibited at MOC6 are samples of goods which he has sold bearing the word TOTTENHAM.

10) Mr O'Connell does not see why the applicant should encroach on honest traders such as himself and the suppliers he uses by monopolising the word TOTTENHAM. He states that he is familiar with the goods sold by the applicant in their own shop and is not aware that they use the word TOTTENHAM. He states that the applicant uses Spurs or Tottenham Hotspur. Mr O'Connell states that he was surprised that the application in suit was accepted for registration as he understood that it was forbidden to register the names of sizeable places. It is for this reason that he uses TOTTENHAM, which is the name of a part of North London, rather than TOTTENHAM HOTSPUR, which is the name of the football club.

Statutory declaration dated 19 May 1999 by Reginald Richard Hart

11) Mr Hart has worked for the London Borough of Haringey for nearly forty years. He is currently the senior shops' inspector for the borough. He is an authorised officer of the borough in respect of street trading.

12) Mr Hart has his roots in Tottenham. He has lived in or close to Tottenham for the whole of his life. He is very familiar with trading in Tottenham owing to his employment. Mr Hart is aware of THFC and its ground, which he states is in High Road, Tottenham. Mr Hart states that THFC do not even have the exclusive rights in the word TOTTENHAM for football clubs. He used to be a qualified football referee with the London Football Association and is aware of several other football clubs within Haringey that include TOTTENHAM in their name. Mr Hart states that Tottenham makes up one third of Haringey and is a mixed area of residential property and retail and commercial premises. There are several industrial estates. Many of the larger retail enterprises are located in or adjacent to High Road which is the principal shopping area within Tottenham. He states that there will be many manufacturers and retailers for the goods which the application in suit encompasses and also many traders offering the services encompassed by the application in suit. He states that there are many businesses which use TOTTENHAM as part of their name, and thus in a proprietary sense, as part of their address, or to indicate their location in or association with Tottenham. He exhibits at RRH2 copies of the relevant pages from the London Telephone Directory showing businesses with TOTTENHAM as their first name. Mr Hart states that Haringey Council supplies souvenir or commemorative items with the word TOTTENHAM upon them to indicate the origin and to provide an association with Tottenham.

13) Mr Hart states that he is familiar with the pattern of street trading in around the ground of THFC. At one time there was a virtual free-for-all with unlicensed traders in and around the THFC ground selling all kinds of goods to football supporters. Following representations from the police Haringey Council decided to license street traders in and around the THFC ground. Accordingly applications were invited from traders to be licensed for street trading on match days. The criteria for granting licences was quite strict and so many traders were unsuccessful.

14) Mr Hart knows Mr O'Connell and regards him as a trader who does his best to stay within the letter of the law. He states that Mr O'Connell was an unsuccessful applicant for a licence but rather than continue trading in an unlicensed fashion he withdrew his stall from the public highway and placed it onto adjacent land. Mr Hart has been aware over the years of

match day traders using a number of names including TOTTENHAM HOTSPUR, SPURS and TOTTENHAM on various merchandise. He believes that he has been aware of the name O'Connell trading in the Tottenham area for over ten years. Mr Hart states that Mr O'Connell uses TOTTENHAM on goods on his stall. He states that he is not aware, at least in recent years, of Mr O'Connell using SPURS or TOTTENHAM HOTSPUR. Mr Hart is aware of the policy of the Trading Standards Department of Haringey in relation to the trade marks TOTTENHAM HOTSPUR, SPURS and TOTTENHAM. He states that the trading standards officers take action against those traders displaying goods with the first two trade marks but not the third one.

Statutory declaration dated 20 May 1999 by Paul Myers

15) Mr Myers is a manufacturer and supplier of football souvenir items. He has been involved in the business since 1969. Mr Myers deals with the history of goods for supporters to show their allegiance to their teams. Gradually this built up into what Mr Myers describes as an industry. The industry, when it began, owed nothing to and was not conducted by any of the professional football clubs. This was the position when he first started selling football colours, favours and souvenirs as a street trader in 1969. Mr Myers states that during the early 1970's football clubs did not have shops selling souvenirs; although supporters' clubs might sell scarves and rosettes, obtained from the same sources as the street traders, in order to finance the running of coaches to away games. During the mid-1970's there was a change as football clubs ran into financial difficulties. Mr Myers states that they began to appoint commercial managers who realised that if they took over control of the colours', favours' and souvenirs' market they could raise substantial revenue. He states that long established street traders, manufacturers and suppliers have found themselves the subject of legal proceedings from the football clubs. From 1970 to 1984 Mr Myers manufactured and supplied football colours, favours and souvenirs for retail and export through a business known as P & G. Exhibited at PM1 is a copy of a 1977/78 catalogue of P & G showing a variety of souvenir products. Mr Myers states that the catalogue is typical of catalogues employed in the business throughout the period from 1970 to 1984. Included in PM1 are pages from another catalogue of P & G which is not dated but which Mr Myers believes would have been issued in 1981 or 1982 since some of the legends on the products refer to THFC being the FA Cup Winners in 1981. In 1980 Mr Myers formed the limited company known as Grampaul Promotions Limited. Grampaul supplies souvenir products to be sold to street traders, retailers and for export. Mr Myers cannot say how many of the products produced by his various firms and companies will have related to products bearing the word TOTTENHAM; his records do not differentiate between the different legends appearing on the products. When THFC have had a good season sales will have been greater.

16) Mr Myers was the first to design and to introduce Jacquard loom woven scarves for football fans. These goods enable more sophisticated pictures and wording to be included on the scarf and make the scarf a product of greater quality. Mr Myers exhibits at PM3 a photograph of one of his printed scarves from "The People" of 16 May 1993 being waved by the owner (Mr Sugar) and the manager (Mr Venables) of THFC at the 1991 FA Cup Final.

17) Mr Myers states that a young boy supporting a football team is not the slightest bit concerned whether a particular scarf or badge has been approved by the owners of the football club. However, since the mid-1980's business managers of football clubs have made life increasingly difficult for souvenir products' suppliers. Mr Myers exhibits at PM4 a copy of a letter sent by the applicant to one of his customers and notes of subsequent meetings in

relation to the matter. The letter relates to a claim to an infringement of copyright and registered trade marks. It does not relate to use of the name TOTTENHAM simpliciter. Mr Myers expresses astonishment that the applicant has now sought to register the trade mark TOTTENHAM as he states that the applicant saw no problem in the use of TOTTENHAM by traders such as himself in 1989 and was happy to be seen brandishing one of his scarves bearing the word TOTTENHAM in 1991.

18) Mr Myers states that the effect of football clubs trying to control the market in relation to football colours, favours and souvenirs is the inevitable raising of prices. Mr Myers exhibits at PM5 a cutting from a newspaper from 1997. The article is headed "The Big Wembley Rip-Off". He believes that the motive of companies like the applicant is to force out suppliers like himself and take over the market for themselves.

Statutory declaration of Anthony O’Gorman dated 20 May 1999

19) Mr O’Gorman is the owner of a business which supplies a range of clothing and other items of interest to supporters of football teams. He operates essentially as a wholesaler and his goods are purchased by traders with fixed shops and also by street traders. Mr O’Gorman also supplies some football club shops directly. He has been in the business for many years. In 1988/89 football season he was selling shirts with the word TOTTENHAM on them from garage premises and from a pub car park in High Road, Tottenham. He did this on his own account and in partnership. The partnership known as Crazy Teez has sold garments with the word TOTTENHAM upon them from 1989; they have also offered hats, scarves and flags. During the early 1990’s goods with the name TOTTENHAM upon them were also sold through Tryrare Limited and later through Group K Limited, both of which companies Mr O’Gorman was a part or whole owner.

20) He states that this trade was well known to the applicant. He also states that he manufactured goods for the applicant marked TOTTENHAM HOTSPUR. Mr Harvey Gilbert, head of merchandise for the applicant, visited the premises of Group K Limited to see the manufacture of TOTTENHAM HOTSPUR products for the applicant. Mr O’Gorman states that he was told by Mr Gilbert that he saw no conflict of interest between his use of TOTTENHAM and the use of TOTTENHAM HOTSPUR on the products which were supplied solely to the applicant.

21) Mr O’Gorman’s businesses have continued to supply goods marked TOTTENHAM to the present day. Mr O’Gorman exhibits at AO’G1 copies of the K T Sports catalogue and a price list. The catalogues show various t-shirts, sweat shirts, hats and bags which bear the name TOTTENHAM or which can be purchased with this name upon them.

22) Mr O’Gorman states that he is careful not to copy the designs of the football clubs nor to use full names or trade marks of football clubs. Mr O’Gorman comments again on his supplying goods to football clubs themselves; Tottenham Hotspur and Arsenal. He comments that the specification of the application in suit includes goods which he has offered for ten years; goods which the applicant knows that he has offered and which he has done so without any restriction or complaint and with the full knowledge of the Head of Merchandise of the applicant. Mr O’Gorman considers that he has more rights in the word TOTTENHAM than the applicant as to the best of his knowledge the applicant does not use TOTTENHAM simpliciter.

Decision

23) The grounds of opposition pursued by the opponents are under sections 3(1)(b) and (c) of the Trade Marks Act 1994. The relevant provisions read as follows:

- “3.- (1) 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,

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.”

24) As the evidence of the applicant was not admitted into the proceedings he cannot pray in aid to the proviso.

25) The specification of the application in suit was amended during the proceedings by the addition of the words “all relating to Tottenham Hotspur Football Club”. At the hearing I put to Mr Baker my lack of understanding as to what the effect of this amendment was. I cannot see how a coat or a tube or saddlery, for instance, can relate to a football club. Mr Baker explained this by stating:

“They relate to Tottenham Hotspur in the fact that they would be perceived as goods that are authorised or licensed in their production by Tottenham Hotspur and that by buying those particular goods, the purchasers are in some way supporting their club and supporting Tottenham Hotspur Football Club.”

Mr Baker, as far as I can see, is stating that the limitation reflects who the owner of the trade mark right is. Consequently the limitation does not affect the nature of the goods and services; which is the point of a specification – to state what goods or services are covered and what their nature is. I, therefore, do not find that the limitation affects the issues before me. I suspect that the purpose was to avoid or overcome a geographical objection I do not see that the limitation to the specification has that effect.

Section 3(1)(b) objection

26) Ms Szell 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 evidence of the opponent shows that the football club is known as Tottenham. I do not think that Mr Baker disputed this. The specifications also indicate that TOTTENHAM will be seen as the name of the football club, through the limitation which I have discussed above. Ms Szell referred me to the following cases: *AD2000* [1997] RPC168, *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:

“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 the 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.”

Ms Szell 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.

27) I, therefore, find that the trade mark in suit is not devoid of any distinctive character and the ground of opposition under section 3(1)(b) is dismissed.

Section 3(1)(c) objection.

28) The objection under section 3(1)(c) is based upon Tottenham being a geographical name. The opponents have not adduced into evidence details of the population of Tottenham. Mr Hart in his declaration states that Tottenham makes up one third of Haringey but he does not state what the population of Haringey is. Mr Hart goes on to state that Tottenham is a mixed area of residential property and retail and commercial premises in which there are several industrial estates. He states that there are many businesses which use Tottenham as part of their name, and thus in a proprietary sense, as part of their address, or to indicate their location in or association with Tottenham. He exhibits at RRH2 copies of the relevant pages from the London Telephone Directory showing businesses with Tottenham as their first name. The evidence exhibited at RRH2 shows but a few names 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 Tottenham has a reputation for anything, other than the football team.

29) To be objectionable TOTTENHAM has to be more than the name of a locality. It has to be seen or be likely to be seen as an indicator of geographical origin; merely being the name

of a place is not enough to fall foul of section 3(1)(c). In *Windsurfing Chiemsee Produktions und Vertriebs GmbH (WSC) and Boots und Segelzubehör Walter Huber, Franz Attenberger* Cases C-108/97 and C-109/97 the European Court of Justice held:

“Article 3(1)(c) of the First Council Directive 89/104/EEC of 21 December 1988 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.”

There is no dispute that Tottenham is a locality. The issue before me is whether TOTTENHAM is likely to be seen, now or in the future, as a trade mark or as an indicator of geographical origin.

30) In *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* Case C-363/99 the Advocate General returns to the German doctrine of *Freihaltebedürfnis* – the need to leave free. (An English language version of the opinion has not yet been published by the Court.) The Advocate General differentiates between *Freihaltebedürfnis* and the findings of the European Court of Justice. European jurisprudence requires the public interest to be taken into account without that necessarily taking into account the requirements of German case law in relation to the demonstration of the real, current or serious need to keep free. The Advocate General is of the opinion that the findings in *Windsurfing* in relation to the need to keep free still apply, despite the findings in *Baby-dry* C-383/99. He states:

“Por estas causas, estimo que, a falta de pronunciamiento expreso del Tribunal de Justicia, sigue vigente la doctrina de la sentencia *Windsurfing Chiemsee*, relativa al reconocimiento de un cierto imperativo de disponibilidad en el ámbito del derecho comunitario de marcas.”

(“For these reasons, I consider that, in the absence of an express decision from the Court of Justice, the doctrine in the *Windsurfing Chiemsee* decision remains in force, as regards the recognition of a definite need to leave free in the field of Community trade mark law” – *my translation*)

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).

36) The applicant, having been successful, is entitled to a contribution towards his costs and I therefore order the opponents to pay him the sum of £335. 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 8TH day of April 2002

**D.W.Landau
For the Registrar
the Comptroller-General**