

O-192-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2231643
BY PATRICIA HARD O'CONNELL AND MICHAEL O'CONNELL
TO REGISTER THE TRADE MARK:**

TOTTENHAM

IN

CLASSES 6, 24, 25

AND

**THE OPPOSITION THERETO
UNDER NO 52755
BY TOTTENHAM HOTSPUR PLC
BASED UPON THE EARLIER TRADE MARK:**

TOTTENHAM

Trade Marks Act 1994
in the matter of application no 2231643
by Patricia Hard O’Connell and Michael O’Connell
to register the trade mark: TOTTENHAM
in classes 6, 24 and 25
and
the opposition thereto
under no 52755
by Tottenham Hotspur Plc

BACKGROUND

1) On 8 May 2000 Patricia Hard O’Connell and Michael O’Connell (afterwards referred to as the O’Connells) applied to register the trade mark **TOTTENHAM**. The application was published for opposition purposes in the “Trade Marks Journal” on 28 March 2001 with the following specification:

ornaments made of common metal; metal badges

flags

clothing, headgear, scarves, t-shirts, shirts, gloves.

The above goods are in classes 6, 24 and 25 respectively of the International Classification of Goods and Services.

2) On 25 June 2001 Tottenham Hotspur plc (afterwards referred to as TH) filed a notice of opposition to this application. There are several grounds of opposition, all of which are denied by the O’Connells in a counterstatement. Included in the counterstatement is the claim that trade mark registration no 2130740, which at the time of the filing of the opposition was a pending application, is not an earlier right. As indicated this is now a registration. It is a registration for the trade mark **TOTTENHAM** in fifteen classes. Most germane to this case are classes 6, 24 and 25 which are for the following goods respectively:

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

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.

The application for the trade mark was filed on 24 April 1997 and registered on 11 April 2003. (It was the subject of an unsuccessful opposition by the O’Connells.) Taking into account the nature of this trade mark of TH I consider that it is only necessary to consider the grounds of opposition relating to this trade mark.

3) TH states that the O’Connell’s trade mark is identical to its trade mark no 2130740 and has been applied for in relation to certain goods which are identical to the goods covered by its trade mark. Consequently, registration of the trade mark should be refused under the provisions of section 5(1) of the Trade Marks Act 1994 (the Act). TH states that to the extent that the goods covered by the application are not identical to those of its earlier trade mark they are similar. Given the identity of the trade marks the application should be refused under the provisions of section 5(2)(a) of the Act.

4) Both sides filed evidence but given the nature of the opposition under sections 5(1) and 5(2)(a) of the Act I do not consider that it has a bearing upon this case and so I will not summarise it.

5) Both sides seek an award of costs.

6) After the completion of the evidence rounds both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing, so I will make a decision after a careful study of the papers.

7) Neither side filed written submissions.

DECISION

8) Sections 5(1) and 5(2) of the Act state the following:

“5.— (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because——

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

9) TH’s registration is an earlier trade mark as defined by section 6(1)(a) of the Act.

10) The respective trade marks are identical. The goods of the earlier registration include all of the goods of the application in so far as the latter goods relate to Tottenham Hotspur Football Club, owing to the limitation of the specifications of the earlier right. In so far as such goods do not relate to Tottenham Hotspur Football Club they are identical in every other way and so are highly similar.

11) Consequently, for goods that relate to Tottenham Hotspur Football Club the application encompasses identical goods. For such goods that ground of opposition under section 5(1) of the Act must be successful. Section 5(1) of the Act does not represent a “jury question”. It bites automatically if the requirements are fulfilled.

12) In determining the question under section 5(2)(a), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77. In this case there is an identical trade mark for highly similar goods, those which do not relate to Tottenham Hotspur Football Club but are identical in every other way. Taking into account the identity of the signs and the proximity of the goods I do not consider that the amount of inherent distinctiveness of the earlier trade mark can have an effect on the outcome. I cannot see how confusion could not arise. So, in so far as the goods of the application are not identical, ie do not relate to Tottenham Hotspur Football Club, the grounds of opposition under section 5(2)(a) are upheld. (In fact the evidence indicates that the goods which the O’Connells will sell in relation to this trade mark do relate to Tottenham Hotspur Football Club – see for instance the photographs of their stall which are exhibited at VJK19 to the witness statement of Ms King.)

13) The application proceeded to publication upon the basis of honest concurrent use with TH’s registration and evidence of use was filed by the O’Connells in this opposition. Section 7 of the Act deals with honest concurrent use:

“7. - (1) This section applies where on an application for the registration of a trade mark it appears to the registrar-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

but the applicant shows to the satisfaction of the registrar that there has been honest concurrent use of the trade mark for which registration is sought.

(2) In that case the registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(3) For the purposes of this section “honest concurrent use” means such use in the United Kingdom, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purposes of section 12(2) of the Trade Marks Act 1938.”

In *Codas Trade Mark* [2001] RPC 14 the Hearing Officer stated in relation to honest concurrent use:

“If, for example, the trade mark the subject of the application for registration and the trade mark the subject of the earlier right were identical, and the specification of goods or services of the application was identical to the specification of the goods or services covered by the earlier trade mark, then refusal must follow under section 5(1), which bars absolutely the registration of identical trade marks in respect of identical goods or services (unless the proprietor of the earlier trade mark consents to the registration of the later trade mark). But in relation to section 5(2) the respective trade marks or respective specifications of goods or services may only be similar and the fact that there has been actual use of the trade mark in suit concurrently with the earlier trade mark, may be relevant in determining whether there is a likelihood of confusion.”

The ground of objection under section 5(1) is absolute and mandatory. Honest concurrent use cannot effect the finding in relation to this – see also to this effect *Road Tech Computer Systems Limited v. UNISON Software (UK) Limited* [1996] FSR 805. As far as grounds under section 5(2) are concerned honest concurrent use can be indicative that there is not likely to be confusion in the market place. In this case with identical signs and virtually identical goods confusion seems inevitable. Consequently, the use that the O’Connells have shown cannot assist them.

14) The grounds of objection under sections 5(1) and 5(2)(a) are upheld and the application is to be refused in its entirety.

COSTS

15) Tottenham Hotspur plc having been successful, it is entitled towards a contribution towards its costs. I order Patricia Hard O’Connell and Michael O’Connell to pay Tottenham Hotspur plc the sum of £1625. 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 July 2003

**David Landau
For the Registrar
the Comptroller-General**