

O-232-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2341436
BY WORLD ARTISTS LIMITED
TO REGISTER THE TRADE MARK
LONDON SOUTH AFRICANS RUGBY FOOTBALL CLUB
IN CLASSES 35 & 41**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 92399
BY ALISTAIR TROTMAN**

BACKGROUND

1) On 22 August 2003, World Sport Promotions, now known as World Artists Limited of Office 10, Momentum Pavilion, Securicor Loftus, Pretoria, South Africa applied under the Trade Marks Act 1994 for registration of the trade mark LONDON SOUTH AFRICANS RUGBY FOOTBALL CLUB in respect of the following:

In Class 35: Advertising and promotional services; advertising and promotional services relating to sport and sporting events and tournaments; publication of advertising matter; business management, business administration and business information services; business advisory and consultancy services relating to sport and sporting events; publicity and public relations agency services; promotional management for sports teams, sports clubs and sports personalities; the bringing together, for the benefit of others, of a variety of sports wear, sports equipment and goods relating to or featuring sport, sports teams, sports clubs or sports personalities, enabling customers to conveniently view and purchase those goods; information, advisory and consultancy services relating to the aforesaid services.

In Class 41: Entertainment; organisation of sporting events and tournaments; sporting activities; television programme and videotape production services; booking of sports facilities; promotion of rugby events; sports agency services; agency services for promoting sports clubs and sports personalities; training services; publication services; booking agency services for sporting events; ticket information services for sporting events; information and advisory services relating to the aforesaid services.

2) On 5 April 2004 Alistair Trotman of 70 Charlton Road, Walton on Thames, Surrey, KT12 2DG filed notice of opposition to the application. The ground of opposition is in summary:

The opponent has used the mark LONDON SOUTH AFRICA RUGBY CLUB for several years in relation to a rugby football club. The mark applied for is very similar to the mark used by the opponent as are the services and could cause confusion. The mark therefore offends against Section 5(4)(a) of the Trade Marks Act 1994. The opposition is limited to the Class 41 services.

3) The applicant subsequently filed a counterstatement denying the opponent's claims and requiring the opponent to provide proof of use.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 5 July 2006 when the opponent represented himself and the applicant was represented by Mr Jennings of Messrs Lewis Silkin.

OPPONENT'S EVIDENCE

5) The opponent filed a witness statement, dated 7 February 2005, by Alistair Trotman. He states that he is a professional sports agent and is currently the Director of a company called Southern Hemisphere Sports Ltd. The company deals mainly with the sport of rugby and so Mr Trotman states that he personally decided to form a

rugby club called London South Africa Rugby Club (LSARC) in 2000. He states that since this date the club has participated in numerous friendly matches in order to prove that the club can fulfil fixtures should the club be allowed to join the official league system of the RFU. Mr Trotman states that as the club's ambition is to join the league structure the club has participated in numerous competitions and festivals, 15 a-side, 10 a-side and 7 a-side, throughout Middlesex and Surrey.

6) He states that as a result LSARC has become recognised by various clubs in the Greater London area. At exhibits AT1-17 he provides evidence of activity as set out below:

- AT1: A fax from Mark Plummer dated 2 November 2000 regarding a match "Entertainers v London SA".
- AT2: A letter from Ruislip RFC stating that LSARC have entered two ten a-side tournaments at the club in 2002 and 2003. It also states that LSARC have advised the club on player recruitment and other rugby issues.
- AT3: A fax confirming entry under the name London South Africa in the Staines RFC Cup competition in 2002. Other clubs participating included London Welsh and London New Zealand.
- AT5: A LSARC fixture list complete with results for the 2000/2001 season.
- AT6: A letter from Trail Finders Sports Club confirming participation by London South Africa in the 2001 London Sunday Rugby Festival.
- AT7: Results from the Old Caterhamians 2000 Easter 7's tournament which shows the participation of London South Africa.
- AT8: A programme dated 2002 for a match between the "Seven Seas Baggage New Zealand Wekas" and the "SAfrika LSA Impalas" the match being played at the ground of the London Nigerians RFC.
- AT9: A letter, dated 20 December 2001, from Francis Baron, Chief Executive of the RFU to Mr Trotman regarding the LONDON SOUTH AFRICA RC and a variance to Regulation 9.2.2.
- AT10: Single game insurance cover in the name of SHS London SA, dated 18 August 2003. Also an application form for coverage to the RFU which also has to have a payment to the RFU dated February 2002.
- AT11: A letter from Middlesex County RFU re an application for Associated Club Membership dated 5 February 2002.
- AT12: A copy of a fax, dated 3 May 2001, from John Vale (Honorary Secretary of Surrey County RFU) to Paddy Ralston regarding LSARC. He states that he has been provided with information by Mr Trotman sufficient for him to support the club joining "Surrey [League] Three".

- AT13: A letter from the league secretary of Surrey League Three dated 27 June 2001 stating that London South Africa were joining the league as a probationer side.
- AT14: A copy of a letter from John Vale to Mr Trotman stating that the application to join the Surrey League for 2002/2003 was not accepted.
- AT15: a letter dated 19 September 2002, from Surrey County Rugby Football Union to a number of rugby clubs, including LSARC inviting them to a meeting.
- AT16: A copy of a letter, dated 6 February 2002, from Mr Trotman to The Chairman and Secretary of Surrey RFU requesting entry to the league structure.
- AT17: A letter, dated 25 February 2004, from Mr Trotman to Mr Vale informing him of a change to the law which would allow more than two foreign players per team. The letter asks for entry to the league.

APPLICANT'S EVIDENCE

7) The applicant filed a witness statement, dated 12 August 2005 by Elaine Hulme, its trade mark agent. She states that in order to succeed the opponent must show that he has acquired goodwill in the name LONDON SOUTH AFRICAN RUGBY CLUB. She states that the opponent merely fielded a team on one occasion and even then the match was abandoned at half time. At exhibit EH1 she provides a letter dated 16 August 2004 from John Vale, the Assistant Secretary of Surrey County RFU. In his letter Mr Vale states that although they played one game in September 2001 he is aware of no other fixtures being played. The LSARC was not granted membership as it was a business and the constitution did not meet the requirements of the RFU. He also states that in February 2003 it was noticed that no insurance had been paid. Mr Vale states that when contacted about this Mr Trotman stated that the team had not played any rugby in the 2002/2003 season. On 17 June 2003 LSARC were removed from the register of members of Surrey Rugby as they no longer played rugby. They had also failed to supply information such as a constitution, rules or regulations that met the requirements of Surrey County RFC. Subsequent enquiries regarding insurance proved that LSARC had not played in the seasons 2002/2003 or 2003/2004. However, in this time two games have been insured involving a team by the name of Southern Hemisphere Sports. In February 2004 the Surrey RFC were approached by the applicant to register the club London South Africa RFC, as LSARC had ceased to exist the application was accepted.

8) At exhibit EH2 to her statement Ms Hulme provides a letter from Brian East the Secretary for Middlesex County RFU. In this letter, dated 2 August 2005, Mr East states that LSARC have never been members of Middlesex County RFU.

OPPONENT'S EVIDENCE IN REPLY

9) The applicant filed a second witness statement, dated 18 November 2005. He states that he has made press releases and advertisements under the name LSARC, has used

the matches played by LSARC as a vehicle to test fitness and skill levels of players and then sought to place players in the relevant level of rugby. These placements generated fees for his company SHS. He also states that LSARC was a vehicle for players “to go through the process of mandatory international player clearance procedures that were imposed on them when they played rugby in the UK for the first time, when they had previously played for another club governed by another rugby union”.

10) Mr Trotman states that “once LSARC is established in Surrey league then club will receive central funding from the RFU”. He supplies numerous items of correspondence where the object is clearly to achieve membership of the Surrey County RFU. The major stumbling block to this appears to have been the intention of LSARC to field up to 15 South African players whereas the regulations permit only two overseas players per team. He also supplies numerous fax and e-mails between himself and various players explaining how they should get through the immigration process and stating that they need clearance from their home union to play abroad and mentioning LSARC as the team they will play for, although he stresses that this does not bind the player to LSARC, indeed he points out that he places players all over Europe.

11) Mr Trotman claims that his team played a number of fixtures including the London Sundays teams tournament on 28 April 2002. He states that in the season 2002/20003 his team played a number of “tens” tournaments. He states that his company SHS were the sponsor of LSARC and so the company name appears on the insurance certificate. He provides the following exhibits:

- AT19, 20, 21, 29, 38, 48 & 49: LSARC is not mentioned in any of these exhibits, although AT21 and AT49 do mention SHS London SA and Southern Hemisphere London South Africa respectively.
- AT22 & 24: Letters dated, 4 July 2002 and 1 July 2002 respectively, from John Vale to Mr Trotman, presumably in response to exhibit AT23.
- AT 23: A letter from Mr Trotman, dated 14 June 2002, to John Vale requesting admission into the league structure.
- AT 25: A letter, dated 1 July 2001, from John Vale to Bruce Reece-Russell informing Mr Reece-Russell that LSARC would need a dispensation to play in the league as all the players would be South Africans.
- AT26: a letter, dated 30 September 2002, from John Vale to Mr Trotman informing him that the dispensation was not granted and that LSARC could not join the league.
- AT27: A list of matches for the “Massive Super 10’s” to be played on 8 September 2002. These include teams such as “Skyrunners”, “The Crazy Gang” “Dog Brothers” and “3 Kings Barbarians” as well as “London SA”.
- AT28: A letter, dated 23 May 2004, from John Vale to Mr Trotman stating that LSARC was removed from the records of Surrey County RFU on 17

June 2003. Subsequently, an application had been made by another club using the name London South Africa RFC to become a member of the league and this had been accepted.

- AT30: This contains a fax from a South African living in London seeking information on LSARC with a view to possibly joining the club. Also attached is a letter from John Vale, dated 26 February 2004, regarding a further request by Mr Trotman to join both Surrey and Middlesex Leagues. This letter is also filed as exhibit AT31.
- AT32: A list of fixtures for 2001/2002 on Southern Hemisphere Sports Ltd headed notepaper. This includes 7 and 10 a side games.
- AT33: A mailfax from the South African RFU dated 15 May 2001 to Mr Trotman setting out the procedures for the clearance for players to play overseas. This makes no mention of LSARC.
- AT34: Copies of e-mails, dated December 2002, between Mr Trotman and a player from Australia, where Mr Trotman advises that “if need mention a club say London South Africa my club”.
- AT35: Similar to AT34 but dated November 2003.
- AT36 Similar to AT34 & 35 but dated December 2003.
- AT37: Similar to AT34, 35 & 36 but dated February 2004.
- AT39: Similar to AT34, 35, 36 & 37 but dated March 2004.
- AT40: An offer of employment sent by Southern Hemisphere Sports Ltd on behalf of LSARC on November 2001 to Pierre Durandt relating to a one month trial.
- AT41: As per AT 40 but dated June 2003 and sent to Stephanus Christian de Beer.
- AT42: E-mails between Mr de Beer and Mr Trotman referring to the contract.
- AT43: A copy of a letter dated 18 August 2003 confirming insurance cover for the team “SHS London SA” for a single game on 17 August 2003. No comment is made regarding the issue of “backdating” this cover.
- AT44: A copy of an e-mail dated 17 November 2005 from Brian East, Honorary Secretary of Middlesex County RFU stating that “Further to my letter to Dick Best of 2nd August 2005 as Hon. Secretary of Middlesex County RFU I confirm the intent of the letter was to point out to Dick Best that the name of London South Africa was already in use by a Section 3 club in Surrey CRFU. I understand that Alistair Trotman and his team are the main people involved with the London South Africa RFC”.

- AT45 A copy of a fax from Jason Smith to Mr Trotman stating that Mr Trotman had no legal right to use the name London South Africa with regard to a rugby team.
- AT46: A copy of a letter dated 29 June 2001 from John Vale to Mr Trotman regarding the application of LSARC to be admitted into the league.
- AT47: A copy of an RFU insurance cover application dated 6 February 2002 in the name of London South Africa RC Impalas.

APPLICANT'S ADDITIONAL EVIDENCE

12) The applicant filed a further witness statement, dated 25 January 2006, by Elaine Hulme. This has as an exhibit an e-mail from Mr East Hon Secretary of Middlesex RFU rescinding comments made in the e-mail referred to at exhibit AT44 of Mr Trotman's evidence in reply. The e-mail was sent out twenty five minutes after the original e-mail and also went to Mr Trotman.

OPPONENT'S ADDITIONAL EVIDENCE

13) Mr Trotman filed a further witness statement, dated 16 June 2006. He states that the sole reason for his club not being admitted to the Surrey County League was the fact that the relevant authorities governing rugby football in the UK were unaware of the changes in European law governing the limits on the number of "foreign" players in a team. The changes meant that South African players should not have been regarded as "foreign" players and limited to two players per team.

14) He also states that LSARC had no obligation to report all their fixtures to the relevant authorities and that these authorities do not keep records of such matches.

APPLICANT'S FURTHER EVIDENCE

15) The applicant filed a witness statement, dated 3 July 2006, by Steven Jennings the applicant's Trade Mark Attorney. At exhibit SJJ1 he provides a copy of the Companies House report which shows that Mr Trotman is the only Director of SHS Ltd. He also provides, at exhibit SJJ2, a copy of a page from SHS's website which refers to matches between SHS New Zealand Wekas and SHS South Africa Impalas which takes place annually. At exhibits SJJ3-6 he provides details of his clients use of the mark with details of the ground, training facilities, coaches, player squad and results for 2005/2006.

16) That concludes my review of the evidence. I now turn to the decision.

DECISION

17) At the hearing a preliminary point was raised by each side regarding the admissibility of the additional and further evidence of both sides. Both parties agreed that all the evidence should be allowed into the case.

18) The sole ground of opposition is under section 5(4)(a) which reads:

“5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

19) In deciding whether the mark in question “LONDON SOUTH AFRICANS RUGBY FOOTBALL CLUB” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purpose of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in *Halsbury’s Laws of England* (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or

as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.’

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

‘To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.’”

20) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of

Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty Limited v. The Pub Squash Co. Pty. Ltd* [1981] RPC 429. In the instant case the relevant date is the date of application 22 August 2003.

21) In order to succeed under this head of opposition, the opponent must show that as at the date of the application, 22 August 2003, they could have prevented use of the applicant's trade mark under the law of passing off. In the majority of cases, the opponent's product or services will be on the market or advertised as available to the relevant market and in order to satisfy the first of the elements listed above, the opponent's will file evidence showing use of their trade mark in the market place. The evidence will be dependent on the facts of the individual case but will usually show the period of use before the date of application, invoices will be exhibited together with turnover figures, advertising figures and examples of advertising will also be included. Of course, that will not always be the case and actions for passing off have been successful where the claimant has not commenced trading in the market place. Two such cases are *The British Broadcasting Corporation v Talbot Motor Company Ltd* [1981] FSR 228 the mark was CARFAX (a traffic information system) and in *W H Allen & Co v Brown Watson Limited* [1965] RPC 191, it was the name of a book.

22) With these considerations in mind I turn to assess the evidence filed on behalf of the parties in the present proceedings as set out earlier in this decision.

23) The opponent has provided a large number of exhibits which are intended to corroborate the use of London South Africa Rugby Club. I am willing to accept that the average person would equate S Africa with South Africa and would also view RC as rugby club if it were being used in a rugby context. However, a number of the exhibits show use of variations such as SHS London SA and S Afrika LSA Impalas. Even on official documents such as insurance certificates these variations exist. It is clear that the opponent was actively pursuing the registration of a rugby club under the name London South Africa Rugby Club. It is also clear that a number of seven-a-side and ten-a-side tournaments were entered into under the name London South Africa. With regard to these tournaments it is not clear whether the participation would have been seen as that of a rugby club or merely a group of individuals from South Africa who decided to enter the tournament under this name. I say this because it is clear that some of the tournaments included what could only be termed scratch sides. I doubt very much that there is a "Dog Brothers" rugby club. Scratch sides are a feature of many sporting tournaments and allow for a group of friends to enter a team which will exist only for the duration of the tournament.

24) I note that the opponent is an individual who claims use of the mark LONDON SOUTH AFRICA RUGBY CLUB. There is no evidence of the actual existence of a club such as a list of members, constitution, ground etc. Whilst this is not a requirement in proving goodwill I believe that it would impact on the way that the use of the term LSARC would be viewed. Rugby is, from my own experience, a very social sport. On the pitch there is a high degree of physical contact, most of which is within the laws of the game. However, the players almost invariably then put aside

such contact and socialise over a meal and some liquid refreshment. Rugby clubs are judged on their sporting prowess and their hospitality. In the instant case the opponent appears to be the sole member of the club. It is he who organises the seven, ten or fifteen individuals to form at a given time and location.

25) Mr Trotman has engaged in correspondence with the relevant authorities to seek registration of his club. Initially his request was met with enthusiasm as most sporting organisations are always keen to increase the level of participation. However, it is clear from the later correspondence that the unusual format of the club (one member) and questions over the ability to fulfil fixtures were causes for concern. I do not believe that the correspondence from the officials involved in regulating the sport of rugby union football constitute goodwill. All they show is that the officials were aware of Mr Trotman's stated aim of forming a rugby football club. Similarly, the participation of sides under the name London South Africa in various tournaments do not equate to goodwill as a rugby club under this name. As I have stated earlier a number of these tournaments clearly have scratch sides who can, and do, call themselves by all sorts of names. The fact that a group of South Africans residing around London decide to call their team London South Africa is unsurprising and is merely a description of their origin. Without the normal structures of a club such as committees, coaches and a membership I do not believe that other members of the rugby community would view Mr Trotman's use as that of a rugby club, or even as being by the same group or person.

26) Goodwill is accepted as being the attractive force which brings in custom. It is also accepted that goodwill as property has no meaning except in connection with some trade, business or calling. (Wadlow "*The Law of Passing Off*" Ch.2.02). In the instant case all business dealings, including player contracts, have been shown to be under the name SHS. To my mind the opponent has not shown any goodwill in the name London South Africa Rugby Club.

27) In *South Cone Inc. v. Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership)* [2002] RPC 19 Pumrey J. in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* [1946] 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus, the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

28) This cannot be interpreted in a prescriptive fashion. There will be occasions when the evidence does not fall within the above parameters but still establishes goodwill for passing off purposes - see the decision of Professor Annand, sitting as the Appointed Person, in *Loaded* BL 0/191/02.

29) I do not consider that the opponent has discharged the onus of showing that it has the goodwill required by the tort of passing off and the opposition under Section 5(4)(a) fails.

COSTS

30) As the applicant is successful it is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1,500. This sum 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 14th day of August 2006

**George W Salthouse
For the Registrar,
the Comptroller-General**