

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2293645  
BY STASH LIMITED  
TO REGISTER A TRADE MARK IN CLASSES 25 AND 28**

**AND IN THE MATTER OF OPPOSITION No. 90766  
BY SAMURAI SPORTSWEAR LTD**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON  
BY THE APPLICANT  
AGAINST THE DECISION OF MR. M. REYNOLDS  
DATED 8 DECEMBER 2003**

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**DECISION**

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**Introduction**

1. This appeal concerns an application by Stash Limited (“the Applicant”) for registration of the trade mark STASH in respect of:

Class 25: Clothing; sports clothing; footwear; headgear.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

The application was filed on 25 February 2002 under number 2293645.

2. Samurai Sportswear Limited (“the Opponent”) opposed the application on 28 June 2002. In a decision dated 8 December 2003, the Hearing Officer upheld the Opponent’s objections to the application under section 3(1)(b), (c) and (d) of the Trade Marks Act 1994 (“the TMA”) in relation to all the Class 25 goods and “sporting articles not included in other classes” in Class 28. However, provided the Applicant restricted the specification within the specified time period, the application would be allowed to proceed for:

Class 28: Games and playthings; gymnastic articles not included in other classes; decorations for Christmas trees.

The Hearing Officer’s decision was taken on the basis of the papers before him. Neither party requested an oral hearing although both parties filed written submissions.

3. On 5 January 2004, the Applicant filed notice of appeal to an Appointed Person under section 76 of the TMA. Mr. Simon Malynicz of Counsel appeared on behalf of the Applicant at the oral hearing of the appeal. The Opponent was not represented and made no observations in writing.
4. An appeal to an Appointed Person is by way of review. As the Court of Appeal explained in *REEF Trade Mark* [2003] RPC 101, this tribunal should show a real reluctance, if not the very highest degree of reluctance, to interfere with a decision of a Hearing Officer in the absence of a distinct and material error of principle.

### **Preliminary issue**

5. The Applicant raises as a preliminary issue, the Hearing Officer's refusal to entertain an objection to certain material exhibited at TS9 – TS15 to the second witness statement of Terence Edward Dennis Sands, dated 3 September 2003 ("Sands 2"). The Opponent purported to file such evidence under rule 13(10) of the Trade Marks Rules 2000, as amended (now rule 13C(5)). But, says the Applicant, this was not confined to matters strictly in reply to the Applicant's evidence as required by rule 13(10). If the Hearing Officer's refusal is confirmed on appeal, the Applicant seeks leave to adduce evidence in response.
6. The turn of events in so far as relevant is as follows. Sands 2 was filed at the Registry under cover of a letter from the Opponent's trade mark attorneys dated 10 September 2003. Copies were simultaneously sent to the Applicant's trade mark attorneys. On 26 September 2003, the Registry wrote to the latter (copy to the other side) confirming receipt of the Opponent's rule 13(10) evidence in reply, stating that the evidence rounds were now complete and listing the evidence on file (including Sands 2). By a further letter of the same date, the Registry informed the parties that the Hearing Officer had reviewed the papers and did not consider that an oral hearing was necessary to arrive at a decision on the opposition. The parties were given until 26 October 2003 to request an oral hearing, otherwise written observations should be filed by 7 November 2003. The Applicant made written submissions under cover of a fax letter from their attorneys dated 7 November 2003. At paragraph 1.5.1, the Applicant stated the belief that Exhibits TS9 – TS15 were an attempt by the Opponent to introduce new evidence and were not in reply. The Applicant requested that the Hearing Officer refuse to admit Exhibits TS9 – TS15 into the proceedings.
7. At the time the relevant Registry practice was set out in Chapter 15, Trade Marks Registry Work Manual (1996 Ed.):

"Evidence filed under [rule 13(10)] must be strictly in reply to the claims or allegations made in the evidence filed by the applicant. If the applicant claims that the evidence does not restrict itself to answering the points raised in their evidence, it cannot be admitted until the matter has been resolved. In such circumstances the applicant should

be asked to provide details of where the evidence goes beyond being in reply.

If, after giving the opponent the opportunity to consider the allegations they maintain that the evidence is replying to allegations made in the applicant's evidence, unless the objection is withdrawn it will be necessary for an interlocutory hearing to be appointed. **The matter cannot be left for a decision at the main hearing as the arguments over this procedural matter are likely to complicate and cloud the issues.**"

The most recent version of Chapter 15 (revised May, 2004) sets out the practice more succinctly:

"Any such objections to evidence ought to be raised at the earliest opportunity so that an interlocutory hearing can be appointed if necessary."

8. The Hearing Officer noted that the Applicant raised no complaint to Sands 2 in the period between when Sands 2 was served and the Registry notified the parties that the evidence rounds were considered to be complete:

"It seems to me, therefore, that the time has now long passed to raise a technical objection to the evidence. By inviting me (in their written submissions) to refuse to admit this evidence they would effectively be denying the opponents an opportunity to deal with the point. I intend, therefore, to consider the evidence on its merits."

9. The issue of evidence that is not confined to matters strictly in reply was dealt with by Mr. Geoffrey Hobbs QC, sitting as the Appointed Person, in *Lappet Manufacturing Co. Ltd's Opposition No. 44678*, SRIS O/467/02. As Mr. Hobbs explained, when such evidence is filed without the permission of the Registrar, there is an irregularity in procedure, which may be rectified on such terms as the Registrar may direct under rule 66 of the Trade Marks Rules 2000, as amended. When both parties are apparently content for the evidence in question to be taken into account, the Registrar is under no obligation to exclude it from consideration on his own motion. The Registrar can rectify the irregularity under rule 66 by accepting the position adopted by the parties, thereby implicitly agreeing to the filing of the evidence under what is currently rule 13(C)(6) (formerly rule 13(11)). Where, however, there is an objection to the irregularity, it becomes necessary for the Registrar to decide whether dispensation should be granted pursuant to rule 13(C)(6) to allow the evidence in question to be taken into account. A relevant factor will be lateness of the Applicant's objection and apparent acquiescence in the meantime of the status quo. Other relevant factors are the materiality of the evidence and the seriousness of the irregularity concerned.
10. The relevant principles governing what is evidence in reply are set out in *Ford Motor Company Limited (Nastas's) Application* [[1968] RPC 220, *Ernest Scragg & Sons Limited's Application* [1972] RPC 679 and *Peckitt's*

*Application* [1999] RPC 337. Exhibits TS9 – TS15 comprise a Google Internet search and related web pages. The evidence is clearly not in reply. I am unsure of the process followed the Hearing Officer in taking the evidence into account. Assuming, however, that dispensation to correct the irregularity was implicitly granted by the Hearing Officer under what was then rule 13(11), the Applicant should have been afforded the opportunity to file evidence in response. I, therefore, decided at the oral hearing of the appeal and in the absence of any observations by the Opponent, that the overriding objective was best achieved by allowing the Applicant’s request to introduce new evidence by way of response to Exhibits TS9 – TS15. Such evidence comprised a second witness statement of David Andrew Green and Exhibits DG7 – DG11 (“Green 2”). Furthermore, I am satisfied that such evidence fulfils the criteria set out in *LABEL ROUGE Trade Mark* [2003] FSR 13 (and confirmed by the Court of Appeal in *DU PONT Trade Mark* [2004] FSR 293) in that Green 2: (a) could not have been placed before the Hearing Officer when making his decision; (b) is probative; and (c) there is no reason to doubt its credibility.

### **The Hearing Officer’s decision – the appeal**

11. The main finding of the Hearing Officer was that at the date of application for registration, 25 February 2002, STASH contravened section 3(1)(d) of the TMA in respect of:  
  
Clothing; sports clothing; footwear; headgear (Cl. 25)  
  
Sporting articles not included in other classes (Cl. 28).
12. Section 3(1)(d) of the TMA provides that the following shall not be registered:  
  
“trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade”.
13. The Hearing Officer added that if he were wrong in his conclusion under section 3(1)(d) because some of the Opponent’s evidence post-dated the application date, he would nevertheless find that STASH must be refused registration under section 3(1)(b) and (c) of the TMA, with the later evidence indicating what the position was likely to have been at the earlier date.
14. Mr. Malynicz did not seek to challenge the Hearing Officer’s statement of the applicable law with the exception that he thought the Hearing Officer might usefully have referred to paragraph 35 of the decision of the Court of Justice of the European Communities (“ECJ”) in Case C-517/99 *Merz & Krell GmbH & Co.* [2001] ECR I-6959 (I will return to this point later in my decision). Nonetheless, I would observe that the Hearing Officer’s global direction in relation to section 3(1) fails to address the need to examine each ground for refusal separately and misquotes the ruling in *Merz & Krell*, where the ECJ says at paragraph 41:

“It follows that Article 3(1)(d) of the Directive must be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. It is immaterial, when that provision is applied, whether the signs or indications in question describe the properties or characteristics of those goods or services.”

As is apparent, the ECJ does not speak of signs that have become customary in the language of the trade, as indicated by the Hearing Officer in his direction.

15. I am also concerned that the Hearing Officer did not at an early stage identify the relevant public. Indents five and six of the Hearing Officer’s direction make clear that section 3(1)(b) – (d) must be assessed in relation to the goods and services applied for taking into account the perceptions of the average consumer who is reasonably well informed and reasonably observant and circumspect. The goods at issue in Class 25 are clothing, footwear and headgear at large. Sports clothing is specifically mentioned but there is no limitation by sport. Similarly the subject goods applied for in Class 28 – sporting articles not included in other classes – bear no such limitation. In my view, the width of the specification should have led the Hearing Officer to conclude that the relevant public were consumers in general.
16. Mr. Malynicz’s main criticisms were directed at the Hearing Officer’s treatment of the evidence. First, he says, the Hearing Officer should have disregarded the Opponent’s survey. The Applicant and the Opponent are former business associates in a joint venture to produce sportswear and other merchandise for the Samurai Rugby Sevens team founded by the Opponent. The survey was conducted in order to support the Opponent’s contention that STASH is a generic term understood by rugby players and other sportsmen to mean “kit”. The Applicant concedes that some use has been made of the word “stash” to describe rugby clothing but only amongst a small group of persons linked to the Opponent or the Applicant on a professional or personal level. The Opponent carried out the survey using a questionnaire distributed through his contacts within the game of rugby as well as at tournaments including the World Sevens series in Dubai in December 2002. According to the Opponent, 90 questionnaires were distributed and 84 responses received. The latter showed that “stash” had a particular meaning in connection with rugby to 100% of respondents, meant rugby kit as worn by players to 94%, rugby kit supplied free of charge to 64%, rugby kit originating from the rugby club or other sponsor to 14%, and included leisurewear according to 13% of respondents. Several respondents stated that they first encountered that meaning of “stash” more than 5 years ago.
17. After citing the well known criteria of Whitford J. in *Imperial Group plc v. Philip Morris Ltd (RAFFLES)* [1984] RPC 293, the Hearing Officer accepted a number of criticisms made by the Applicant of the survey:

“21. ... Although the results have been filed I have not been told how or in what circumstances the questionnaires were distributed, save that some were distributed at various rugby tournaments. What was said by way of introduction and, therefore, whether there was any unintentional or accidental leading cannot be determined. Other questionnaires may have been sent under cover of a letter. But if that is the case the covering letter should also have been exhibited.

22. The size of the survey is relatively small. Even within the rugby community it is difficult to say whether it is statistically significant. The response rate of over 90% seems extraordinarily high unless the respondents were invited to complete the questionnaire at the time it was distributed. There also appears to be a heavy concentration of respondents from three areas, London, Suffolk and South Wales ...”

18. The Applicant submits that those criticisms alone should have led the Hearing Officer to conclude that the survey evidence was unreliable. However, there were other failures to meet the *RAFFLES* criteria that the Hearing Officer did not take into account. First, the Hearing Officer took insufficient note of the lack of independence and transparency in conducting the survey. In particular, the Hearing Officer should not have been influenced by the fact that contacts of the Opponent were invited to pass the questionnaire to their associates producing a “pyramid effect” because this was contained in submissions and not in evidence. I am unable to accept these criticisms. To my mind, the Hearing Officer clearly appreciated the defects in the methods of conducting the survey. Furthermore, the Applicant’s “pyramid effect” point is misconceived. The additional information concerning the distribution of the questionnaire was included at paragraph 17 of Sands 2 and was properly evidence in reply. Nevertheless, I believe there is justification in Mr. Malynicz’s second submission that the Hearing Officer failed to consider the nature of the survey questions themselves. A key question asks:

“Does the word “stash” have any particular meaning to you in connection with rugby?”

The question directs the person answering it into a field of speculation upon which that person might never have embarked had the question not been put.

19. I believe the Applicant is right to contend that the survey results are unreliable. Indeed, that also seems to have been the view of the Hearing Officer when he said (at para. 23):

“I conclude that justifiable criticisms can be made of the survey but the results cannot be discounted entirely.”

However, since it transpired that the Hearing Officer did place reliance on the survey results in one important respect namely, to ascertain whether STASH was customary in the current language or in the bona fide and established practices of the trade at the relevant date, 25 February 2002, I believe it is

incumbent upon me to undertake a careful examination of the remaining evidence relied upon by the Opponent in the case.

20. The Opponent's remaining evidence in support of the section 3(1)(b) – (d) objections comprised Exhibits TS 2 – TS 4 and TS 6 – 8 (TS 5 is the survey) to the witness statement of Terence Edward Dennis Sands dated 17 January 2003 ("Sands 1") and Exhibits TS 9 – TS 15 to Sands 2. Exhibit TS 2 is a copy of an advertisement included in the programme for Anglia Countrywide and St. Joseph's College, 13<sup>th</sup> National Schools Rugby Festival, 23 – 24 October 1999. The advertisement is in a former trading name of the Opponent, Titan Sportswear, and offers a "full range of all rugby teamwear & equipment, aftermatch leisurewear, high profile brands, replicas, printed or embroidered apparel". The brands CANTERBURY OF NEW ZEALAND, COTTON OXFORD, and GILBERT surround the details of Titan's mail order service and underneath are the words "Quality Stash". The Hearing Officer thought the words were used in a descriptive sense but to me the use is equivocal. The capital "S" for "Stash" is to be contrasted with use of lower case for all but the first word in "Mail order service" above it. I bear in mind that, in the statement of grounds of opposition, the Opponent argued in the alternative prior common law rights in the mark STASH. Mr. Sands exhibits the advertisement as an example of his own use of "stash". This is true also of Exhibit TS 4, which is an invitation sent out by Mr. Sands to players inviting them to play for The Samurais at the Amsterdam Sevens on 23 – 24 May, 1998. The relevant part of the invitation reads:

<b>"The Captain</b>	Mike Boys of Tredegar
<b>The Stash</b>	Need I say more, you know the score!! the Best looking and the best quality kit in the Business. Just wait till you see it!!
<b>Other Tournaments</b>	We have received invites to the ..."

The Opponent conceded in Sands 2 that the invitation would only have been sent to about 20 players. The Hearing Officer found with regard to Exhibits TS 2 and TS 4 (at para. 25):

"... they are not in themselves indicative of widespread use and may be said to purely reflect Mr. Sands understanding/use of the term. They are also unlikely to have received wide circulation."

21. Exhibits TS 3 and TS 6 are solicited letters to which the Hearing Officer afforded no weight. Exhibit TS 7 comprises two e-mail messages. Both are dated after the relevant date. The first is dated 2 January 2003 and is from [JamesChicken@priceforbes.com](mailto:JamesChicken@priceforbes.com) to "CT Du Plessis" [ctdup@samurai-sports.com](mailto:ctdup@samurai-sports.com), subject "Samurai Quotation". It concerns an order for shirts as listed on a separate page entitled "Plumbers Stash 2003". The second is dated 2 October 2002 and is from Bob Crooks to Terry Sands regarding fleeces and beanies. The e-mail concludes: "James will pop up on Monday to deliver a first XV shirt as promised. Can you get ct to give him my stash please." It is

signed “Crooksy ( Samurai 2<sup>nd</sup> 7 manager !!!!!)”. The Hearing Officer, linking TS 7 with TS 8 (see below), described both as unsolicited items where it is clear that “stash” is being used in a descriptive manner with the expectation that the addressee or reader will understand the term. I believe that there is force in Mr. Malynicz’s criticism that this is hardly surprising since the e-mails were addressed to the Opponent in each case and are just further examples of the Opponent’s own use.

22. Exhibit TS 8 again postdates the application but only by a couple months, 5 April 2002. It is headed “[www.HULLSTUDENT.COM](http://www.hullstudent.com) HULL – HULL UNIVERSITY UNION – Good Afternoon” and gives “Men’s Rugby Links”. Two of these links read: “order stash online” and “get canterbury stash online”. Mr. Sands says that “canterbury” refers to the well known rugby kit manufacturer.
  
23. Exhibits TS 9 – TS 15 contain the disputed evidence “in reply”, which I must consider in the light of Green 2. Exhibit TS 9 is a Google search undertaken in 2003 (the exact date is unclear) against “rugby stash”. About 1,770 hits were reportedly found. Hits 1 – 30 are included in TS 9. TS 10 – 15 are copies of related web pages. The first two entries on the search are for “STASH rugby kit and sportswear” and are clearly references to the Applicant’s trade mark. The third mention is to Exeter University Rugby League – Club Information . This speaks of “Available Kit (Stash)”. Exhibit TS 10 contains a copy of Exeter University Rugby League’s home web page dated 18 March 2003. The left hand menu contains an entry “Available Kit (Stash)” and a further page has a section entitled “Stash Orders” that informs: “In order to find out what any individual has ordered the ‘Stash List’ should be consulted by clicking here”. The next page has a list of names, items and prices headed “Rugby League 2002-2003 Stash List and Subs”. Mr. Malynicz says that the Applicant has supplied clothing to Exeter University since before the relevant date and the references could be to the Applicant’s goods. I shall return to that point when I consider Green 2. The fourth entry is “BUSA/ Rugby Review” and refers to “Top stash Rugby Store”. TS 11 contains copies of rugby pages from the British Universities Sports Association (BUSA) website created on 18 December 2002 and last updated on 7 August 2003. In the “Gossip” section there is an article headed “**Mega stash**” which reads: “did anyone see an article in The Sunday Times by Stephen Jones, talking about the stash the Kiwis wear. Apparently the three-layered shirts ...”. The fifth hit has no reference to the word “stash”. According to Green 2, the sixth hit is a reference to Loughborough Students Union. It concerns South Africa 2003 fundraising and an excerpt reads: “donate all the stash and bits”. The seventh and ninth hits seem to refer to the Applicant’s trade mark (confirmed by Green 2) and the eighth to a US site. The tenth hit is “Rugby Football Union – Chat”. TS 12 exhibits the related web page, which is a chat room with the following message dated 10 April 2003 from [davelarham@yahoo.co.uk](mailto:davelarham@yahoo.co.uk):

“... Depending which club, school or organisation you are coaching, they should have “stash” available; whether for free or for sale.”



Mr. Malynicz makes two points: (a) this is chat and (b) the reference could be to the Applicant's goods.

24. Turning to the second page of the Google search, hit eleven is "Oxford University Rugby – Match Report". TS 14 is a printout from the University Rugby Football Club website with a report by Edward Brooks dated 12 December 2000 (i.e. before the relevant date) of match between Oxford and Cambridge U21s. The second page reports:

"Angered by the fact that the tabs have far more stash than him Marsh was in no mood to be messed with and punished Cambridge for their insolence: 3-3."

I have some sympathy with Mr. Malynicz's comment that the meaning of "stash" in the report is unclear. Hits twelve and thirteen are "Uniservity" rugby websites. The Uniservity Men's Rugby Homepage exhibited at TS 15 says "Welcome to Boro Road Rugby Club. BORO STASH ON ORDER NOW!!! Ben Yates [08 October 2001]". TS 15 is dated before the relevant date and described by Mr. Malynicz as the high water mark of the Opponent's evidence. Hit fourteen speaks of Stash Builders and is obviously irrelevant. Hit fifteen refers to DrunkWasps.com and arguably the Applicant. There is no reference to "stash" in hit sixteen. Hit seventeen reads "but trust Pete Whitehead to find a stash, which has ..." and has no apparent relevance. Hit eighteen is BallsOnline.com advertising Markwort STASH Adult Gloves. The price is given in US dollars. Hit nineteen is a South African site. Hit twenty reads: "Heroin 'stash' plan sparks civil outcry".

25. Moving finally to the third and last page of the search. Hit twenty-one concerns Rugby School in Covington: "Yearbook stash peek at history". Hit twenty-two is for motorcycle parts. There is no reference to "stash" in hit twenty-three. Hit twenty-four arguably refers to the Applicant as certainly do hits twenty-six and twenty-seven. Hit twenty-five is similar to hit eighteen and looks like a US site. Hit twenty-eight is Hitchin Rugby Football Club and reads: "... of jelly beans to top up their glycogen stores when they are fielding, our footballers will almost certainly have a stash of fat ...". Hit number twenty-nine is Flyde Rugby and states "... Best kit and best stash by far". The printout at TS 13 shows that this is an extract from a Report on the Barcelona 7s 2003. The report itself is undated but the printout was obtained on 19 August 2003. The report ends by thanking those who contributed "to the fundraising for all our stash". Exactly what the writer means by "stash" in TS 13 is unclear. Hit 30 is OpsuPol3: "A player should have a stash of three or four mouthpieces". As a general point, Mr. Malynicz queried the helpfulness of Google searches in cases such as the present. Having completed the above exercise, I believe there is substance to his comments.
26. In summary, the evidence of any alleged customary use (a) not originating from the Opponent and (b) occurring before the relevant date comprises:

TS 14 Edward Brooks' report of a match between Oxford and Cambridge U21s, 12 December 2000.

TS 15 Boro Road Rugby Club, Ben Yates, 8 October 2001.

It is, therefore, apparent that the Hearing Officer's reliance on the survey and in particular the claim of a number of the respondents to have been aware of the term "stash" for five years or more, was crucial to the outcome of the case. In my judgment, the Hearing Officer erred in placing such reliance on the questionnaire survey.

27. The evidence of any alleged customary use (a) not originating from/linked to the Opponent (b) occurring after the relevant date and (c) leaving aside the survey, is as follows:

TS 8 Hull University Students' Union, Rugby Links, 5 April 2002.

TS 10 Exeter University Rugby League, Club Information, 18 March 2003.

TS 11 BUSA, Gossip, 18 December 2002.

TS12 Rugby Football Union, Chat, 10 April 2003.

TS 13 Flyde Rugby, Barcelona 7s 2003, 19 August 2003.

There is also the sixth hit on TS 9 concerning Loughborough Students Union, South Africa 2003 Fundraising. I now turn to consider Green 2.

28. Mr. David Green is the Managing Director of Stash (UK) Limited, the Applicant. He is also Director of Knitcraft Limited. He says that even before Stash (UK) Ltd was incorporated on 14 January 2002, rugby kit made and sold by Knitcraft Limited had been supplied under the mark STASH for some time. In his second witness statement, Mr. Green deals in turn with the Opponent's Exhibits TS 9 – TS 15, i.e. the Google search and print outs of related web pages. The thrust of his evidence is directed to showing that Knitcraft Limited and Stash (UK) Limited have supplied rugby kit to various university rugby clubs/teams since before the relevant date. These club/teams have included Exeter University Rugby Club (TS 10), university teams that compete in the BUSA competitions (TS 11), Loughborough University Rugby Club (TS 9, hit six), Lancaster University, which he says is the main feeder of players for Flyde Rugby Club (TS 13), Oxford and Cambridge college and university teams (TS 14) and Borough Road Rugby Club (Brunel University) (TS 15). In support, Mr. Green exhibits:

- (a) An e-mail from Charlie McCall, University of Exeter, Athletic Union Chair 2000-2001, dated 22 March 2001 concerning a logo, which Mr. Green says they were going to apply to Exeter's kit (DG 7).
- (b) An invoice from Knitcraft Limited to Loughborough Students Union dated 3 October 2001 concerning an order for rudy shorts. There is a reference to "*EMBROIDERY OF MOTIF STASH OVAL LEG*" for which no charge is made. A second invoice to the same addressee of even date is for "*Stash tee shirt*", 100 items white and navy (DG 8).
- (c) An invoice from Knitcraft Limited to Alistair Brown, Flyde College, Lancaster University dated 11 January 2002, which appears to relate to rugby shirts. There is no mention of STASH on the invoice (DG 10).

- (d) An invoice from Knitcraft Limited to Rupert Cross at Brunel University dated 19 February 2001. Again this appears to relate to shirts (cotton drill tops) and again there is no reference on the invoice to STASH.

As Mr. Malynicz observed, Green 2 is not “knock-out”. Nevertheless, it provides some background to my consideration of TS 9 – TS 15.

29. Mr. Malynicz made a second general criticism of the Opponent’s evidence, including the survey, to the effect that it does not show use in trade. He argues that even if the Opponent’s evidence does, as the Hearing Officer concluded, establish that the term “stash” has become widely used in rugby circles to indicate kit, particularly clothing, this is insufficient to bar registration under section 3(1)(d) of the TMA. Although he acknowledges that in the light of recent ECJ case law consumer perception must be taken into account, Mr. Malynicz’s submits that the concluding words of section 3(1)(d) qualify both the preceding phrases in that sub-paragraph, so that a mark must have become customary either “in the current language [*of the trade*]” or “in the *bona fide* and established practices of the trade” (emphasis in square brackets added).
30. I am unable to accept that argument. On my reading, there are two separate limbs of section 3(1)(d). A mark must be refused registration if, in relation to the goods or services applied for, it has become customary:
- (a) in the current language; or
  - (b) in the bona fide and established practices of the trade.

It is clear from the proviso to section 3(1), that the general objection to marks which fall within section 3(1)(b) – (d) is that they are lacking in distinctive character (Case C-299/99 *Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd* [2002] ECR I-5475, para. 58) . If the relevant public has come to view a sign in current language use as a generic name for the goods or services in question, then the objection is satisfied because the mark is prima facie lacking in distinctive character. An added requirement that the name must have become customary also in the current language of the trade is superfluous. I note that the District Court of The Hague, Civil Section D, expressed a similar view on parallel legislation in *Healing Herbs Limited v. Bach Flower Remedies Limited*, Case 02/244, 30 June 2004.

31. Mr. Malynicz based his argument on the ECJ decision in *Merz & Krell*, supra., concerning the equivalent Article 3(1)(d) of Council Directive 89/104/EEC (“the Directive”) and, in particular, paragraph 35 where the ECJ said:

“... marks covered by Article 3(1)(d) are excluded from registration not on the basis that that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which marks are sought to be registered.”

But, it is important to realise that, here, the ECJ was considering the overlap between Article 3(1)(c) and (d) of the Directive (section 3(1)(c) and (d) TMA) in the context of the second part of the referred question, whether to fall within Article 3(1)(d) a mark must describe the properties or characteristics of the goods or services concerned. Paragraph 35 on the one hand is to be compared with paragraph 26 on the other hand where the ECJ, in the course of deciding the first part of the referred question to the effect that Article 3(1)(d) must be assessed in relation to the goods or services applied for, said:

“Under Article 3(1)(d) of the Directive, trade marks which consist exclusively of signs or indications which have become customary in the current language or trade practices are to be refused registration.”

32. I was also referred to the Opinion of AG Léger (13 November 2003) and the decision of the ECJ (29 April 2004) in Case C-371/02 *Björnekulla Fruktindustrier AB v. Procordia Food AB*. But I do not believe either support the interpretation that the Applicant seeks to advance. *Björnekulla* involved Article 12(2)(a) of the Directive (section 46(1)(c) TMA), the English and Finnish (but not other language) versions of which state that a trade mark is liable to revocation if:

“in consequence of acts or inactivity of the proprietor, it has become the common name *in the trade* for a product or service in respect of which it is registered.” (emphasis added)

The ECJ followed the Advocate General in construing Article 12(2)(a) in the light of the general scheme and objectives of the Directive, particularly Article 3. Thus construed, Article 12(2)(a) could not be confined only to where the trade uses a mark generically. Instead, the relevant circles comprise principally consumers and end users and, depending on the market concerned, all those in trade who deal with the product in question commercially.

33. In the event, I do not believe this issue of the interpretation of section 3(1)(d) is central to the outcome of the appeal. “Customary” is defined in the Oxford English Reference Dictionary, 1995 as: “usual; in accordance with custom”. In my judgment, the Opponent has failed on the evidence to prove that at the relevant date STASH contravened section 3(1)(d) as consisting exclusively of signs or indications which have become customary either in the current language or in trade practices for the goods concerned.

### **Section 3(1)(b) and (c)**

34. The Hearing Officer held that if he were wrong in his finding under section 3(1)(d), he would nevertheless refuse registration under section 3(1)(b) and (c) to STASH in Class 25 and in Class 28 for sporting articles not included in other classes, with the evidence that is dated after February 2002 being indicative of what the position is likely to have been at the earlier date. However, that does not comply with the guidance of the ECJ that each ground in Article 3(1) of the Directive (section 3(1) TMA) operates independently and must separately be examined (Case C-363/99 *Koninklijke KPN Nederland NV*

*v. Benelux-Merkenbureau (POSTKANTOOR)* [2004] ETMR 771 at paras. 67 and 85). At the oral hearing of the appeal, I granted a short adjournment so that Mr. Malynicz could obtain his client's instructions in the event that I overturned the Hearing Officer's decision under section 3(1)(d). On resumption of the proceedings, Mr. Malynicz urged that, if appropriate, I should decide the appeal also under section 3(1)(b) and (c). I agree that the overriding objective is best served by that course of action.

35. Section 3(1)(c) of the TMA (Article 3(1)(c) Directive) prevents the registration of trade marks which consist exclusively of signs which may serve, in trade, to designate characteristics of goods or services. As the words "may serve" indicate, sub-paragraph (c) covers not only actual but also potential use in trade. The provision has been considered by the ECJ in a number of cases notably, Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, Case C-383/99 P *Procter & Gamble Company v. OHIM (BABY-DRY)* [2001] ECR I-6251, Joined Cases C-53/01 to C-55/01 *Linde AG, Winward Industries Inc., Rado Uhren AG* [2003] ECR I-3161 and Case C-191/01 P *OHIM v. Wm Wrigley Jr. Company (DOUBLEMINT)* [2004] ETMR 121. In *POSTKANTOOR*, supra., the ECJ summarised the correct approach:

"54. ... Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

55. The public interest requires that all signs or indications which may serve to designate the characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. Therefore, marks consisting exclusively of such signs or indications are not eligible for registration unless Article 3(3) of the Directive [the proviso to section 3(1) TMA] applies.

56. In those circumstances, the competent authority must, under Article 3(1)(c) of the Directive, determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that that might be the case in the future ... If, at the end of that assessment, the competent authority reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark."

I refer also to *Linde*, supra., for the scope of enquiry under 3(1)(c):

"75. The competent authority called upon to apply Article 3(1)(c) of the Directive to such trade marks must determine, by reference to the goods or services for which registration is sought, in the light of a

concrete consideration of all the relevant aspects of the application, and in particular the public interest referred to above, whether the ground for refusing registration in that provision applies to the case at hand.”

Finally, I note that it is sufficient if the trade mark, when used in relation to the goods or services, is likely to be viewed as an indication of origin by at least a significant proportion of the relevant buying public (*Windsurfing*, supra., para. 52, *Philips*, supra., paras. 59 – 61) which in this case is the public at large.

36. I have not found this issue easy to determine. The Applicant concedes that there has been some descriptive use amongst a small group of persons linked to the Opponent or the Applicant on a professional or personal level. But the concrete evidence of present or likely future uses by other traders is, as I have described, very thin. A few random Google hits of possibly descriptive uses within University Rugby Clubs or by Rugby enthusiasts is, in my view, not enough. Applying the tests set out at paragraph 35 above, I have concluded that on the basis of the evidence and the materials before me, the objection under section 3(1)(c) is not made out.
37. Section 3(1)(b) of the TMA (Article 3(1)(b) Directive) states that registration must be refused to trade marks which are devoid of any distinctive character. The nature of the enquiry under sub-paragraph (b) is identified by the ECJ in *Linde*, supra., as follows:

“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.”

The objection under section 3(1)(b) seems to add nothing to the objection under sub-paragraph (c). Accordingly, it too fails.

### **Conclusion**

38. In the result, the appeal succeeds. I direct that the Opponents pay the Applicant the sum of £1000 in respect of the costs incurred in the opposition and a further sum of £800 towards the Applicant's costs of the appeal including the preliminary issue, to be paid on the same basis as indicated by the Hearing Officer.

Professor Ruth Annand, 3 September 2004

Mr. Simon Malynicz of Counsel instructed by Messrs. Serjeants appeared on behalf of the Applicant.

The Opponent did not appear and was not represented.