

O-329-14

**IN THE MATTER OF APPLICATION NO 2655880
BY
THE RANGERS FOOTBALL CLUB LIMITED
TO REGISTER A SERIES OF TWO TRADE MARKS**

**RFC
&
R.F.C.**

IN CLASSES 14, 24 and 25

**AND OPPOSITION THERETO
UNDER NO 400756
BY
RUSSELL CAMPBELL**

BACKGROUND

1. On 12 March 2013 The Rangers Football Club Limited ('the applicant') applied to register the above series of trade marks in classes 14, 24 and 25 of the Nice Classification system¹. Following amendment, the specification stands as follows:

Class 14

Jewellery; necklaces, chokers, pendants, chains, bracelets, bangles, earrings, rings, toe-rings, anklets, tiaras, studs and rings for navel piercing; articles of precious metals and their alloys; goods made of precious metals and their alloys or coated therewith not included in other classes; badges, buckles, hair ornaments, keyrings, key fobs, cups, jewellery boxes, trinket boxes, boxes, money clips; badges, buckles, hair ornaments and keyrings made of precious stones; watches; stopwatches; horological and chronometric instruments; cuff-links; tie-pins; silver and gold tankards; pitchers made of precious metals and their alloys; flasks of precious metals and their alloys; precious stones; candelabras, candle sticks; statues and statuettes made of precious metals and their alloys; goblets made of precious metals and their alloys; vases and vessels made of precious metals and their alloys; works of art made of precious metals and their alloys; paper knives made of precious metals and their alloys; napkin rings made of precious metals and their alloys; gems, precious and semi-precious stones; tableware made of precious metals and their alloys; parts and fittings for all the aforesaid goods; all of the aforesaid goods relating to or for the promotion of football (soccer).

Class 24

Rugs; travelling rugs; lap rugs; towels; flags and pennants; plastic pennants; bed linen, blankets, bedspreads, brocades; cloth; fabric; table covers and table linen; place mats; napkins, serviettes and table runners; curtains; curtain holders of cloth; banners; handkerchiefs of textile; bath linen; bunting; household linen; mats of linen; coverings of textile and of plastic for furniture; covers for toilet lids of fabric; covers for cushions; loose covers for furniture; textile wall hangings; shower curtains; fabric of imitation animal skins; upholstery fabrics; hemp and jute fabric; textile piece goods; lingerie fabric; all of the aforesaid goods relating to or for the promotion of football (soccer).

Class 25

Clothing, headwear and footwear; clothing of leather and of imitation leather; money belts; t-shirts, polo shirts, rugby shirts, jackets, ties, bow ties, pullovers, trousers, socks, shirts, skirts, dresses, sweaters, sweatshirts, pants, jerseys, jumpers, waistcoats, kilts, pyjama suits, night suits, night shirts, night dresses, dressing robes; underwear; boxer shorts, briefs, bras, lingerie, garters, hosiery, corsets, bodices; romper suits, bibs; children's clothing; clothing for babies; outer clothing; blazers, coats, fleeces, padded jackets; sports clothing; track suits, training suits, football tops, football shorts, leotards, bathing suits, bikinis, swimming trunks, beachwear; swimwear; sleepwear; sports bras, jock straps; sports clothing for children and for babies; track suits, training suits, football tops, football shorts; waterproof jackets, wax jackets, oilskins, waterproof trousers, outer trousers, galoshes, waterproof coats, anoraks, wet suits for surface water sports; braces; hats and caps; shoes, sandals, slippers, training shoes, boots,

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

football boots, ski boots; gloves, mittens and scarves; belts (clothing); all of the aforesaid goods relating to or for the promotion of football (soccer).

2. Following publication of the application, on 31 May 2013, Russell Campbell (the opponent) filed notice of opposition against the application on 28 August 2013.

3. The opposition was brought under sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994 (the Act).

4. The opponent outlines his objections as follows:

“3(1)(b) the letters ‘RFC’ are used commonly as abbreviations by many clubs to indicate a rugby/football club including without limitation such clubs as Aberdeen RFC, Dundee RFC, Gala RFC, Melrose RFC, Ellan RFC, Edinburgh University RFC, Currie RFC, St Andrews RFC, Kircady RFC and Richmond RFC.

3(1)(c) the letters ‘RFC’ are used as an abbreviation to describe the services of rugby/football clubs. The letters have been used as an abbreviation since the late 19th century including with Langholm RFC which was founded in 1871. The letters are used as an abbreviation for rugby/football clubs by hundreds of clubs both professional and amateur to indicate that they are a rugby football club including without limitation Aberdeen RFC, High School and Former Pupils RFC, Dundee RFC, London Scottish RFC, Gala RFC, Melrose RFC, Ellan RFC, Stirling RFC, Edinburgh University RFC, Currie RFC, St Andrews RFC, Kircady RFC and Richmond RFC.

3(1)(d) the letters ‘RFC’ have been used since the late 19th Century to indicate rugby/football clubs. Langholm RFC was founded in 1871 and continues to play in Dumfries; Clifton RFC was established in 1872. According to a 2011 report by the Centre for International Business of Sport at Coventry University, there are now over four and a half million people playing rugby in clubs using ‘RFC’ as part of its name. There are over 1,200 rugby clubs in England using the abbreviations ‘RFC’. The letters ‘RFC’ have therefore been perceived to indicate a rugby/football club.”

5. On 23 September 2013 the applicant filed a counter statement which denied all of the grounds raised in the notice of opposition. It submitted as follows:

“1. The Applicant denies that the marks RFC and R.F.C. are devoid of distinctive character and calls upon the Opponent to prove the assertions made in Section D of form TM7 and the relevance of those assertions to its opposition under Section 3(1)(b) of the Act. Section 1(1) of the Act makes it clear that a trade mark may consist of letters.

2. The Applicant denies that the marks are excluded from registration under Section 3(1)(c) of the Act. It is denied that the letters RFC describe the services of rugby football clubs. The Opponent is put to proof of its

assertions and the relevance of its assertions to the registrability of the marks under Section 3(1)(c).

3. The Applicant denies that the marks 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. The Opponent is put to strict proof of its assertions under Section 3(1)(d) of the Act. The Applicant calls upon the Opponent to prove the relevance of third parties using RFC as part of their name to the registrability of the marks RFC and R.F.C.”

6. The opponent filed evidence and the applicant filed written submissions; neither party filed submissions in lieu of a hearing or asked to be heard.

7. I give this decision following a review of all of the material before me.

Opponent’s evidence filed as submissions

8. The opponent’s evidence consists of a witness statement by Francis McEntegart, a barrister at McEntegart Legal Limited. The statement of truth is not dated and the signature is made by the legal firm and not by the individual making the statement. Consequently, this cannot be considered evidence and I will treat it as submissions.

9. A number of documents were attached to the statement which appear to be extracts cut and pasted from the Internet. The opponent is not prejudiced by my decision to treat the statement as submissions because the specific source of these 'exhibits' is neither identified nor discernible nor are they dated. They would not have assisted the opponent's case.

The decision

10. Section 3(1) of the Act is as follows:

“3. - (1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1),

(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,

(d) 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:

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.”

11. It is well established that the absolute grounds for refusing registration must be examined separately, although there is a degree of overlap between sections 3(1)(b), (c) and (d) of the Act: see *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] E.T.M.R. 57, the Court of Justice of the European Union (“CJEU”), paragraphs 67 to 70.

12. In *Starbucks (HK) Limited, PCCW Media Limited, UK Broadband Limited v British Sky Broadcasting Group plc, British Sky Broadcasting Limited, Sky IP International Limited* [2012] EWHC 3074, Arnold J referred to summaries of the law in two decisions from the CJEU in relation to Articles 7(1)(b) and (c) of the Community Trade Mark Regulation, which correspond to sections 3(1)(b) and (c) of the Act:

“90. The principles to be applied under Article 7(1)(b) of the CTM Regulation were conveniently summarised by the Court of Justice of the European Union in Case C-265/09 P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* [2010] ECR I-8265 as follows:

‘29. ... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v. OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes 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 those of other undertakings (*Henkel v. OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v. OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v. OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v. OHIM*, paragraph 25; *Henkel v. OHIM*, paragraph 35; and *Eurohypo v. OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v. OHIM* [2004] ECR I-

10107, paragraph 78; *Storck v. OHIM*, paragraph 26; and *Audi v. OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P and C-474/01 P *Procter & Gamble v. OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v. Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v. OHIM*, paragraphs 36 and 38; and *Audi v. OHIM*, paragraph 37).

34. In that regard, the Court has already stated that difficulties in establishing distinctiveness which may be associated with certain categories of marks because of their very nature – difficulties which it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law (see *OHIM v. Erpo Möbelwerk*, paragraph 36, and *Audi v. OHIM*, paragraph 38).

...
37. ... it should be pointed out that, even though it is apparent from the case-law cited that the Court has recognised that there are certain categories of signs which are less likely *prima facie* to have distinctive character initially, the Court, nevertheless, has not exempted the trade mark authorities from having to carry out an examination of their distinctive character based on the facts.

...
45. As is clear from the case-law of the Court, the examination of trade mark applications must not be minimal, but must be stringent and full, in order to prevent trade marks from being improperly registered and, for reasons of legal certainty and good administration, to ensure that trade marks whose use could be successfully challenged before the courts are not registered (see, to that effect, *Libertel*, paragraph 59, and *OHIM v. Erpo Möbelwerk*, paragraph 45).'

91. The principles to be applied under Article 7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in Case C-51/10P *Agencja Wydawnicza Technopol sp. z o.o. v OHIM* [2011] ECR I-0000, [2011] ETMR 34 as follows:

'33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by

analogy, Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 30, and the order in Case C-150/02 P *Streamserve v OHIM* [2004] ECR I-1461, paragraph 24).

...

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, *inter alia*, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 45, and Case C-48/09 P *Lego Juris v OHIM* [2010] ECR I-0000, paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in Case C-80/09 P *Mergel and Others v OHIM*, paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 58). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

...

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No 40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).'

92. In addition, a sign is caught by the exclusion from registration in Article 7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see Case C-191/01 P *OHIM v Wm Wrigley Jr Co* [2003] ECR I-12447 at [32] and Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 at [97].

93. Counsel for PCCW relied upon two other authorities. First, Case C-273/05 P *OHIM v Celltech R&D Ltd* [2007] ECR I-1912, in which the CJEU stated at [81]:

‘In this case, it must be held that the Court of First Instance properly assessed the descriptive character of the mark CELLTECH considered as a whole and concluded that it was not established that the mark, even understood as meaning 'cell technology', was descriptive of the goods and services referred to in the application for registration. Therefore, it did not infringe Article 7(1)(c) of Regulation No 40/94.’

94. Secondly, Case T-207/06 *Europig SA v OHIM* [2007] ECR II-1961, in which the Court of First Instance (now General Court) said at [27]:

‘It follows that, for a sign to be caught by the prohibition set out in [Article 7(1)(c)], there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see *PAPERLAB*, paragraph 25, and the case-law cited there).’

The applicant’s marks

13. The application is made in respect of RFC and R.F.C.. Since RFC will not be seen by the average consumer as anything other than three letters, i.e. it cannot be considered to create a new word by removing the dots, I will refer to the marks as RFC so as to include the mark R.F.C..

The relevant public

14. As the above case law indicates, the distinctive character of the trade marks applied for must be assessed, first, by reference to the goods the subject of the opposition and, secondly, by reference to the perception of those goods by the relevant public.

15. The relevant public is defined in *Matratzen Concord AG v Hukla Germany SA – C-421/04* (CJEU):

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

16. The relevant public for the opposed goods in classes 14, 24 and 25 is the general public, with the exception of precious stones in class 14 which may also be purchased by, inter alia, jewellers and watchmakers.

17. The date at which the distinctiveness of the applicant's trade marks must be assessed is the date of the application for registration, namely, 12 March 2013. I must make an assessment on the basis of the trade marks' inherent characteristics, and, if I find the trade marks are open to objection on that basis, I must then determine, whether the trade marks have, in fact, before the date of the application for registration, acquired a distinctive character as a result of the use made of them.

Acquired distinctiveness

18. In its submissions the applicant states that it has used the letters 'RFC' to indicate trade origin of its goods for many years. It includes details of several registrations which it describes as 'monogram' marks before concluding:

"It has also used the marks which are the subject of the present application in block capitals, in both formats RFC and R.F.C.. This use has included use on jewellery and clothing and dates from at least as early as January 1995. The applicant has therefore used the marks as unique identifiers of the merchandise of Rangers Football Club which, of course, has the initial letters RFC."

19. No evidence has been filed by the applicant to explain, for example, the actual trade marks used, what goods were sold under the trade marks, turnover achieved under the trade marks, amounts spent on promoting the trade marks and so on. Consequently, I have only the inherent characteristics of the trade marks to consider.

Limitations to the applicant's specification

20. All of the goods classes in the applicant's specification include the limitation 'all of the aforesaid goods relating to or for the promotion of football (soccer)'. Following the decision in *PostKantoor*² an exclusion of objectionable goods may be acceptable to the Registry at the examination stage or in response to an opposition, providing it excludes a characteristic of those goods. In my view, jewellery which relates to or promotes soccer is not a sub-category of jewellery any more than textile goods relating to or promoting soccer are a sub-category of those goods in class 24. The limitation does not limit a characteristic of the goods in these classes. Furthermore, such a limitation lacks clarity. I am not convinced, for example, that a precious stone in class 14 could 'relate to' or 'promote' soccer without being included in a larger item of jewellery.

21. In respect of the limitation in class 25, football clothing or 'kit' which relates to or promotes soccer could be considered a subcategory of clothing and is an acceptable limitation.

The objection under section 3(1)(c)

22. Due to the interplay between the absolute grounds for refusal under section 3(1), I will deal first with the objection under Section 3(1)(c) of the Act, the general

² C-363/99

principle of which is provided in *Agencja Wydawnicza Technopol sp. z o.o. v OHIM* - [2011] ETMR 34 (CJEU):

“36. In examining that argument, due account must be taken of the objective pursued by art. 7(1)(c) of Regulation 40/94 . Each of the grounds for refusal listed in art.7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (C-456/01 P & C-457/01 P) [2004] E.C.R. I-5089; [2004] E.T.M.R. 87 at [45], and *Lego Juris A/S v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (C-48/09 P) [2010] E.T.M.R. 63 at [43]).

37 The general interest underlying art.7(1)(c) of Regulation 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *Wrigley* [2004] E.T.M.R. 9 at [31] and the case law cited).

38 With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of art.7(1)(c) of Regulation 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*Wrigley* [2004] E.T.M.R. 9 at [32]; *Campina Melkunie* [2004] E.T.M.R. 58 at [38]; and the order of February 5, 2010 in *Mergel v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (C-80/09 P) , not yet reported, para.37).

39 By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (*Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber* (C-108/97 & C-109/97) [1999] E.C.R. I-2779; [1999] E.T.M.R. 585 at [35], and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99) [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [58]). It is, furthermore, irrelevant whether there are other, more usual, signs than *693 that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland* [2004] E.T.M.R. 57 at [57]).

40 It follows from the foregoing that the application of art.7(1)(c) of Regulation 40/94 does not require the sign at issue to be the usual means of designation. Paragraph 37 of *Procter & Gamble* [2002] E.T.M.R. 3 , which is relied upon by *Technopol* and which uses the terms “no different from the usual way of designating the relevant goods or services or their characteristics”, cannot therefore be understood as defining a condition for refusing to register a sign as a Community trade mark.”

23. The opponent objects to the application under this section because:

“the letters ‘RFC’ are used as an abbreviation to describe the services of rugby/football clubs.”

24. The applicant submits:

“5...What is clear from the material [the opponent’s evidence], however, is that the letters RFC are never used alone. They are always preceded by the name or initial of the rugby football club.

7. The letters RFC may be used as an abbreviation for ‘rugby football club’ but that is not a description of services it is an abbreviation of part of a name. The opposition under Section 3(1)(c) is not well founded and should be struck out.

9. It is clear from Section 1(1) of the Act that there is express provision for trade marks consisting of letters. Whether a letter mark is registrable will depend upon whether the average consumer of the goods at issue would expect goods offered for sale under the mark to originate from a single undertaking. The fact that the letters RFC may be used as part of the name of a rugby club to indicate that it is a rugby football club does not mean that the mark RFC or R.F.C. when used alone cannot perform the function of indicating trade origin for goods. Exhibit 4, for example, refers to Gala Rugby Football Club merchandise but the abbreviation used in the examples shown refer to GRFC. The applicant submits that without the preceding name or initial the letters RFC will not be seen as ‘rugby football club’.”

25. The opponent submits that the three letter combination ‘RFC’³ is used by a number of rugby clubs in the UK. However, as the applicant submits, in order for the letters to function in the way described by the opponent, it is necessary that they be used as a suffix with another identifier preceding the letters, e.g. Aberdeen RFC. By analogy the letters Ltd (Limited Company) operate in a similar way, being identified by the preceding company name. In isolation the letters may have any number of meanings or no meaning at all, simply being seen as a three letter combination.

26. I have no submissions from the opponent providing its reasons as to why the letters RFC are descriptive of the opponent’s goods. The only submission is that RFC is descriptive for the services of rugby clubs. It is clear from cases such as *Europig* that there must be a sufficiently direct and specific relationship between the sign and the goods and services to enable the average consumer to perceive, without further thought, a description of the goods and services or one of their characteristics. The goods at issue are goods in classes 14, 24 and 25 and not the services of a rugby club.

³ RFC and R.F.C. are both used by the examples of rugby clubs provided in the opponent’s written submissions.

27. Even if I were to accept that RFC solus indicated the suffix 'rugby football club' (and I do not believe this is the case when used without an identifier such as a geographical location or other club name), it is far more likely that the average consumer of the goods, who is a member of the general public, will simply see the marks as a three letter combination. These are not 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 the applicant's goods in classes 14 and 24.

28. With regard to the applicant's clothing, footwear and headgear items in class 25, these are limited to 'goods relating to or for the promotion of football (soccer)'. RFC does not describe a characteristic of these goods whether it is considered to mean rugby football club or whether it is seen as a three letter combination.

29. The opposition under section 3(1)(c) fails.

The objection under section 3(1)(b)

30. The general principles of this section are provided in *Combi Steam Trade Mark*⁴:

"7. It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs "a residual or sweeping-up function", backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: *Procter & Gamble Ltd's Trade Mark Application* [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Case C-363/99 *Koninklijke KPN Nederland BV v Benelux-Merkenbureau* (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]. However, the converse is not true: a mark which is not descriptive may nevertheless be devoid of distinctive character for other reasons (ibid.).

8. When a trade marks examiner assesses the distinctiveness of a trade mark within the meaning of section 3(1)(b), s/he must do so firstly by reference to the goods or services listed in the specification, and secondly by reference to the perception of the mark in relation to such goods or services by the relevant public, which consists of average consumers of the goods or services in question, who are deemed to be reasonably well informed, observant and circumspect: Joined Cases C-53/01 to C- 55/01 *Linde AG, Winward Industries Inc and Radio Uhren AG* [2003] ETMR 78 at [41].

⁴ *BL O/363/09 (AP)*

9. It is not necessary to show that a mark has a particular level of creativity or originality in order to establish distinctive character: Case C-329/02P *SAT.1 Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 (ECJ) at [41]. While the Court of First Instance (“CFI”) has repeatedly referred to “a minimum degree of distinctive character” as being sufficient to avoid article 7(1)(b) of the CTMR/article 3(1)(b) of the Directive (for example, Case T-34/00 *Eurocool Logistik GmbH & Co. KG v OHIM* (“EUROCOOL”) [2003] ETMR 4 at [39]; Case T-128/01 *Daimler Chrysler Corp v OHIM* [2003] ETMR 87 at [33]; Case T-320/03 *Citicorp v OHIM* (“LIVE RICHLI”) at [68]), the ECJ has not adopted this wording and has deemed it unnecessary to give any more precise definition to the possible dividing line between lack of distinctiveness and the minimum distinctiveness to which the CFI refers: *Deutsche Krankenversicherung AG v OHIM* (“COMPANYLINE”) [2002] ECR I-7561 at [20].

10. The ECJ approaches the issue of distinctiveness by reference to the underlying purpose of article 3(1)(b) of the Directive/7(1)(b) CTMR, which in the Court’s view is to preclude registration of trade marks that are incapable of performing the essential function of guaranteeing the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin: *SAT.1 v OHIM* at [23]; Case C-37/03 P *BioID AG v OHIM* [2005] ECR I-7975 (ECJ) at [27].”

31. Under this section the opponent submits:

“3(1)(b) the letters ‘RFC’ are used commonly as abbreviations by many clubs to indicate a rugby/football club”

32. The applicant submits:

“6. The opponent alleges that the mark is devoid of distinctive character because the letters RFC are used commonly as abbreviations by many clubs to indicate a rugby football club. The applicant asked the opponent to prove the relevance of this assertion to its opposition under Section 3(1)(b). The opponent has not done so. Opposition under Section 3(1)(b) should be rejected.”

33. It is clear from decided cases such as *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co. KG*⁵ that letter marks must be assessed for distinctive character in relation to the goods and/or services in question, as with other types of marks.

34. In order to succeed under this section the applicant’s marks must be shown to be incapable of performing the essential function of a trade mark, i.e. to distinguish its goods from those of other undertakings.

⁵ C-265/09 P (CJEU)

35. As was the case under 3(1)(c), the opponent must show that the applicant's marks are non-distinctive for its goods in classes 14, 24 and 25. The only submissions before me from the opponent are that the letters RFC are commonly used by rugby clubs. In the absence of any evidence or submissions regarding the use of RFC for the opponent's goods and in light of my findings above, I cannot make such a finding. The three letters RFC used in respect of the goods in class 14, textile goods in class 24 and clothing in class 25, are capable of acting as a badge of origin. With regard to the goods in class 25, even if RFC is seen as an abbreviation for rugby football club, by the relevant public, rugby is not a non-distinctive term for goods relating to soccer any more than cricket is a non-distinctive term for goods relating to tennis.

36. The opposition under section 3(1)(b) fails.

The objection under section 3(1)(d)

37. The general principles with regard to this section of the Act are provided in *Telefon & Buch Verlagsgesellschaft mbH v OHIM*:⁶

"49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the 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 (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (BSS, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and BSS, paragraph 39).

⁶ T-322/03 (GC)

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and BSS, paragraph 40).”

38. In respect of its pleadings under this section the opponent submits:

3(1)(d) the letters ‘RFC’ have been used since the late 19th Century to indicate rugby/football clubs. Langholm RFC was founded in 1871 and continues to play in Dumfries; Clifton RFC was established in 1872. According to a 2011 report by the Centre for International Business of Sport at Coventry University, there are now over four and a half million people playing rugby in clubs using ‘RFC’ as part of its name. There are over 1,200 rugby clubs in England using the abbreviations ‘RFC’. The letters ‘RFC’ have therefore been perceived to indicate a rugby/football club.”

39. The applicant submits:

“8. The opponent argues (under Section 3(1)(d)) that the letters ‘RFC’ 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 having been used since the late 19th century to indicate rugby/football clubs. The applicant put the opponent to strict proof of its assertions and called upon the opponent to prove the relevance of third parties using RFC as part of their name to the registrability of the marks RFC and R.F.C....The use of RFC by rugby clubs as part of their name, e.g. Aberdeen RFC, has no relevance to Section 3(1)(d) of the Act. Those letters will always be preceded by the name of the club. They are never used in isolation. The opposition under Section 3(1)(d) is not well founded and should be struck out.”

40. As is clear from the case law above, whether a mark is customary in the trade can only be assessed, first, by reference to the goods in respect of which registration is sought and secondly, on the basis of the target public’s perception of the mark and requires evidence of that trade.

41. Registration should only be refused under this section of the act where the sign (RFC) has become customary in the current language or in the bona fide and established practices of the trade to designate the goods (or services) for which registration is sought (the applicant’s goods in classes 14, 24 and 25).

42. The opponent’s submissions are that *the letters ‘RFC’ have been used since the late 19th Century to indicate rugby/football clubs*. The application is made in respect of a number of goods and not to the provision of rugby club services or any other services. I have no evidence before me which shows any use of the letter

combination RFC in respect of the trade in goods in class 14 or the textile goods in class 24 or clothing in class 25.

43. Even if I were prepared to conclude that the three letters, RFC would be understood by the target public as meaning rugby football club (and I am not), in the absence of evidence to the contrary, I am not prepared to accept that RFC is customary in the trade for the applicant's goods in classes 14 and 24, nor to clothing relating to or promoting football in class 25.

44. The opposition under section 3(1)(d) fails.

Conclusion

45. The opposition fails under sections 3(1)(b), 3(1)(c) and 3(1)(d).

COSTS

46. The opposition having failed the applicant is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. I have taken into account that no hearing has taken place and award costs on the following basis:

Preparing a statement and considering the other side's statement:	£ 300
Written submissions:	£ 300
Official fee:	£ 200
Total:	£ 800

47. I order Russell Campbell to pay Rangers Football Club Limited the sum of £800. 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 30th day of July 2014

**Ms Al Skilton
For the Registrar,
the Comptroller General**