

# O-049-18

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATIONS NO 3,084,505 IN THE NAME OF  
YUDAN TROPHY LIMITED

AND IN THE MATTER OF AN APPEAL FROM THE DECISIONS OF LOUISE WHITE  
DATED 19 OCTOBER 2016 (O/488/16)

---

## DECISION

---

### Introduction

1. This is an appeal from the decision of Louise White, for the Registrar, dated 19 October 2016 in which she dismissed the opposition of Hallam FC under sections 3(6) and 5(4)(a) of the Trade Marks Act 1994 to Youdan Trophy Limited's ("YTL") application number 3,084,505. Hallam FC appeals the decision.
2. YTL's application number 3,084,505 was for the following mark:



3. At the bottom of the mark are the words "Est 1867" and then "Sheffield". The application is for services in Class 41 namely "Organization of football games". Hallam FC based their opposition on having rights in the words THE YUDAN CUP.

### *Hallam FC and the trophy*

4. Hallam FC is a football club based in Sheffield. While it is now a modestly successful club which currently plays in Division One of the Northern Counties East Division, it is a club which has a very proud history. It is said to be the second oldest football club in the world, having been formed in 1860 (the oldest being Sheffield FC which was formed in 1857). It has Sandygate, its football ground, which is claimed to be the oldest football ground in the world. It also won the Youdan Cup in 1867, a fact upon which this appeal turns.

5. The background to this cup is as follows. The competition was between twelve teams. It was sponsored by a theatre promoter called Thomas Youdan. It was therefore known both at the time, and subsequently, as the Youdan Cup. In 1867, the Cup was won by Hallam FC. The competition ran only once and so the cup was never awarded to any other football team. The competition was played under the Sheffield Rules and not the Association Football Rules. It is recognised by Guinness World Records as the oldest football (rather than Association Football) competition.
6. The trophy itself was given to Hallam FC when it won the competition in 1867. Sometime thereafter the trophy was lost before being rediscovered and repurchased by the club from an antique dealer in Scotland in 1997. The trophy itself is said to be an important football artefact.

*This case*

7. This appeal has had a somewhat complicated procedural history. Originally, the matter was due to be heard before Ms Amanda Michaels, sitting as an Appointed Person, on 12 May 2017. Hallam FC applied for Ms Michaels to recuse herself as she was in chambers with Mr Hicks (who now represents YTL but did not do so before the Hearing Officer). In her decision *Youdan Cup* (O/359/17), Ms Michaels held that she did not need to recuse herself, but as the matter could be allocated to another Appointed Person she would do so as a precaution. The case was therefore allocated for me to hear the substantive appeal.
8. After the matter was allocated to me, Hallam FC submitted further evidence it wished to be considered on appeal. It did not make a formal application to admit the evidence. At the hearing, Mr Hicks said the evidence was not relevant and objected to its being admitted. It was not clear how Hallam FC was intending to rely on the new evidence at the hearing and so I indicated that should any of the evidence prove relevant I would apply the principles from *Ladd v Marshall* [1954] 1 WLR 1489 as to whether it should be admitted. In the end I found that none of the additional evidence would have had “an important influence on the result of the case” (see *Ladd v Marshall*, p 1491) and so I did not allow it to be admitted.
9. At the lunch adjournment it became clear that the case was not progressing. Mr Hicks indicated that he would need about 30 minutes for his submissions. I therefore directed that I would sit until 5pm; Mr Hicks would have 30 minutes to make his submissions and Dr Loveluck could have the rest of the day to make his remaining submissions (allowing him to make well over four hours of submissions). The case was just about heard in one day.
10. After the hearing, I received a letter from Dr Loveluck indicating that Hallam FC intended to apply to amend its pleadings to add two new grounds of objection under section 3(3)(b) and 3(4) of the Trade Marks Act 1994. While the application was not formally made, I gave a preliminary indication that such a course of action would require a new hearing to be held on an entirely new basis and so it would not be

appropriate to allow the amendment. In the end no application to amend was actually made.

### Standard of appeal

11. The principles applicable on appeal from the registrar were considered in *TT Education Ltd v Pie Corbett Consultancy* [2017] ETMR 26 by Daniel Alexander QC sitting as the Appointed Person. These principles have now been approved and applied by the High Court; see for instance: *Royal Mint Ltd v The Commonwealth Mint and Philatelic Bureau Ltd* [2017] EWHC 417 (Ch) at paragraph 18 and *Apple Inc v Arcadia Trading Ltd* [2017] EWHC 440 (Ch) at paragraph 11.

12. Mr Alexander summarised the position at paragraph 52 of his Decision (I made a few minor updates to this summary in *Grill'O Express* (O/140/17), paragraph 6, which I have incorporated in square brackets):

52. Drawing these threads together, so far as relevant for the present case, the principles can therefore be summarized as follows.

- (i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR [52.21]). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong ([...][CPR 52.21]).
- (ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF, DuPont*).
- (iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B and others*).
- (iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country and others*).
- (v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be "clearly" or "plainly" wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).
- (vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson and others*).

## O-049-18

Bearing in mind the repeated reminders that different points are likely to be particularly relevant in other cases, this is not intended to be a summary of universal application for other cases where particular aspects of the approach may require different emphasis.

13. I will apply these principles.

### Section 5(4)

14. Dr Loveluck's basic submission was that the Hearing Officer had not properly considered the evidence before her when she held that Hallam FC had no goodwill in the mark THE YOUDAN CUP.

15. He made an additional point, which I will deal with first. In her decision (paragraph 22), the Hearing Officer stated the relevant date was 4 April 2014 and that a certain event took place a full year later when they took place in March 2015. The date of filing of the application was 4 December 2014. While this is a clear error, none of the Hearing Officer's findings would have been affected by the date moving forward seven months to the correct date. Accordingly, the error is not material.

16. In the Hearing before me, Dr Loveluck began his case on the basis that Hallam FC had goodwill in the image of the cup as well as in the words THE YOUDAN CUP. However, as the TM7 referred to words THE YOUDAN CUP only, I did not allow Dr Loveluck to pursue claims in relation to the image. In any event, the application in suit did not include a picture of the trophy held by Hallam FC, or indeed any trophy, so it would not have helped Hallam FC's case to include any goodwill in the image.

17. In summary, Dr Loveluck put forward evidence to show that *possession* of the Youdan Cup had provided an income to Hallam FC. In other words, people and businesses had provided money (or sponsorship) to Hallam FC to see (or even hold) the trophy. He also put forward evidence that having been the winner of the Youdan Cup was part of the *brand identity* of Hallam FC and demonstrated its antiquity (in footballing terms).

### *Goodwill in what?*

18. The classic definition of goodwill is that of Lord Macnaghten from a case on stamp duty *IRC v Muller* [1901] AC 217, 223-4:

What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade. One element may preponderate here and another element there. To analyze goodwill and split it up into its component parts, to pare it down as the Commissioners desire to do until nothing is left but a dry residuum ingrained in the actual place where the business is carried on while everything else is in the air, seems to me to be as useful for practical purposes as it would be to resolve the human body into the various substances of which it is said to be composed. The goodwill of a business is one whole, and in a case like this it must be dealt with as such.

19. In the same case, Lord Lindley stated (at p 235)

Goodwill regarded as property has no meaning except in connection with some trade, business, or calling. In that connection I understand the word to include whatever adds value to a business by

## O-049-18

reason of situation, name and reputation, connection, introduction to old customers, and agreed absence from competition, or any of these things, and there may be others which do not occur to me. In this wide sense, goodwill is inseparable from the business to which it adds value, and, in my opinion, exists where the business is carried on. Such business may be carried on in one place or country or in several, and if in several there may be several businesses, each having a goodwill of its own.

20. Dr Loveluck, using these definitions, argued that Hallam FC had goodwill in the mark THE YOUDAN CUP. In fairness to Dr Loveluck, as the House of Lords made clear, goodwill can be generated by “anything that adds value to a business” and includes “location” and “connection” (per Lord Lindley). Accordingly, using these definitions it is clear that the location of the trophy and Hallam FC’s connection with the trophy can be part of the club’s goodwill.
21. However, passing off does not protect all goodwill. As it is expressed in Wadlow, *The Law of Passing Off* (5<sup>th</sup> Ed, 2016) at paragraph 3-3:

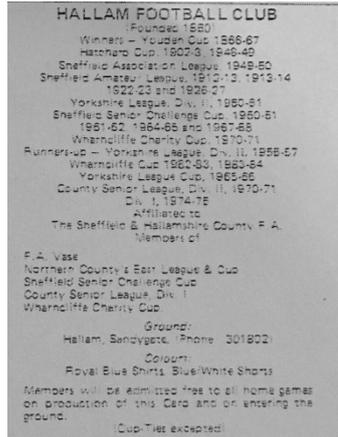
...Fortunately, for the purposes of passing-off one need only be concerned with those components of goodwill which are capable of being damaged by misrepresentation. Natural advantages of the claimant’s business, such as its situation, are not likely to be so damaged...
22. He continues at paragraph 3-4:

Goodwill is to be considered as a whole. Passing-off requires only that damage should be caused to the goodwill of the claimant’s business as a result of the defendant’s misrepresentation. It is therefore unnecessary to sever the claimant’s goodwill into its various components: damage of any recognised kind to the whole or any part of the goodwill is sufficient....Components which are obviously incapable of being damaged by misrepresentation, such as the advantage of being in a busy shopping street, are inapplicable to passing-off and may be disregarded.
23. While a claim for passing off can involve things other than signs and get up, this is not the case in relation to an objection under section 5(4)(a). For such an objection to be made out, it is necessary for goodwill to be attached to a particular sign or get up, which in this case is THE YOUDAN CUP.
24. Accordingly, while the possession of the trophy itself may create goodwill in a business it is not the sort of goodwill that is protected by passing off. To use a more general example, the British Museum holds in its collection The Rosetta Stone, which enabled the deciphering of Egyptian hieroglyphs. There will be some visitors who go to the museum simply to visit or study the Stone. Thus, the Stone’s situation (location) creates goodwill in the British Museum as it “brings people” to the museum. However, in each case, it is the sort of goodwill which is disregarded for passing off; it is similar to the goodwill arising from being on a busy street. Similarly, lectures held on, or special exhibitions including, the Rosetta Stone would attract people to the Museum to hear the lectures or attend the exhibitions. However, such use is merely descriptive of the lectures or exhibition being hosted and does not create the relevant goodwill no matter how many people turn up to look or listen. What applies to the British Museum and the Rosetta Stone equally applies as regards Hallam FC and the Youdan Cup.
25. Similarly, the fact Hallam FC won the Youdan Cup adds to its “brand”. In many things, being “first” is something that is remembered and sought after. Where a person does

## O-049-18

something “first” he or she may be awarded an honour or be given sponsorship as other individuals and traders may wish to associate themselves with this success. However, neither Sir Edmund Hillary nor Tenzing Norgay are entitled to exclude others from using the word Everest. Similarly, Sir Robin Knox-Johnston does not have the right to use the name *Golden Globe* for a yacht race just because he was the first (and to date) the only person to win. In the footballing context, Tottenham Hotspur won the 1901 FA Cup as a non-league club (and it remains the only non-league club to achieve this feat). This is part of the brand of Spurs, but the club has no rights in the name of the cup.

26. In each of these contexts, a positive “connection” is created with being the first (or only person) to achieve something. It is part of the goodwill of the individual or club, but it is not the right sort of goodwill. Furthermore, critically, it does not give goodwill to the person in the name of the competition itself.
27. Accordingly, neither the possession of the trophy nor the fact Hallam FC is the one and only winner of the Youdan Cup (and known to be so) enables them to prevent anyone using those words (or anything colourably similar) under the law of passing off.
28. The next issue is, irrespective of the fact it won the cup, whether the conduct of Hallam FC enabled it to claim it has goodwill in the mark THE YOUDAN CUP. In this respect, the evidence put forward is very weak. Dr Loveluck explained that the accounts of the club were on a computer which was password protected and the person who knew the password has subsequently died. Even though it may be possible to circumvent passwords on computers, I am happy to accept that the accounts are essentially “lost”. However, as it is for Hallam FC to present the evidence demonstrating goodwill, I cannot make any assumptions based on these accounts.
29. In relation to her finding that there was no goodwill, the Hearing Officer made a few minor immaterial errors (such as suggesting Hallam FC was the oldest football club in the world, rather than the second oldest). However, Dr Loveluck goes further and suggests that there were other errors in her summary of evidence (see paragraphs 8 to 23 of the Decision). In each case, the “errors” he identified in the Hearing were all consistent with the evidence and so were not errors at all.
30. Instead of rehearsing all the evidence again (all of which I have considered), I will use two examples which show the fundamental problem with Hallam FC’s claim to goodwill in the mark THE YOUDAN CUP.
31. In the Hearing below and before me, Dr Loveluck relied on a picture of a season ticket. The only reference to the Youdan Cup in the ticket was on the page setting out Hallam FC’s successes in various competitions:



32. On this page the reference to the Youdan Cup is on the third line down in this list. Clearly, this evidence no more generates goodwill in the mark THE YOUDAN CUP than it does in the YORKSHIRE LEAGUE CUP, which Hallam won in 1965-6 or the SHEFFIELD AMATEUR LEAGUE which it won 1912-3, 1913-4, 1922-3 and 1926-7.
33. Another example of evidence put forward by Dr Loveluck was the hoarding outside Sandygate:



34. This includes the statement "Winners of the World's First Football Trophy" and a picture of the trophy (the claret jug in the bottom left hand corner of the blue section). Nowhere on the hoarding do the words THE YOUDAN CUP appear and so clearly it cannot generate goodwill in those words. I do not need to consider whether goodwill is created in the claret jug picture as this was not part of the opposition.
35. None of the evidence put forward at the hearing below, or any of the additional evidence which was submitted (but never admitted into evidence) for the appeal, provides sufficient evidence that Hallam FC have goodwill in the words THE YOUDAN CUP. Any goodwill the club possesses in relation to the cup is not the kind that is protected by passing off. Accordingly, I agree with the Hearing Officer's conclusion in paragraph 30:

As regards goodwill, it is noted that it is a force associated in connection with a business. Hallam FC clearly has a goodwill in terms of the operation of a football club. However, the attractive

force that brings in custom is the name Hallam FC. The Youdan Cup is not used as part of the attractive force to bring in custom but merely reflects a historical fact that the club was the first and only winner of the cup. I am not persuaded that consumers on seeing a football tournament run under the name YOUDAN TROPHY would believe that the operation had anything to do with Hallam FC, even if they were aware of the historical fact. The activities undertaken by Hallam FC are not therefore a definable trade offered under the name of the Youdan Cup. Rather, they are those which form a secondary part of its core business (i.e. playing competitive football) and the Youdan cup forms part of the historical content of these offerings, based on the historical event. There is no evidence that this historical event has acquired a distinct identity of its own in a manner in which goodwill can attach. Further, any “goodwill” associated with any of these activities would clearly attach to the name Hallam FC itself. The basis of the opposition in so far as it is based upon Section 5(4)(a) therefore fails.

36. I therefore dismiss Hallam FC’s appeal under section 5(4)(a).

### Section 3(6)

37. Dr Loveluck framed Hallam FC’s objection under section 3(6) on numerous grounds. First, he objected on the ground that YTL had no *bona fide* intention to use the mark as registered. Secondly, he made various allegations about improper conduct by YTL. Thirdly, he claimed that YTL were aware of Hallam FC’s “rights” when they applied to register the mark. Finally, he alleged that the use of “Est 1867” was misleading and suggested a link with the original 1867 tournament which was not true.

#### *No bona fide intention to use*

38. Hallam FC’s first submission was that there was no *bona fide* intention to use the mark. This was based on allegations that since the application was made, YTL have only used a variation of the mark and not the mark exactly as registered. The TM7 did not include any such allegation and it appears that the issue was raised in the Second Witness Statement of Dr Loveluck. In any event, it was not considered below and I will not now do so. Nevertheless, while I do not need to consider the matter, it is clear that use of a mark includes use in a form which does not alter its distinctive character (see Trade Marks Act 1994, ss 6A(4)(a), 46(2) and 47(2A) also see Directive 2008/95/EC, art 10(1)(a)). This means, in simple terms, there is no requirement to use exactly the same mark for there to be a *bona fide* intention to use.

#### *Improper conduct*

39. The second set of allegations put forward by Hallam FC related to alleged conduct by YTL and its agents, which Dr Loveluck submitted was improper. An allegation of bad faith under section 3(6) requires the *application* to be made in bad faith. Thus, the improper conduct has to relate to the application itself and not a trader’s general business practices. In general terms, a fraudster can obtain a trade mark provided none of that fraudulent activity relates to the trade mark application itself. Put simply, it is not the role of the registry to carry out assessments of business virtue. It would be quite improper, therefore, for me to consider these sorts of allegations in relation to a trade mark application.

#### *Earlier rights*

## O-049-18

40. The third set of allegations were largely based on the existence of Hallam FC having earlier rights in THE YOUDAN CUP. As a matter of historical fact, it is clear that YTL knew about the Youdan Cup tournament and that Hallam FC had won that tournament in 1867. Indeed, had the earlier tournament never occurred I doubt the name YOUDAN would have even been considered by YTL. However, as the Hearing Officer and I have both found, Hallam FC did not have goodwill in the name THE YOUDAN CUP or any other rights in that name. In the absence of protectable rights, this ground of bad faith must fail.

### *Established "1867"*

41. The final set of allegations were those which were developed fully at the hearing. Essentially, Dr Loveluck argued that the inclusion of the words "Est 1867" in the trade mark suggested that there was a link between the original tournament run in 1867 and the tournament started by YTL when, in fact, there was no such link.

42. Dr Loveluck made reference to the Consumer Protection from Unfair Trading Regulations 2008 (SI 2008/1277) and submitted that YTL implying its tournament was connected to the original tournament would be a breach of those regulations.

43. Both these allegations, although made as part of a section 3(6) objection, would more properly be made as an objection under sections 3(3)(b) and 3(4).

44. Many traders indicate to consumers that a business has been running for a number of years by saying somewhere that the business was established in a particular year. There are commercial advantages in suggesting a business has been trading for years. The sense of permanence may increase consumer trustworthiness. The fact the business has existed for a long period of time also suggests that it is successful enough to stay in business, imparting some degree of a quality stamp. In some cases, simply being the oldest might attract business; for instance, people want to visit the oldest pub simply for a drink. Indeed, this sense of history attracts people to place where there is little trace left of the event in question; for instance, many old battlefields are now agricultural fields or open scrub land but they attract visitors nonetheless.

45. This equally applies to competitions. It is reasonable to assume, everything else being equal, a football team is more likely to enter "the oldest football competition in the world" than a competition which has just started and so has no history.

46. Furthermore, just because a venture existed historically does not mean a modern trader may link its business with the historic one when no relationship exists. For instance, it would be misleading if a person looks in the records and finds that in 1320 a public house was located on a particular street and it was called the "King's Head". Assuming the pub had long gone, a trader cannot then open a business on that spot in 2018, call it the "King's Head" and then claim the business was established in 1320. The claim of establishment suggests some degree of continuity – albeit what sort of continuity is required may be open to debate.

47. Accordingly, a trade mark which by its nature *actually* deceives the public as to the length of time a particular service has been provided might be contrary to section 3(3)(b) of the Trade Marks Act 1994. Importantly, where the mark is deceptive in itself it cannot be remedied by corrective statements (*Associates v Gloucestershire Old Spots Pig Breeders' Club* [2010] ETMR 12, paragraph 25 and 26; adopted by me in *TWG v Mariage Frères SA* (O/358/17) at paragraph 84).
48. In the evidence provided, particularly in the interviews by those promoting the modern competition, it is clear that the Youdan Trophy is presented as a new or resurrected tournament. Nevertheless, in the new evidence submitted by Hallam FC there are some instances where the current competition has been suggested to be the oldest tournament in the world such as @YoudanTrophy asking people to “Help support the world’s oldest football tournament!” (in a Tweet on 17 July 2017). Just as corrective statements cannot make a trade mark less deceptive, statements made in conjunction with a trade mark cannot make the use of that mark itself deceptive so as to prevent registration. Accordingly, the new evidence cannot assist Hallam FC’s case and so I do not need to consider whether it should be admitted.
49. The germane issue is whether “Est 1867” as part of the trade mark itself would lead the average consumer into believing that the services offered today had been offered in some way since 1867 and whether this can be an objection under section 3(6). As section 3(3)(b) was not one of the grounds of objection considered below or during the hearing before me, I do not need to consider whether it can be made out on that basis. In any event, Mr Hicks suggested that there were uses of the mark which would not be deceptive (and the omission of “Est 1867” might be one, provided this does not alter the mark’s distinctive character). Accordingly, I make no findings.
50. Similarly, for the same reasons as outlined above, the use of the trade mark might breach the 2008 Regulations and if this is the case it might give rise to an objection under section 3(4). Again, I make no finding in this regard.

*Attempt to add new grounds under section 3(3)(b) and 3(4)*

51. Hallam FC did not object to the application in suit under either sections 3(3)(b) or (4). When I mentioned these grounds at the beginning of Mr Hick’s submissions, Dr Loveluck submitted that there was nowhere on TM7 to set out this objection and so he should be entitled to oppose on these grounds.
52. When I pointed out the box on TM7 marked “**Other** state any other part of section 3 you reply on and give your grounds” he accepted that the objection could and should be set out in this box. However, he went on to say that this box was not helpful to litigants in person as it was not clear what other grounds might be. I agree that when TM7 is revisited again it might be better to clarify what other section 3 grounds remain, rather than simply saying “Other”.
53. Nevertheless, litigants in person must play by the same rules as other parties (as I discussed in *Be3D* (O/173/17), paragraph 9 to 16) and a litigant should not be able to

## O-049-18

introduce entirely new grounds of opposition mid-way through an appeal hearing when it becomes apparent such grounds may have been more appropriate (save in the most exceptional circumstances). Similarly, when a few weeks after the hearing, Dr Loveluck indicated that Hallam FC would be applying to amend its TM7 to add these new grounds I gave a preliminary indication that such an application would likely be refused. As I mentioned above, in the end the application was never made.

54. Accordingly, Dr Loveluck's case is restricted to suggesting that the use of "Est 1867" in YTL's mark means that the application was made in bad faith (and as indicated in paragraph 49, it is far from clear that a challenge on other grounds would succeed).

*Are deceptive trade marks made in bad faith?*

55. Mr Hicks's submission on this point was simple. He pointed to Arnold J's summary of the law on bad faith in *Red Bull GmbH v Sun Mark Limited and Sea Ait & Land Forwarding Limited* [2012] EWHC 1929 (Ch), paragraph 135:

...As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties...

56. Mr Hicks accepted that these two classes were not exhaustive, but as yet no other classes have been identified. Furthermore, he suggested that the use of the words "Est 1867" being misleading (if they were) did not fall into either category identified by Arnold J and the use of these words was of a quite different nature. Therefore, he submitted, it was not something which should be prevented under bad faith.

57. In response to a question from me, Mr Hicks submitted that section 3(6) cannot be the basis of an objection where it is better founded under another specific provision of the section, such as section 3(3)(b). I think this must be right. Findings of bad faith are not there for sweeping up assorted conduct, but to prevent the abuse of the trade mark system (see *Melley's TM Application* [2008] RPC 20 at paragraph 51). The mischief caused by deceptive marks (and accordingly prevented by section 3(3)(b)) is not an abuse of the trade mark system itself. I provide one caveat to this general statement, it may be that an objection under section 3(6) can be made out where the use of the mark would be deceptive and by this fact it can be proved that the applicant had no *bona fide* intention to use the mark (see *TWG v Mariage Frères SA* (O/358/17) at paragraphs 67 to 71).

58. Accordingly, I reject all of Dr Loveluck's submissions under section 3(6).

### **Outcome**

59. I therefore dismiss the appeal and uphold the Decision of the Hearing Officer.

### **Costs**

60. At the Hearing, YTL indicated that if the Appeal is dismissed an application will be made for so called "off-scale" costs. Accordingly, I direct that YTL provides any written submissions and a schedule of costs within fourteen days of the date of this

## O-049-18

decision; and Dr Loveluck may provide written submissions in response within fourteen days thereafter. I will then make any further directions required.

61. If the Respondent does not provide any written submissions then I award £1,500 as a contribution to YTL's costs for this appeal. This is in addition to the award of £3,000 made by the Hearing Officer. Accordingly, the total costs award against Hallam FC would be £4,500.

PHILLIP JOHNSON  
THE APPOINTED PERSON  
17 January 2018