

TRADE MARKS ACT 1994
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

DECISION

Introduction

1. On 12 March 2013, The Rangers Football Club Ltd (“the Applicant”) applied under number 2655880 to register the designations “RFC” and “R.F.C.” in series under s.41(1)(c) of the Trade Marks Act 1994 (“the Act”) as trade marks for use in relation to a wide range of goods in classes 14, 24 and 25.
2. The list of goods for which protection was requested, following amendment of the application for registration in May 2013, was (with the permitted amendments shown underlined):

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

3. The qualification underlined was added to the specification at examination stage to overcome an objection raised by the examiner under sections 3(1)(b) and (c) of the Act, an objection based on “RFC” being an abbreviation for RUGBY FOOTBALL CLUB. The qualification had an apparent intention to limit the goods to the field of soccer (association football) and, therefore, avoid the rugby football objection.
4. The application for registration was opposed by Mr Russell Campbell (“the Opponent”) in a Notice and Grounds of Opposition filed under number 400756 on 28 August 2013. It was contended that registration should be refused under ss.3(1) (b), (c) and (d) of the Act. The main point advanced under each of these heads was that “RFC” is an abbreviation for “rugby football club” and that the mark is, consequently, devoid of distinctiveness, descriptive and commonly used as such. The opposition was maintained despite the soccer qualification.

5. The Opponent filed evidence and the Applicant filed only written submissions.
6. The Registrar's hearing officer, Ms Al Skilton, rejected the opposition by a decision and made an award of costs of £800 in favour of the Applicant. The Opponent appealed to the Appointed Person. That appeal came before Mr Geoffrey Hobbs QC who, in a decision dated 25 August 2016, decided (among other points) that there had been an insufficiently stringent and full examination of the objections to registration as envisaged by the case law from the CJEU and he was not satisfied that that the hearing officer had given "real and sufficient weight to the significance of the letters "RFC" as an abbreviation for 'rugby football club' in her consideration of the objections to registration on the basis of the papers on file". Accordingly, the matter was remitted to another hearing officer for decision.
7. By a further decision dated 20 July 2017, a different hearing officer, Mr Oliver Morris acting on behalf of the Registrar, also rejected the opposition. The Opponent has therefore appealed again to the Appointed Person and this is my decision in respect of that appeal. The Applicant has been professionally represented throughout the proceedings by Ancient Hume although it took no part in the appeal before me. The Opponent initially had legal representation but is now acting in person.
8. By a procedural order made shortly after the scheduled date for the hearing in June 2018 (which had already been adjourned once) I directed that the appeal should continue in writing because the Opponent had not attended on the day and had said that he had missed his train. I took the view that, in the light of the written submissions made by the Opponent and the earlier decisions including that of Mr Hobbs QC which summarised the potential concerns relating to registration of the mark by reference to the key authorities, no additional benefit would be gained by rescheduling the hearing yet again for further oral submissions.

The arguments advanced and the "bad faith" point

9. The nature of the arguments before each of the tribunals considering this issue has been substantially the same and focuses on the significance of the fact that "RFC" is an abbreviation of "rugby football club". However, the Opponent advanced quite lengthy submissions after the case had been remitted for further consideration by Mr Hobbs QC alleging that the mark had been applied for in bad faith. The hearing officer dealt with this issue as follows:

“21. The opponent states that his intention was to oppose on section 3(6) grounds all along, but that his representative in Liverpool (McEntegart Legal Limited) did not follow his instruction. I find it highly improbable that a firm of legal representatives would simply ignore an instruction from a client. It is also highly improbable that the opponent would not have seen the letters/forms submitted on his behalf. This raises the question as to why, if it was not his intention, he allowed the proceedings to continue on a false basis for a number of years. This does not make a fertile basis for a request to amend the pleadings so late in the day.

22. I accept that the registrar has discretion to amend pleadings (and to accept further evidence in relation to them), even at this very late stage in proceedings. I also accept that the opponent is currently without legal representation and that trade mark proceedings are not always the easiest to follow. This is why the opponent was sent a number of very clear directions (on 25 November 2016) so that the Tribunal (and the applicant) could clearly and concisely understand the opponent’s intentions and what impact they would have on the proceedings. However, the opponent simply did not respond. It only responded when a subsequent letter was sent to it, although that response still did not comply with the directions and it merely contained more of the same (as per the opponent’s original letter).

23. Directions were then issued as to how the case would proceed (the original grounds only) but the opponent was given an opportunity to be heard. No request to be heard was made. The only response was more (or similar) of the same. The letter from Mr Gallagher does not assist – he is not a party to the proceedings.

24. The opponent may be of the misapprehension that the Tribunal can simply allow his new ground and accept what he has filed as evidence and then issue a decision in his favour. Whereas, in fact, even if some form of amendment was permitted, time periods would have been required for the other side to amend its counterstatement, for the opponent to file evidence (none of his submissions were in evidential form), for the applicant to be given a chance to file its evidence on the new ground and then for the opponent to reply. This would then have led to another chance to request a substantive hearing or file submissions in lieu. Effectively, the proceedings would have to start again from scratch.

25. In circumstances where the opponent failed to respond to the Tribunal’s directions when first set, together with the fact that he has yet to do so, nor requested a hearing to challenge the preliminary view to proceed upon the basis of the original grounds only, I find that it would be disproportionate and inequitable for the applicant to have to face further delay and give any further credence to the section 3(6) ground. I will proceed on the original grounds only.”

10. This aspect of the decision is sought to be made one of the subjects of this appeal. In my view, that is unfounded and procedurally impermissible. This was an unimpeachable exercise of the hearing officer’s case management powers to refuse to permit a different case to be advanced at a late stage in the proceedings. No formal application was made to amend the grounds of opposition at any stage and the grounds of appeal do not in terms contend that the hearing officer was wrong in exercising his

discretion to refuse to consider this point. He was, in my view, clearly right to refuse permission to amend in all the circumstances and I would in any event only be justified in reversing that decision if it was particularly clear that he was wrong.

11. In reaching this conclusion, I have taken account of the materials in the letter written by the Opponent to the Registry dated 15 August 2017 which, among other things, provides reasons for why the section 3(6) objection was not included by the opponent. They do not affect the correctness of the hearing officer's decision in this respect.

The central issues on the appeal – sections 3(1)(b), (c)-(d) Trade Marks Act

12. I therefore turn to the central issue on this appeal namely whether the hearing officer was wrong to hold that the mark was not precluded from registration by the operation of sections 3(1)(b)-(d) of the Act.

The decision

13. The hearing officer dealt with the central issues as follows. First, he recorded at para. [37] that these provisions prevent, respectively, registration of trade marks which are “..devoid of any distinctive character”, “..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” or “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”. Next, he noted the effect of the proviso to section 3(1) which is not relied on in this case. He bore I mind (see para. [39]) that the grounds of appeal were independent and have differing general interests. He observed that it was possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(b) of the Act and referred to *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P.
14. Since the basis on which the decision is challenged does not really distinguish between the separate heads of objection and the points made under each of the grounds of objection were closely related, it is convenient to consider first how the hearing officer dealt with them and then the compendious grounds of attack on all of them.

The grounds of decision

15. Under **section 3(1)(c)** the hearing officer recorded the case-law of as summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) at [91]-[92] and which is not said by the appellant to be incorrect in any respect on this appeal.

16. He evaluated the case advanced on this ground as follows:

“41. I can deal with this ground relatively briefly. The ground of opposition is pleaded as follows:

“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.....”

42. Thus, even on the pleaded case, it is not even claimed that the abbreviation RFC is used (or is capable of being used) as a description of the goods of the application. Whilst I fully accept that RFC describes the nature of a sporting club, it does not follow that it describes the goods in classes 14, 24 and 25. Even in respect of the worst case scenario (rugby clothing in class 25, which would fall within various of the broad terms listed), I struggle to see what characteristic RFC would be describing. Whilst the word RUGBY would clearly describe a characteristic of rugby clothing – indicating its suitability for use in playing that sport – RFC does not do the same because the letters relate to a club not the sport itself. One would not describe the clothing as suitable for RFC. The ground under section 3(1)(c) is dismissed.”

17. Under **section 3(1)(d)**, at para. [39], the hearing officer took the (unchallenged) legal principles from *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, where the General Court summarised the case-law of the CJEU under the equivalent of s.3(1)(d) of the Act, as follows:

“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).

18. He evaluated this ground as follows at para. [44]:

“44. The evidence shows use of the letters RFC as a part of a longer name (or part of a longer series of letters). There is no use of RFC alone. Even when the letters are used, in it is not in a manner which designates the goods of the application. It is being used in a manner which designates the nature of the particular sporting club. For a mark to fall foul of the objection it must be the mark put forward for registration that has become customary – RFC alone. If the ground could apply to the use of the trade mark as part of longer expressions then that would render a large number of perfectly good trade marks vulnerable. For these reasons, shortly stated, the objection fails.”

19. Under **section 3(1)(b)**, the hearing officer took the (again unchallenged) principles from *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) which I need not set out in full. He reminded himself of the guidance provided by Mr Hobbs QC in the earlier decision in the case where he noted:

“24. The examination had to be stringent and full: Technopol (above) at paragraph [77]. It had to be carried out in relation to each of the goods listed in the application for registration, with collective assessment being appropriate only with respect to goods which are interlinked in a sufficiently direct and specific way to the point where they form a sufficiently homogenous category or group: Case C-597/12P Isdin SA EU:C:2013:672 at paragraphs [22] to [30]. The fact that various kinds of goods can, from a commercial point of view, be classified as ‘merchandising goods’ is not sufficient, without more, to enable them to be treated as constituents of a homogenous category or group: Case T-501/13 Karl-May-Verlag GmbH EU:T:2016:161 at paragraphs [8] and [64] to [75].

25. The exploitation of name, badge and image ‘rights’ is (and there is an abundance of case law relating to registered and unregistered trade marks demonstrating that it is) a widespread and well-established commercial practice. The limitations added by amendment (albeit legally ineffectively) to the application for registration in the present case are premised upon the proposition that all of the various kinds of goods listed in classes 14, 24 and 25 can be endowed with characteristics that will render them marketable under prevailing marketing conditions as ‘*goods relating to or for the promotion of*’ sporting activities and events. I would not expect the Registrar, with his immense experience of applying trade mark law to real world commercial activities, to dismiss that as an entirely undeliverable proposition. And if, as specifically envisaged by the limitations, it can realistically be regarded as a deliverable proposition, within the coverage of the application, in areas of trading activity linked to ‘*football (soccer)*’, it would be counter-intuitive to assume that it could not also be realistically regarded as a deliverable proposition, within the scope of the application, in areas of trading activity linked to ‘*rugby football*’. Thus

embracing the likelihood of the letters **FC** functioning commercially as a reference to ‘football club’ in the name or emblem of an entity trading in the area of goods relating to or for the promotion of *‘football (soccer)’* and the likelihood of the letters **RFC** functioning commercially as a reference to ‘rugby football club’ in the name or emblem of an entity trading in the area of goods relating to or for the promotion of *‘rugby football’*.”

20. The hearing officer applied that guidance in the analysis of the marks in question. In key passages of the decision he said:

“48. Having found that the mark is not descriptive of, or generic for, the goods, the possibility of a sign such as this being devoid of distinctive character is most likely to be on the basis that it will be perceived as indicating a person’s allegiance to the sport of rugby – e.g. that he/she is a fan of rugby. This would most obviously be relevant for goods such as t-shirts, hoodies, key rings etc., as such goods are often used for carrying messages of one form or another. However, RFC, as stated earlier, describes the club not the sport. Therefore, whilst signs such as RUGBY or RUGBY FOOTBALL would signify an allegiance to the sport, I have difficulty in accepting that RFC does likewise. I accept that the letters will be known and recognised, but it does not follow that the mark is not capable of performing the essential distinguishing function. Familiarity does not necessarily equate to non-distinctiveness. As I have already said, there is no evidence of RFC being used alone in a rugby football context. The unusualness of seeing the letters alone (without a preceding word or letter) instead of with reference to (as part of) a specific club, and that the letters do not reference the sport per se, suggests to me that the relevant public (even in the context suggested by Mr Hobbs) would regard the mark as a badge of trade origin. It is clearly allusive, but it is still capable of denoting trade origin and will, essentially, be seen as the RFC brand.

49. I acknowledge that the specification covers not just the type of goods mentioned in the preceding paragraph which are apt to carry messages of one form or another, but also goods which have a clear rugby purpose (rugby kit for example). However, even from that perspective, and absent an additional name/letter, I see no reason why the mark would not indicate the trade origin of such goods irrespective of its allusive qualities. Without a preceding name, the letters RFC alone are unlikely to be regarded as part of the formal name of a rugby football club. In that case, the use would be out of its usual context and therefore unusual. Used in that way I see no reason why such a sign would not be taken as a fancy mark designating the goods of a particular undertaking. If, on the other hand, RFC is seen as an abbreviation for Rangers Football Club, as the opponent appears to envisage, then I note that the names of football clubs have been found to be distinctive as trade marks, irrespective of whether they also function as badges of allegiance for fans of the club...”

21. Accordingly, he found that the objection under section 3(1)(b) was not made out.

The appeal

22. Other than the objection to the failure of the hearing officer to address the question of alleged bad faith which I have considered above, it is not easy to discern from the grounds of appeal or the supporting documents why it is said that the decision is erroneous.
23. The grounds of appeal say that the decision is “perverse, ignoring all evidence provided (copious and encyclopaedic) of current and previous use of applied for mark [sic], accepting the submission by the applicant of use ‘since 1990’s’ despite no evidence being provided”. They also complain about the repeated reference to ‘rugby football club’ and suggest that the prominence given to it is a violation of basic civil law principles. Finally, they say that the decision “ignores criminal law implications of grant of mark” [sic]. This is one of those situations in which fairness to the Opponent and to the Applicant requires the tribunal to engage in a modest degree of reformulation of the thinking behind the grounds, which were, it appears, written without legal advice, in order for them to be fitted into the conventional legal framework. There is, however, a limit to which that can be done in fairness to the Applicant. I have tried to strike a reasonable balance in doing so.
24. First, it is not suggested either in the grounds of appeal or in any of the documents subsequently submitted by the Opponent that the hearing officer applied the wrong principles of law and it seems to me that his approach was right with one possible qualification namely that his statement of the manner in which a mark could be descriptive of characteristics of goods in para. [42] of the decision may be said not to be all encompassing (see below). So the appeal is, as I take it, really about whether the hearing officer’s evaluation was wrong. Second, it is not suggested that the grounds of appeal are specific to any given head of objection under section 3(1) of the Act. In my view, of the sections, the strongest ground of attack on these marks lies under section 3(1)(c) (descriptive of goods associated with a rugby football club) and if the hearing officer did not err in his determination under that section, the case will be no better under the other heads. Third, the reference to the criminal law implications is, in my judgment, misconceived. The Opponent is concerned that registration of the marks will place a commercial weapon in the hands of the applicant which would criminalise the sale of unauthorised merchandise in certain circumstances. That may be a consequence of registration but it is not a ground of objection to registration as such.

Approach to appeal

25. In *Apple Inc v Arcadia Trading Ltd* [\[2017\] EWHC 440 \(Ch\)](#) (10 March 2017), Arnold J said at [11]:

Standard of review The principles applicable on an appeal from the Registrar of Trade Mark were recently considered in detail by Daniel Alexander QC sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [14]-[52]. Neither party took issue with his summary at [52], which is equally applicable in this jurisdiction: "(i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR 52.11). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong (Patents Act 1977, CPR 52.11). (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)."

26. I apply those principles to the present case and, in particular, to the contention that the hearing officer's evaluation was perverse which I take to be an allegation that he was wrong in the relevant sense.

Discussion

27. First, it is important to note that the grounds of objection to the mark were not that the mark was devoid of distinctive character/descriptive or customary because of its reference to Rangers Football Club. The ground of objection under each of the heads was that "RFC" would be used or taken to be used to refer to something else completely namely a rugby football club. It is worth observing that there is no suggestion that the opponent himself intends to use the initials "RFC" on or in relation to the goods in question for the purpose of denoting or referring to a rugby football club: the opponent's business involves use of those initials to refer to Rangers Football Club. That is the reason why the initials RFC appear on the goods.
28. Second, the evidence taken as a whole (and indeed the grounds of opposition themselves) do not suggest that there has been any use of "RFC" on its own to denote a rugby football club. The use of "RFC" identified in the evidence which makes such a reference involves the use of some (often geographical) description (such as "Aberdeen RFC"). However, as the hearing officer said in para. [29] of the decision, the grounds of opposition had to be determined on the basis that the letters "RFC" will not only be recognised as an abbreviation for "rugby football club" when accompanied by a preceding word (more often than not a geographical name) but that the letters may also be recognised as the abbreviation for those words when the manner in which they are used are conducive for such a perception to arise.
29. Third, the case law has not been unequivocal in permitting a football club to prevent a person who sells merchandise bearing the registered trade mark of the club to do so (on the footing that the mark is only a badge of allegiance rather than a badge of origin), the CJEU and the English courts have not suggested that there is anything wrong in principle in deploying a mark which is otherwise validly registered for that purpose (see for example *Arsenal Football Club Plc v Reed* [2003] EWCA Civ 696 (21 May 2003)). That case concerned the mark "Arsenal", and therefore did not have to consider a situation in which a mark was used by a club to denote the origin of its goods but was also capable of being used (and is in fact used) by other traders or sports clubs as part of terms (or marks) to denote the characteristics of their goods as connected with such

clubs in some way. Mr Hobbs QC was therefore right to consider that the present situation required close scrutiny to ensure that registration of the mark would not act as an undue obstacle to third parties using the mark descriptively.

30. Fourth, the close scrutiny involves considering not only whether the term in question is directly descriptive of physical characteristics of the goods themselves (such as in the example given by the hearing officer of “RUBGY” as being descriptive of a characteristics of a rugby football shirt) but also whether the term is descriptive in a wider sense of denoting what might be termed a “connectional” characteristic of the goods in question. Such characteristics are of diverse kinds and a need for close scrutiny arises in those situations since the nature of the characteristics of the goods that the term may be describing is not always self-evident. One example is where a mark is sought to be registered for goods which are said to be commemorative of an event (see for a recent example the decision of Mr James Mellor QC sitting as the Appointed Person in *BREXIT TM* O-262-18, 27 April 2018 analysed under section 3(1)(b)). I have therefore given the points made by Mr Hobbs QC in para. [25] of his decision particularly close attention to determine whether the hearing officer’s decision in the present case fell short of what was required.
31. Having done so, I consider that the hearing officer sufficiently addressed this concern in his decision notwithstanding that his evaluation of whether the marks were descriptive of the goods in para. [42] of the decision, may be said not to cover all the possible relevant characteristics of goods which a term may describe. Key to the point is the fact that the uses identified of “RFC” for a rugby football club were limited to situations in which the acronym was used with another term. No other use for any goods was referred to in the evidence. So while the term “RFC” as such could be used as descriptive of such a club without an addition, there was no evidence that this was done in practice. That is an important aspect of context which the hearing officer was entitled to and did take into account. That is reinforced by the fact that the opponent was not himself using “RFC” to refer to any rugby club and did not suggest that he was. This suggests that the primary denotation of “RFC” without any addition is not of a “rugby football club”, even though it could be used to designate such.
32. Fifth, there is a sliding scale of descriptiveness (compare *Bongrain SA, Re Trade Mark Application* [2004] EWCA Civ 1690 at [26]). At one end are terms which are wholly descriptive regardless of addition and regardless of context. They can never act as marks. At the other end are marks which are plainly distinctive and have no possible

descriptive connotation, even “connectional”, with respect to the goods or services in question. There is a range in between, where some terms have descriptive connotations, or where elements of context either of the term itself or as to the mode of its use are critical in determining whether or not the term is descriptive and if so of what. The case law from the CJEU such as *Doublemint* (Case C-191/01P *OHIM v. Wm Wrigley Jr Co* EU:C:2003:579 at para. [32]) suggests that if there is any real prospect of the term in question being used descriptively for the goods in question because one of the meanings is descriptive, registration should be refused, partly on the footing that third parties should not have to fall back on defences of descriptive use in respect of their use of a term which should not be registered at all. It is considerations of this kind which lead to a need for particularly careful evaluation.

33. However, even given the need for such scrutiny and the importance of keeping ordinary terms free for use, I am unable to conclude that the hearing officer was wrong in his evaluation of the marks in question against the required legal standard under any of the heads in this case. There might be some descriptive use of “RFC” so as to mean “rugby football club” without any addition, but the prospect of that occurring was low and the dominant use of the sign as proposed to be registered was not as such. There are marks, of which the present are examples, where the prospect of descriptive use of them in the form registered (i.e. with no additional qualifier) exists but is sufficiently low that they can properly be registered despite the possibility of descriptive use. In such circumstances, it does not seem to be to be unreasonable to require those who do wish to use the marks descriptively in that way to rely on the defence that they are so doing, rather than prevent registration altogether on the footing that the possibility exists. A rugby football club (or any other trader) which used the term “RFC” (alone) in a bona fide way to refer to itself as a rugby football club or to a connection of goods or services with a rugby football club would *prima facie* be entitled to do so under the provisions of the Act (section 11). Moreover, it would be questionable whether the sign “X RFC” where “X” was the name of a rugby football club would even arguably be treated as sufficiently similar to the marks in issue for an infringement case to get off the ground at all, regardless of the potential defences.
34. In my view, on the specific facts of the case as found by the hearing officer following remittal, he reached a reasonable conclusion which was in line with the case law.
35. For those reasons I do not consider that this ground of appeal is made out.

Further observations

36. In upholding the registration of this mark in the face of this opposition, it is important to be clear what is not being decided.
37. First, nothing has been said about the potential section 3(6) objection save that it has not been admitted into these proceedings (see above). The scope of objections to registration on the grounds of no bona fide intention to use was referred to the CJEU in the recent *Sky Kick* case and raises potentially difficult questions about which I say nothing. Nor, of course, has anything been decided about whether the marks may be or may become vulnerable to revocation for non-use in respect of any goods.
38. Second, this decision does not take any view as to whether it would or would not be permissible to use the initials “RFC” on certain goods within the scope of the registrations for the purpose (for example) of indicating or enabling others to indicate allegiance to or support for Rangers Football Club. Whether that would or would not be permissible must be decided under the law of trade mark infringement, taking into account the potential defences available under section 11 of the Act and the case law, including *Arsenal* referred to above. That issue is likely to be fact-sensitive and may depend on the nature of the goods on which those initials are used, the nature of presentation of the letters, the intentions of those selling such goods and the perceptions of consumers. This decision does not hold that the opponent would (or would not be) liable civilly or criminally for dealing in any particular articles bearing the initials “RFC”. That would need to be determined separately.
39. Third, while again such would be for determination elsewhere, it seems to be that registration of this mark should not be a bar to the bona fide use of the initials “RFC” to denote a rugby football club or any goods originating from or connected with such an organisation. No-one using the initials “RFC” to denote a rugby football club or any goods or services connected with such a club should therefore have anything to fear from registration of this mark.

Costs

40. I have rejected the appeal but the applicants played no significant part in it and did not attend nor filed written submissions. No application was made for costs and I do not consider that an additional costs award would be justified in the circumstances. Accordingly, the costs ordered by the hearing officer should now be paid.

O/558/18

DANIEL ALEXANDER QC

Appointed Person

3 August 2018

Representation

The appellant in person by written submissions. The respondent did not appear.