

O-302-05

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 2376955
TO REGISTER A TRADE MARK
IN CLASSES 25 AND 26
BY SPORTING KICKS LTD**

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DECISION AND GROUNDS OF DECISION

Background

1. On 29th October 2004, Sporting Kicks Ltd of The Charter House, Charter Mews, 18A Beehive Lane, Ilford, Essex, IG1 3RD, applied to register the following trade mark in classes 25 and 26:



2. The goods for which registration is sought are as follows:

Class 25: Clothing, footwear, headgear;

Class 26: Lace, embroidery, pins, needles, buttons, hooks, pin badges, badges.

3. Objection was taken against the mark on 21st January 2005 by Mr Ian Dore, a trade mark examiner, under Section 3(3)(a) of the Act because it incorporates the words "Inter City Firm". Mr Dore set out the grounds for the objection against the mark and said "Its use is contrary to public policy as it would be seen to promote football hooliganism". He added "It is my opinion that goods bearing the mark would be promoting gangs which provoke violence". In order to substantiate the objection, Mr Dore sent to the applicant copies of extracts from the websites which show use of "Inter City Firm" and "ICF". A selection of these is shown at Annex A.

4. A hearing took place on 22nd March 2005 at which the applicant was represented by Mr Karl Hunt of Sporting Kicks Ltd. Following the hearing, I maintained the objection.

5. Subsequently on 19th July 2005, the application was refused. I am now asked under Section 76 of the Act and Rule 62(2) of the trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

6. No formal evidence of use has been put before me and therefore I have only the prima facie case to consider.

The Law

7. Section 3(3)(a) of the Act reads as follows:

“A trade mark shall not be registered if it is –

(a) contrary to public policy or to accepted principles of morality”.

The case for registration

8. Mr Hunt made the following points in support of the mark:

- The applicant has been trading for over six years and is an established leader in the sale of retro soccer merchandise which has had a continual upward growth in terms of demand and sales;
- As part of the established sale of retro merchandise, the applicant has been selling T-shirts, caps, hats and pin badges with the logo Inter City Firm;
- People who are likely to wear retro merchandise bearing the ICF Inter City Firm logo do so not because they are active hooligans but more so to identify with their respective football clubs. The sign gives a sense of identity and camaraderie for these football fans;
- The mark is therefore a retro sign that has evolved into a fashion symbol which is an identifier for football fans who have a particular affiliation for their respective clubs;
- Although hooliganism at football matches was prevalent during the early 1980s, it is now commonly accepted that the same has declined to such an extent that now
- violence in city centres due to drug and alcohol abuse is of far greater concern. Hooliganism associated with the Inter City Firm is now non-existent;
- By way of comparison, it would be wrong to refuse a mark such as THE SEX PISTOLS today because of violence that might be associated with that punk band in the 1970s;

- The registrar has in the past allowed marks which are considerably more offensive than the applicant's mark, for example:

FCUK AT HOME (E2116903) in Classes 8, 11, 16, 20, 21, 24 and 29
HOOLIGAN (M678322) in Class 25
HOOLIGAN (2199851) in Class 32
FIGHT CLUB (E3067501) in Classes 9, 25 and 16
SEX 'N' DRUGS 'N' ROCK 'N' ROLL (2064059) in Class 9
SEXY BITCH (2016709) in Classes 9, 25 and 41

9. Mr Hunt acknowledged the references supplied to him by the examiner and said that Sporting Kicks is the outlet for Inter City Firm merchandise. Mr Hunt emphasised that his firm was not promoting football hooliganism and there has not been an instance of any cause for complaint from any of the football clubs which state that the merchandise is encouraging their fans to be actively violent. Mr Hunt submitted examples of the mark in use and a selection of these is shown at Annex B.

Decision

10. The mark of the application is, on the face of it, innocuous. It includes the words "inter city" and a commonly recognised symbol, and may convey the impression that it is something to do with the railways. However, this is not the case. The Inter City Firm is a name which was chosen by a group of hooligans and in a review of a book by Cass Pennant - "Congratulations You Have Just Met the ICF" - (see that part of the Annex A headed "John Blake Publishing Ltd": Internet Bookshop") the following is stated:

"The InterCity Firm were the most notorious firm of football hooligans this country has ever seen. They were hard, terrifyingly vicious, brilliantly organised, tremendously feared and highly fashionable".

11. The objection raised against the mark is that its registration is contrary to public policy. In relation to Section 3(3)(a) of the Trade Marks Act, Geoffrey Hobbs QC, as Appointed Person, made the following observations in his decision in the JESUS trade mark, Basic Trademark SA's application [2005] RPC 25:

"1. Article 6 quinquies, para. B3 of the Paris Convention of March 20, 1883 (as last revised at Stockholm on July 14, 1967) provides for refusal and invalidity of registration in relation to trade marks that are "*contrary to morality or public order*". The corresponding rule at the Community level under Art. 7(1)(f) of the Community Trade Mark Regulation and at the national level in the United Kingdom under s.3(3)(a) of the Trade Marks Act 1994 (implementing Art. 3(1)(f) of the Trade Marks Directive) is that trade marks shall not be registered if they are "*contrary to public policy or accepted principles of morality*".

2. The objection relates to the intrinsic qualities of the mark concerned, not the personal qualities of the applicant for registration: Case T-224/01 *Durferrit GmbH v. OHIM* (9 April 2003) paras [67] to [71], [75] and [76]. It has been observed that the legislation uses the expression 'public policy' for the purpose of referring to matters of the kind covered by the French legal term "ordre public": *Philips Electronics NV v.*

Remington Consumer Products Ltd [1998] R.P.C. 283 at 310 per Jacob J. This is borne out by the use of the words “*contrary to ... public order*” in the English text of Art. 6 quinquies of the Paris Convention and the words “*qui sont contraires à l’ordre public*” in the French language versions of Art. 7(1)(f) of the Community Trade Mark Regulation and Art. 3(1)(f) of the Trade Marks Directive.

3. Both as a matter of national law (see s.3 of the Human Rights Act 1998) and on the basis that measures incompatible with observance of the European Convention on Human Rights are not acceptable under Community law (Case C-112/00 *Schmidberger Internationale Transporte und Planzuge v Austria* [2003] 2 C.M.L.R. 34, p.1043 at paras [71] to [74]) it is necessary to interpret and apply the prohibition in s.(3)(a) of the Act consistently with the provisions of the Convention (“ECHR”).

4. Consistently with Art. 10 ECHR it must be recognised that the right to freedom of expression (including commercial expression: *Casado Coca v Spain* (1994) 18 E.H.R.R. 1 paras [33 to 37]) is exercisable subject only to “*such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority or impartiality of the judiciary*”.

5. Consistently with Art. 14 ECHR it must be recognised that the aims and objectives of Art. 10 are to be secured “*without discrimination on any ground such as sex, race, colour, language, religion, political or other opinion, national or social origin, association with a national minority, property, birth or other status.*”

6. Section 3(3)(a) seeks to prohibit registration in cases where it would be legitimate for the “*prevention of disorder*” or “*protection of ... morals*” to regard use of the trade mark in question as objectionable in accordance with the criteria identified in Art. 10 ECHR. It does so in terms which disclose no intention to prohibit registration in cases where use of the relevant trade mark would not be objectionable under Art. 10 on either or both of those bases. The problem of anti-social branding is, in part, addressed under s. 3(3)(a) by accommodating the concept of “*ordre public*” within the “*prevention of disorder*” (in the French text of the Convention “*à la defense de l’ordre*”) under Art. 10. That makes it legitimate, for example, to treat the display of “*any writing, sign or other visible representation which is threatening, abusive or insulting within the ... sight of a person likely to be caused harassment, alarm or distress thereby*” as objectionable: see s. 5(1)(b) of the Public Order Act 1986. However, the right to freedom of expression must always be taken into account without discrimination under s. 3(3)(a) and any real doubt as to the applicability of the objection must be resolved by upholding the right to freedom of expression, hence acceptability for registration.

7. The latter point serves to explain the emphasis in the case law on the degree of censure involved in an adverse finding under the current legislation.”

12. It seems to me that the mark tendered for registration is a form of “anti-social branding” and a display which is potentially threatening to others and likely to cause alarm or distress.

13. In correspondence with the applicant I also referred to the decision of Mr Allan James (for the Registrar of Trade Marks) in CDW Graphic Design Ltd's Trade Mark Application for the mark www.standupifyouhatemanu.com. [2003] RPC 30 Mr James said on page 574:

“39 Normal and fair use of the applicant's mark in any of these contexts is liable to function, as Mr St Ville submitted, as a “badge of antagonism”. In my judgement, such use is liable to increase the incidence of football violence or other offensive behaviour. Consequently, I find that the application to register the trade mark is contrary to public policy, and the objection under s.3(3)(a) of the Act therefore succeeds.”

14. There is a similar problem with the present mark. I am of the view that its registration and use for clothing and badges etc is likely to lead to an increase in football violence by individuals or gangs. For instance, a football fan from Chelsea seeing a rival fan from West Ham wearing a shirt bearing the applicant's mark could easily be goaded or provoked into violence. In this sense it is a “badge of antagonism”. In fact the use of the mark on the goods at issue is liable to be seen by the public as a badge of allegiance to, or membership of, a criminal gang.

15. At the hearing and in correspondence, Mr Hunt contended that hooliganism associated with the Inter City Firm is now non-existent and the mark is considered to be a retro sign. It is difficult to prove one way or another whether the Inter City Firm is a gang which is presently in existence. Because of its association with criminal activities it is unlikely to be an organisation which would openly recruit members. However, there have been recent reports in the media concerning football violence, hooliganism and associated gangs and I sent to Mr Hunt extracts from various internet websites which supports this view. A selection of these is shown at Annex C.

16. These articles highlight my concerns that registration of the mark could result in an increase in violence associated with football hooligans. Moreover, the information contained in the annexes show that there are many recent references to the Inter City Firm. For example, under Annex A, the Wikipedia website (dated 2004) lists the Inter City Firm under “Active Hooligan Groups”. In 2001, on the “Spiked Life” website, there is a report referring to an article in the Sun newspaper (dated 13th July 1998) which says “.....Beckham and his family had been targeted by the notorious Inter City Firm (ICF) – Britain's most feared hooligans”. Although I acknowledge that the applicant's mark may be regarded by some as a “retro” sign, even if it is the case that this gang no longer exists, I am not persuaded that registration of the mark is not contrary to public policy. Football fans of today would be well aware of the violent connotations associated by the mark. The record of the gang is too current for the mark to be seen as a purely “retro” or nostalgic sign.

17. Dealing with Mr Hunt's point drawing an analogy between the applicant's mark and THE SEX PISTOLS and his contention that it would be wrong to refuse such a mark today because of violence that might be associated with that punk band in the 1970s. I do not accept the analogy. THE SEX PISTOLS may well have been controversial and at times caused offence but they were a pop group with the aim of providing musical entertainment and their activities cannot be compared with that of a criminal gang whose activities centred on violent behaviour.

18. Therefore, in conclusion of my consideration of the objection under Section 3(3)(a), it is my opinion that registration of the mark would be contrary to public policy. Such a sign falls within a category of marks that may be described as “anti-social branding”. Furthermore, the mark comprises a display which is potentially threatening to others and likely to cause alarm or distress. Given renewed interest in groups such as the Inter City Firm it is against public policy to register a mark which might be interpreted as glorifying or promoting their exploits.

19. Finally, I have to consider the question of whether the acceptance of other marks in the past has any bearing on my decision. At the hearing Mr Hunt drew my attention to several previous registrations (by various other proprietors) and argued that the applicant’s mark was not as offensive as these and urged me to accept the application. I am not aware of the circumstances surrounding the acceptance of the marks that Mr Hunt referred to and, in any event, each case must be dealt with on its own merits. In *British Sugar PLC and James Robertson and Sons Ltd* decision [1996] RPC 281 (referred to as the TREAT decision), Mr Justice Jacob said:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME trade mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

Conclusion

20. In this decision I have considered all documents filed by the agent, and for the reasons given the application is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Sections 3(3)(a) of the Act.

Dated this 11th day of November 2005

**Charles Hamilton
For the Registrar
the Comptroller-General**

There are no annexes attached