

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 1528428
BY NEWCASTLE UNITED FOOTBALL COMPANY LIMITED
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO 42565 BY TOON ARMY LIMITED AND COLIN STUART (JOINTLY)**

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**IN THE MATTER OF Application No 1528428
by Newcastle United Football Company Limited
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**IN THE MATTER OF Opposition thereto under
No 42565 by Toon Army Limited and Colin Stuart (jointly)**

DECISION

On 3 March 1993, Newcastle United Football Company Limited, of St James' Park, Newcastle Upon Tyne, applied under Section 17(1) of the Trade Marks Act 1938 to register the trade mark TOON ARMY. The application was made in Class 25 and after examination proceeded to advertisement for the specification of goods comprising:-

T-shirts; sweatshirts; hats; scarves; all included in Class 25; but not including any of the aforesaid goods adapted for wear by military personnel.

The application, numbered 1528428, was advertised for opposition purposes on 26 October 1994 and on 12 May 1995, Toon Army Limited and Colin Stuart as joint opponents filed notice of opposition to the application.

The grounds of opposition are in summary:-

1. Under Section 11 By virtue of the use the opponents have made of the trade mark TOON ARMY, the use of the trade mark applied for by the applicant in relation to the goods in respect of which the application is made is likely to deceive or cause confusion.

2. Under Section 9 & 10 The trade mark is not distinctive of the applicants' goods nor adapted or capable of distinguishing the goods of the applicant, and is not a registerable trade mark

The opponents ask the Registrar to exercise his discretion and refuse the application and that costs be awarded against the applicant..

The applicants filed a counter-statement admitting that the opponents had notified them of their intention to object to the registration of application number 1528428, but deny all grounds of opposition saying that there is no reason for the registrar to exercise his discretion to refuse the application. The applicants request that the opposition be dismissed and that costs be awarded in their favour.

Both sides have filed evidence in these proceedings and the matter came to be heard on 24 August 1998 when the applicants were represented by Mr Alan Fiddes of Dibb Lupton Alsop, their Trade Mark Attorneys. Mr Colin Stuart, a private opponent represented himself.

5 By the time this matter came up for a decision, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the 1938 Act must continue to be dealt with under that Act, in accordance with the transitional provisions set out in Paragraph 17 of Schedule 3 of the 1994 Act. Accordingly, all reference in this decision are references to the 1938 Act and the Trade
10 Marks and Service Marks Rules 1986.

Opponents' evidence (Rule 49)

15 The opponents' evidence comprises a statutory declaration dated 3 May 1996 by Mr Colin Stuart, who is the owner of a business engaged in the manufacture of fashion wear, and is a former director of Toon Army Limited, the other opponent. Mr Stuart states that he first used the name TOON ARMY as a trade mark on various fashion garments in 1992. He states that since this date he has sold approximately 200,000 items carrying the trade mark throughout the United Kingdom, principally in Newcastle Upon Tyne and the surrounding area.

20 Mr Stuart states that in 1993, he formed a Limited Company called Toon Army Limited with the sole intention of trading in goods bearing the TOON ARMY trade mark. Although the company was dissolved, Mr Stuart confirms that he has continued to use the trade mark up to the present day.

25 Mr Stuart refers to Exhibit "CS1", which he describes as "invoices showing bills for artwork done in the name of Toon Army". The Exhibit comprises two invoices from a company known as CR Print Group, who describe their activities on the invoice as "creative print, design and presentation". The first invoice, dated 30 March 1992, states that it is for the "print in two
30 colours - TOON ARMY white T shirts", 1,000 in total of various sizes. The second invoice, dated 25 February 1992, describes the work completed as "ARTWORK - TOON ARMY", "Visuals X 4", "Designs X 4" and "Artwork X 4". Both invoices make reference to work related to the words "TOON ARMY", although they do not contain examples of the actual work.

35 Mr Stuart goes on to refer to Exhibit "CS2", which he describes as "collar tags" and which he states are inserted in every garment he sells. The Exhibit comprises four identical "collar tags", which bear two identical banner type flags placed one under the other. The top banner contains the word "TOON", the lower banner contains the word "ARMY". This completes the opponents
40 evidence.

Applicants' evidence (Rule 50)

45 This consists of a two Statutory Declarations. The first is dated 29 January 1997 completed by Mr Russell Cushing, who is General Manager and Secretary of Newcastle United Football Company Limited. Mr Cushing states that the trade mark TOON ARMY is a reference to the supporters of Newcastle United Football Club, and is a mark which has been associated with the club for a considerable period of time. He refers to "Exhibit 1" which consists of pages from a

publication “United The First One Hundred Years, The Official Centenary History of Newcastle United” written by Paul Joannou. The cover page contains the title, a picture of a Newcastle United football jersey, various Newcastle United footballer and the Newcastle United Football Club crest, although there is no reference to the TOON ARMY. The second page of the Exhibit has a reference “to the clubs now famous band of supporters, the Toon Army”. The third page of the Exhibit contains pictures related to Newcastle United, one of which is captioned “Even Sir John Hall celebrated along with the Toon Army”. The fourth page of the Exhibit appears to be a duplicate of the third page. Mr Cushing claims that from this it is clear that the term TOON ARMY has long been associated with Newcastle United Football Club and its use specifically refers to the activities of the club and its fans.

Mr Cushing goes on to say that the mark TOON ARMY is often used by newspaper, television and radio when referring to Newcastle United Football Club. Mr Cushing refers to “Exhibit 2” which are copies from “The Sun” and “The Express” dated 9 January 1997. Both are reports of the departure of Kevin Keegan who had resigned as manager of Newcastle United Football Club, and describe the reaction of the Newcastle United Football Club fans, describing them as the Toon Army.

Mr Cushing further states that his company has made use of the name TOON ARMY as a trade mark in the United Kingdom in respect of clothing since at least 1991. He refers to “Exhibit 3”, a copy of a catalogue dated 1993-1994, which, from the cover can be seen to relate to the United Club Shop at St James Park. The catalogue lists various items for sale, namely; track suits, football shirts, T shirts, sweatshirts, children's wear, bibs, caps, ski hats scarves, gloves, ties slippers, underwear, overcoats, sports holdalls, souvenir badges and pennants, a book, board game and playing cards, golf balls and tees, dart flights, soft toy, a football, gift vouchers, team, player and ground photographs or prints, postcards, “best wishes” card, wrapping paper, pens, bookmarks, pencil sharpener, clocks, mugs, drinking glasses, finger and ear rings, pendants, wallets, business card holders, cheque book covers, travelling razor and an autograph book. Each item bears the Newcastle United FC crest or some other reference to the club, or the “Magpies”, the nick-name of the club. One item, a baseball cap, clearly bears a reference to the Toon Army.

The second Statutory Declaration filed as evidence in support of the application is dated 3 February 1997, and completed by Mr Alan Michael Fiddes, the Head of Trade Marks at Dibb, Lupton Alsop, the agent for the applicants. This Declaration is essentially replying to the points made in the Declaration completed by the opponent, Mr Colin Stuart. Mr Fiddes refers to statement by Mr Stuart that the company, which I take to mean Toon Army Limited, was not incorporated until 24 May 1993. Mr Fiddes states that as this is after the date on which the applicants had filed their application, it is clear that this company could not have made use of the mark TOON ARMY prior to this date, and as a consequence, his clients have the prior right. He goes on to say that the opponents have not substantiated their claim to use of the trade mark TOON ARMY in the United Kingdom since 1990, or that it has become known to the trade or public as denoting exclusively their goods.

Mr Fiddes also states that the company Toon Army Limited was, according to records at Companies House, dissolved on 14 March 1995, and consequently did not exist on the date of filing of the opposition and cannot be a party to these proceedings.

Mr Fiddes makes reference to the claim by Mr Stuart in his Declaration that he had manufactured several thousand items of clothing with the mark, but had only produced only one invoice relating to the printing of TOON ARMY on white T shirts as evidence. Mr Fiddes states that the use shown by the opponent was use as a decoration, and not use as a trade mark within the provisions of the Act, and as a consequence the opponents have no evidence of any use of the mark TOON ARMY in the United Kingdom. In support of this contention, Mr Fiddes refers to the KODIAK trade mark case (1987 RPC 269), and UNIDOOR LIMITED V MARKS & SPENCER PLC (1988 RPC 275).

In the remainder of his Declaration, Mr Fiddes refutes the allegations that use of the trade mark TOON ARMY by the applicants is calculated to deceive or cause confusion. He alleges that it is the opponents who are attempting to cause deception or confusion in the minds of the public by trying to associate themselves with the applicants activities, the claims that it is clear from the evidence that the mark is exclusively associated with the applicants. In paragraph 11 of his Declaration, Mr Fiddes concludes by stating that "The evidence submitted by the applicants quite clearly does not substantiate their claim that the mark applied for by the applicants is not distinctive or adapted to distinguish the goods of the applicants within the meaning of Section 9 or 10 of the Trade Marks Act 1938". The use of a double negative makes this a rather convoluted sentence, although the intention of the statement is reasonably obvious, in effect, that the applicants' evidence substantiates their claim that the mark is distinctive or adapted to distinguish their goods.

No further evidence was filed in these proceedings, and I now turn to consider the grounds of opposition. I will deal first with the objections under Sections 9 & 10 of the Act, which states:

9 (1) In order for a trade mark (other than a certification trade mark) to be registerable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any distinctive mark, but a name, a signature, or a word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

(2) For the purpose of this section "distinctive" means adapted, in relation to the

goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally, or where the trade mark is registered or proposed to be registered subject to limitations in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which:-

- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

10 (1) In order for a trade mark to be registerable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to the limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which:-

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

At the hearing it was established that the opponents' attack under Sections 9 & 10 was based on the argument that the mark was not the property of the applicants, and that therefore it cannot be distinctive of the applicants' goods. Mr Stuart stated that the applicants were not the originators of the name TOON ARMY. It had originally referred to the city and people of Newcastle, not the football team, and had subsequently been adopted by the supporters of the Newcastle United Football Club. I take the view that this line of argument is not a matter for consideration under Section 9 & 10 which relate to the inherent or absolute qualities of the mark.

The opponents have not provided any evidence which supports these grounds of opposition, and in his submissions at the hearing, Mr Stuart did not develop the bare grounds set out in the pleadings. It seems to me that the name TOON ARMY is an invention with no reference to the character or quality of the goods. Accordingly, I can see no basis for the objection under Sections 9 & 10 and the opposition fails on these grounds in the prima facie.

I next turn to consider the ground raised under Section 11 of the Act. That section reads as follows:

5 “It shall not be lawful to register as a service mark or part of a service mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any other scandalous design.”

10 The established test for objection under Section 11 is set down in Smith Hayden & Co Ltd’s application [Vol 1946] 63 RPC 101 as adapted by Lord Upjohn in the Bali trade mark case 1969 RPC 496. Adapted to the matter at hand the test reads as follows:

15 “Having regard to the user of the opponents mark TOON ARMY is the tribunal satisfied that the mark applied for, the applicant’s mark, TOON ARMY, if used in a normal and fair manner in connection with any services covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?”

20 The test requires me to consider the user established by the respective parties at the relevant date, that is, the date of the application for registration of the trade mark under opposition. In the grounds of opposition, the opponents claim use of the mark TOON ARMY “since at least 1990”, although in their evidence this date is given as 1992. The opponents claim to have used the mark in relation to “articles of clothing”. In turn, the applicants in their evidence claim to have use of
25 the mark “since at least 1991”, also in respect of clothing. Evidence to substantiate both claims is very limited. Neither the applicants or the opponents have provided any information relating to turnover or advertising to illustrate the extent of their use.

30 The applicants' evidence consists essentially of an extract from a book on the history of Newcastle United Football Club, and copies of articles that have appeared in newspapers. These are either undated or originate from a date after the relevant date and cannot be given any weight. The final exhibit is a copy of a catalogue dated 1993-94 which offers a range of “Newcastle United Football Club merchandise. Amongst the items offered for sale are various items of clothing, with only one item, a baseball cap, bearing the words TOON ARMY.

35 The opponents in their evidence claim that since 1992 they have sold “perhaps 200,000 items of fashion wear” carrying the TOON ARMY name. The invoices forming Exhibit “CS1” relate “artwork”, and the “printing” of TOON ARMY white T shirts”, 400 T shirts in total and Mr Fiddes on behalf of the applicants accepted that this was possible proven use of the words TOON
40 ARMY, although sought to persuade me that if the opponents have made any use of the words it was as a decoration on these T shirts, and that this was not necessarily use as a trade mark. Mr Fiddes referred me to a number of decided cases, *inter alia*, UNIDOOR LTD V MARKS & SPENCER PLC (1988 RPC 275), and the KODIAK trade mark case ((1990 FSR 49). In these cases it was held that placing a slogan on goods to advertise other goods, or using a sign in an
45 apparently decorative fashion without taking steps to acquaint the public that the sign is a trade mark, “was not bona fide use” or “caused extreme doubt” that the use was a trade mark. Applying the principles adopted in these two cases to the case in question, it could be held that

even if the opponent had used "TOON ARMY" on an item such as a T-shirt, this would not necessarily lead the public to take the words as a "badge of origin" of the T-shirt. This would depend upon the manner in which the words are used, for example, if emblazoned across the T shirt in large letters, the words could be taken as a statement that the wearer supports Newcastle United Football Club. As no example of the artwork or the T shirts have been provided I am unable to determine whether the words TOON ARMY were used, and if they were, whether this use was as a trade mark or mere decoration.

A second exhibit, "CS2" consists of four identical examples of a strip of material bearing the words TOON ARMY in two banderole flag devices. In his Declaration Mr Stuart describes these as "collar tags" which he states are inserted in every garment that he sells. There is nothing to indicate the range of garments in which these labels have been used or to determine the date from which any use commenced. I find that the opponents' evidence to establish their use of prior to the relevant date is not sufficient to sustain an objection, and that being the case they fail in their opposition under Section 11 of the Act.

There remains the matter of the Registrar's discretion. In his submissions Mr Stuart has claimed that the words TOON ARMY are used in relation to, or as a description of the supporters of Newcastle United Football Club, and not the club itself, a claim supported by the applicants' own evidence. However, I take the view that there is an inextricable link between the club and its supporters and therefore see nothing in the evidence filed in this case that persuades me that I should exercise discretion against the applicants.

As the applicants have been successful they are entitled to a contribution towards their costs. I order the opponent pay the applicants the sum of £635. As one of the joint opponents, Toon Army Limited is no longer in existence, the order is made against the remaining opponent, Mr Colin Stuart.

Dated this 16 Day of November 1998

M Foley
For the registrar
The Comptroller-General