

O-219-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2453891  
BY DAVID GEORGE ROBSON TO REGISTER A  
TRADE MARKS IN CLASSES 16, 35, 36, 38, 39, 40, 41 & 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 95858 BY BAFF (2006) LTD TRADING AS  
BRITISH ARMED FORCES FEDERATION**

## BACKGROUND

1) On 26 April 2007 David George Robson applied to register a series of four trade marks. Following examination, three of the trade marks were deleted. The representation of the trade mark that remained and which was accepted and subsequently published for opposition purposes on 12 October 2007 in Trade Marks Journal No.6705 was as follows:



2) Registration is sought in respect of the following goods and services:

Class 16: Printed materials; book-binding material; photos; stationery; office supplies; instructional and teaching materials; printers' type.

Class 35: Advertising; business management; business administration; office functions.

Class 36: Insurance; financial affairs; real estate affairs.

Class 38: Telecommunications.

Class 39: Transport; packaging and storing goods; travel arrangements.

Class 40: Treating materials.

Class 41: Education; providing training; entertainment; sporting and cultural activities.

Class 42: Scientific and technological services; design and research relating to these services; industrial analysis and research services.

3) On 11 January 2008 BAFF (2006) Ltd trading as: British Armed Forces Federation (the opponents) filed a notice of opposition. This is based upon Section 3(5) and relates to Sections 4(1)(b), 4(1)(d) & 4(2)(a) of the Trade Marks Act 1994 (as amended) (the Act). In their Statement of Grounds the opponents say:

“3.The trade mark should not be registered because it consists of or contains:

a. pursuant to s.4(1)(b), a representation of the Royal Crown, because:

- (i) the crown reproduced at the centre of the applied for mark, and/or
- (ii) the crown reproduced at the centre of the applied for mark, when placed, as it is in the applied for mark, at the centre of the Union Flag, and/or
- (iii) the crown reproduced at the centre of the applied for mark, when placed, as it is in the applied for mark, at the centre of the Union flag and surrounded by wording that indicates the mark is the mark of an organisation representing some or all of the United Kingdom armed forces,

is a representation of the Royal Crown.

b. pursuant to s.4(1)(d), words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation, because:

- (i) the crown reproduced at the centre of the applied for mark, and/or
- (ii) the crown reproduced at the centre of the applied for mark, in combination with the Union flag at whose centre that crown is placed, and/or
- (iii) the crown reproduced at the centre of the applied for mark, in combination with the Union flag at whose centre that crown is placed and the surrounding wording that indicates the mark is the mark of an organisation representing some or all of the United Kingdom armed forces,

is likely to lead persons to think that the applicant either has or recently has had Royal patronage.

c. pursuant to s.4(2)(a), a representation of the national flag of the United Kingdom and as a result of that representation the use of the trade mark, when taken either alone or in combination with the crown at the centre of the flag and/or with the wording surrounding the flag that indicates the mark is the mark of an organisation representing some or all of the United Kingdom armed forces, would be misleading. The said misleading impression would be that the applicant:

- (i) was a representative body authorised by one or more elements of the United Kingdom armed forces, and/or
- (ii) was a representative body authorised by the United Kingdom government.”

4) On 23 January 2008 Mr Robson filed a counterstatement to which was attached a number of documents. In his counterstatement he says, inter alia:

“The Combined Armed Forces UK trade mark logo did originally include the royal crown but this was subsequently changed during the application process with the [IPO]. The royal crown was removed from the trade mark and logo and replaced with a crown acceptable to the Lord Chamberlain’s office...

The claim by the opposition that the submitted trade mark and logo should not be given a certificate of registration by the IPO because it depicts the royal crown is therefore a false pretence and incorrect. Since this is the total basis of their opposition...their claims should be rejected...”

5) Both parties filed evidence in these proceedings which to the extent that I consider it necessary I have summarised below. The matter came to be heard on 9 July 2009. At the hearing, which took place by a combination of telephone and video conference, the applicant Mr Robson represented himself; the opponent was represented by Mr Douglas Young.

#### **OPPONENTS’ EVIDENCE**

6) Before I summarise the evidence provided in these proceedings, I should perhaps start by saying that a good deal of the so called evidence provided by both parties consists of submissions rather than actual evidence. At the hearing, I pointed this out to Messrs. Young and Robson and indicated that where this was the case, it was neither necessary nor indeed appropriate for me to summarise these submissions here. That said, I made it clear that I would keep them in mind when making my decision.

7) The evidence consists of a witness statement, dated 25 April 2008, by Douglas Young who is the opponents’ Chairman. Mr Young explains that while he is aware of the advice provided by the Lord Chamberlain’s office, this advice only related to the use of a crown as part of the trade mark, and not to the use of the national flag or to the use of the crown in combination with the national flag. At paragraph 6 of his statement he says:

“The opposition relates not only to the inclusion of the Royal Crown, but to the use of several symbols (Royal Crown, the national flag, and the wording) which, when taken alone or in combination, may give the misleading impression that the applicant either has or has recently had Royal patronage and/or (b) that the applicant was a representative body authorised by one or more elements of the United Kingdom armed forces and/or the United Kingdom government.”

8) Exhibit DY1 consists of an extract from the publication “British Flags and Emblems” by Graham Bartram which Mr Young explains was published in 2004 by The Flag Institute and Tuckwell Press. Of this publication he says:

“I understand that this is the leading modern authority on British flags and emblems.”

9) Mr Young then refers to the illustration of the ensign of a Queen's Harbour Master which appears on page 39 of this publication, and which he notes contains a combination of the national flag, white circle and device of a crown. Save for the letters QHM appearing in this representation, it is, in his view:

“.. identical or remarkably similar to the device contained in [the application].”

10) He goes on to make the same point by reference to the flag flown by Consular Officers ashore which appears on page 58 of the same publication. Mr Young adds:

“12. ...However the opponents are concerned that the disputed mark looks like an official flag. That it is, in fact, the same as or very similar to an actual official flag justifies that concern.

13. I accept that the crown comprised in the disputed mark can be distinguished by the informed viewer from the Royal St Edward's crown, when viewed in sufficient size and in isolation. The crown forms, however, only a small part of the total area of the disputed mark and is difficult to distinguish from a Royal crown in the typical uses of the mark on the applicant's letterhead and website. The opposition is based not only on the individual features of the crown, flag and lettering but also on their combined effect.

14. The words surrounding the device do nothing to reduce the overall misleading impression that the applicant is a representative body authorised either by one or more elements of the United Kingdom armed forces, or by the United Kingdom government. If anything, in combination with the crown and flag the words add to the overall misleading impression. For the avoidance of doubt, the applicant is not a representative body authorised by one or more elements of the United Kingdom armed forces and/or by the United Kingdom government, and, to the best of my knowledge, is not incorporated in any way.”

## **APPLICANT'S EVIDENCE**

11) This consists of a witness statement, dated 17 September 2008, by the applicant for registration Mr David George Robson. Mr Robson's evidence falls into two categories. The first category consists of some of the documents he originally submitted with his counterstatement (to which no exhibit numbers have been allocated) and which he refers to as Statement 1, and the second category consists of exhibits DGR1 to DGR4 which are referred to in what he describes as Statement 2. It appears to me that the following documents which appear in the first category mentioned above may be relevant to the issues currently before me. These are as follows:

12) A letter dated 12 July 2007 from Mr Robson to Mr Jonathon Spencer at the Lord Chamberlain's Office in which he says, inter alia:

“Thank you for your letter dated 29 March 2007 regarding the use of the Royal Crown as an integral part of our Federation's Logo for Copyright purposes. A copy of your reply is

enclosed together with the illustrations of alternative Crowns you suggest would be acceptable, since it was not possible to use the Royal Crown.

We have now selected illustration 5 from your suggested list of alternatives for our copyright registration purposes and altered the Federation's logo as above on this letterhead.

We wish to use this "Letterhead logo" for all our Administrative purposes in future. Could you please request the Lord Chamberlain to state whether he has any further objections to our Logo now that the Royal Crown has been removed and advise me accordingly."

13) A letter dated 14 October 2007 from Mr Robson to Mr Kevan Jones MP entitled "The British Armed Forces Federation – Bill 117." I have not summarised the contents of this letter here, given the following comments which appeared in a letter dated 19 November 2007 from Mr Pete Wishart MP to Mr A J Davis of Perth (which was also in connection with the Bill mentioned above), namely:

"I have been in contact with Kevan Jones MP regarding this matter. You will be pleased to hear that this bill has been recently dropped...and it was made clear that this Bill has been dropped for the foreseeable future."

14) A letter dated 16 July 2007 from Jonathon Spencer the Deputy Comptroller at the Lord Chamberlain's Office to Mr Robson. The letter reads as follows:

"Thank you for your letter dated 12 July enclosing a copy of the proposed revised logo to include a crown chosen from the illustrations provided by the Royal Warrant Holders Association.

I can confirm that there would be no objection from here to your using the design of crown as part of the logo for the Combined Armed Forces Federation UK."

15) A letter dated 7 January 2008 from Companies House to Mr Robson in response to a letter from him dated 22 December 2007 (which is not provided) entitled "BAFF (2006) Ltd". In the letter a member of staff at Companies House provides information on the rights which result from the registration of a company or business name.

16) A letter dated 24 October 2007 from The Rt. Hon. Michael Ancram QC, MP to Mr Frank Rixon BEM who is referred to as the "Membership Secretary" at CAFF and in which Mr Ancram says, inter alia:

"..I strongly support the stand taken by David Robson and I am grateful to you for bringing it to my attention."

17) An extract taken from the Queen's Regulations 5<sup>th</sup> edition – 2004 in relation to, inter alia, the rules governing the membership of, and participation, in trade unions and professional associations by service personnel.

18) Of this document Mr Robson says:

“..all Trade Unions and Professional Associations of representation are automatically authorised by the United Kingdom’s Government...The Combined Armed Forces Federation UK is a Professional Association.”

19) Included with his counterstatement (but not in the documents attached to Statement 1), is a document dated 25 June 2005 written by Mr Robson in relation to The Combined Armed Forces Federation UK entitled “Preamble to the Constitution.” I do not propose to summarise this document in full, but note that in the first paragraph it says:

“The Federation exists to provide independent and impartial advice, help and representation on Financial and Legal matters affecting the welfare, efficiency, and morale of past and present Members of the United Kingdom’s Armed Forces, related to conditions of service.”

20) Also included (on the basis indicated in paragraph 19 above), was a letter dated 17 February 2007 from Mr Robson to Mr Young. In this letter Mr Robson says, inter alia:

“I pointed out “The Combined Armed Forces Federation UK” was already in existence as a representative body on financial and legal issues for the Armed Forces, and you were welcome to join, and give us your support.

Notwithstanding you have chosen with your colleagues to go ahead and create an identical organisation, referred to as “The British Armed Forces Federation.” As I also pointed out in May this was bound to create confusion in the minds of existing and past Members of the armed forces. We have already been approached by our Members asking if the title of our Federation has been changed to yours. On our web site you will notice it has been necessary for us to include a clarification for their benefit. We also suggest that you refer to yourselves as “The British Armed Forces Staff Association” instead.”

21) Insofar as the second category of evidence is concerned, Mr Robson provides four exhibits, a number of which are duplicates of documents I have already mentioned above.

22) Exhibit DGR1 consists of a letter dated 29 March 2007 from Jonathon Spencer of the Lord Chamberlain’s Office to Mr Robson. Mr Spencer says, inter alia:

“The Lord Chamberlain has asked me to reply to your letter to him dated 19 March concerning your request to register your logo as a trade mark following advice you have received from the Patent Office.

The Royal Crown is a constituent element of the Royal Arms which, as the personal property of the Sovereign, may not be registered as a trade mark or any part of a trade mark. I am therefore very sorry that we cannot consent for the registration to proceed.

In seeking alternative ideas, I enclose a set of crown designs which are sufficiently different from the design of the royal Crown and which we would therefore have no objection to being registered as a trade mark..."

A copy of the acceptable crown designs mentioned is provided as exhibit DGR 1/2.

23) I note that in his statement Mr Robson says:

"For the avoidance of doubt I am the democratically elected Secretary General of the Combined Armed Forces Federation UK, by members of the Armed Forces on March 17 2004 at the inaugural General Meeting."

24) Mr Robson also comments in the following terms on what, in his view, are the differences between the applicant and the opponents:

"There is an important distinction our federation and the BAFF (2006) Ltd inasmuch that, in line with the Police Federation, on which we are modelled, we are strictly a representative association for the "Other Ranks" of the Armed Forces which BAFF (2006) Ltd is not! Within CAFF UK, although membership is open to "all ranks" of the Armed Forces, Officers of Staff Rank (those at "Brass Hat" level and above) are barred from becoming members of the Executive and/or Management Committees. This protects and maintains the independent and impartial representations of the "Other Ranks" and avoids inevitable conflicts of interest between the two levels of rank."

25) Finally, in response to the comment in paragraph 10 above (sub paragraph 14 of Mr Young's statement) when he says that to the best of his knowledge that the applicant:

"..is not incorporated in any way",

26) I note that Mr Robson says:

"..Also there is no requirement in law for a Professional Association to be incorporated, or any bar in law preventing it seeking the protection of its Trade Mark and Logo..."

27) I also note of course that the application has been filed in the personal name of David George Robson and not in the name of The Combined Armed Forces Federation UK.

#### **OPPONENT'S EVIDENECE IN REPLY**

28) This consists of a further witness statement, dated 18 December 2008, from Mr Young, accompanied by exhibits DY2-1 to DY2-4. Once again, as a good deal of the statement consists of submissions rather than evidence, I shall approach the matter on the basis indicated in paragraph 6 above. Exhibits DY2-1, DY2-2 and DY2-3 consist of a series of letters dated 22 December 2007 and 25 January 2008 from Mr Robson to Mr Young and/or his legal advisers



Russell Jones & Walker. While I do not propose to summarise these letters here in any detail, the following extracts from the letter of 22 December 2007 explain the outcome Mr Robson hoped his letter would achieve:

“You are required by The Combined Armed Forces Federation UK to immediately remove the title, letterhead, logo and trade mark of BAFF (2006) Ltd from the entire public domain including its website and Company House registration.

Any failure to comply with the above requirement and inform those to whom it may concern immediately, will be regarded as a continued act of piracy and an injunction will be applied for to prevent any further breach of copyright...”

29) Exhibit DY2-4 consists of a letter, dated 2 July 2007, from Mr Young to Mr Robson in which Mr Young says:

“I see there is still some misunderstanding about the role of the [BAFF].”

30) The purpose of Mr Young’s letter appears to be to correct any misunderstanding which may have arisen. I note that in the final paragraph of this letter Mr Young says:

“I hope you find this letter helpful. I much appreciated our telephone conversation last year. If there is time to arrange it before your pensions campaign material is distributed, I would be delighted to arrange a meeting at your convenience.”

31) Insofar as the trade mark at issue is concerned, I note that in his statement Mr Young says:

“..I can only repeat....that the letter from the Lord Chamberlain’s Office (while certainly representing the Sovereign’s interest in regard to the use of the crown symbol) cannot represent any form of authorisation on behalf of the United Kingdom Government.”

32) In response to Mr Robson’s reliance on the Queen’s Regulations, Mr Young says:

“Unfortunately the said provision in Queen’s Regulations does not authorise membership of organisations which are formed specifically to represent military personnel in their capacity as members of the armed forces. The provision relates to membership of civilian trade unions and [civilian] professional associations for members of professions and trades which exist outside the armed forces.”

And:

“Queen’s Regulations therefore cannot provide the authorisation relied on by the applicant to justify the impression conveyed by the disputed mark that the applicant was a representative body authorised by one or more elements of the United Kingdom armed forces, and/or was a representative body authorised by the United Kingdom government.”

33) Having referred to the Fourteenth Report of the all party House of Commons Defence Committee's recommendation of 30 July 2008, and the Ministry of Defence's response to those recommendations of 21 October 2008, Mr Young says:

“It will be clear, however, that the UK Government (Ministry of Defence) whilst not prohibiting membership by individual personnel – does not offer any kind of official recognition of any Armed Forces Federation.”

34) That concludes my review of the evidence filed in these proceedings.

## **DECISION**

35) At the hearing the opponent agreed to withdraw the ground of opposition under Section 4(1)(b) of the Trade Marks Act.

36) As a preliminary point Mr Robson queried whether the opposition had been filed within the relevant time limit. He referred me to the Trade Mark Rules, as shown on our website, which state:

### **“3.1.1 Notice of Opposition**

Rule 17 of the Trade Marks Rules 2008

With the introduction of the Trade Marks Rules 2008, taking effect from 1 October 2008, the time frame for filing opposition has changed. Any party or person wishing to oppose an advertised mark has a period of two months from the date of publication within which to indicate their intention to oppose the advertised mark.

Within that two month period the opponent can file either a Form TM7 or a Form TM7A. At the end of the two month period every mark that has had neither a Form TM7 nor a Form TM7A filed against it will proceed to registration.

The Form TM7A is a request for an extension of the period for filing the Form TM7; and upon acceptance of this form the period for filing Form TM7 is then extended to three months from the date of publication of the mark to be opposed, i.e. an additional one month to the original period of two months. Form TM7A shall be filed electronically using the filing system provided on the office web site.”

37) I note that the change to the period of time a party has to file an opposition came about on 1 October 2008. Prior to this an opponent had three months from the date of publication in which to file an opposition. In the instant case the application was published in Journal 6705 on 12 October 2007. The opponent therefore had until 12 January 2008 to file its opposition. The form TM7 from the opponent was received by the Registry on 11 January 2008 via fax. The opposition was therefore filed within the three month time limit which was in force at that time.

39) The opposition is based upon section 3(5) of the Act which in turn refers to section 4 of the Act. These sections read as follows:

“3(5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).

4. - (1) A trade mark which consists of or contains -

(a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them, or it,

(b) a representation of the Royal crown or any of the Royal flags,

(c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof, or

(d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation,

shall not be registered unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.

(2) A trade mark which consists of or contains a representation of-

(a) the national flag of the United Kingdom (commonly known as the Union Jack), or

(b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man,

shall not be registered if it appears to the registrar that the use of the trade mark would be misleading or grossly offensive.

Provision may be made by rules identifying the flags to which paragraph (b) applies.

(3) A trade mark shall not be registered in the cases specified in -

section 57 (national emblems, &c. of Convention countries), or

section 58 (emblems, &c. of certain international organisations).

(4) Provision may be made by rules prohibiting in such cases as may be prescribed the registration of a trade mark which consists of or contains -

(a) arms to which a person is entitled by virtue of a grant of arms by the Crown, or

(b) insignia so nearly resembling such arms as to be likely to be mistaken for them, unless it appears to the registrar that consent has been given by or on behalf of that person.

Where such a mark is registered, nothing in this Act shall be construed as authorising its use in any way contrary to the laws of arms.”

40) Specifically, the opponent is relying upon Sections 4(1)(d) and 4(2)(a).

41) Before turning to the substantive issues in these proceedings, I have found it helpful to place the events surrounding the application for registration into chronological order. In doing so, I have reviewed the trade mark application file which, although not strictly in evidence in these proceedings, contains information which is publicly available. Having done so, it appears to me that the relevant chronology is as follows:

- **13 March 2007** - the Trade Marks Registry’s (TMR) Search and Advisory Service (SAS) issued a report to Mr Robson in respect of a range of trade marks in classes 36 and 45; one of the trade marks was substantially the same as the trade mark shown in paragraph 1 above. However, it appears that the representation of the trade mark presented to the SAS differed and led the examiner to advise that under section 3 of the Act:

“..your mark would not be acceptable for registration under this section because it includes a representation of the Royal Crown which appears to be the property of someone else. It is therefore likely to be objected to under section 3(5) of the Act if you apply to register it.”

The letter explained that to avoid this objection consent should be sought from the Lord Chamberlain’s Office (LCO).

- **19 March 2007** – Mr Robson writes to the LCO (letter not in evidence);
- **29 March 2007** – LCO responds refusing consent but offering alternatives (paragraph 22 above);
- **26 April 2007** – application for registration filed;
- **26 June 2007** – examination report issued raising, inter alia, an objection under section 3(5) of the Act;
- **12 July 2007** – Mr Robson writes to LCO (paragraph 12 above);
- **16 July 2007** – LCO responds to Mr Robson (paragraph 14 above);
- **19 July 2007** – Mr Robson writes to examiner;
- **14 August 2007** – application accepted;

- **12 October 2007** – application published for opposition purposes;
- **11 January 2008** – opposition filed by BAFF (2006) Ltd.

42) In determining these matters I take account of the guidance set out in the Manual of Trade Marks Practice, the relevant sections of which are as follows:

**“FLAGS (UK National Flags)**

Section 4(2) of the Act states:

*"A trade mark which consists of or contains a representation of -*

*(a) the national flag of the United Kingdom (commonly known as the Union Jack), or*

*(b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man, shall not be registered if it appears to the registrar that the use of the trade mark would be misleading or grossly offensive. Provision may be made by rules identifying the flags to which paragraph (b) applies."*

There are no specific provisions in the rules to which the latter paragraph refers. The inclusion of this clause is an enabling provision for future use, if required. Marks incorporating such flags **may** be objected to if the flag element can be regarded as a “representation” of the flag in question.

There are no automatic grounds for refusing marks which contain a UK national flag. Section 4(2) of the 1994 Act states that marks which consist of or contain a representation of the U.K. national flag shall not be registered **if it appears that the use of the mark would be misleading or grossly offensive.**

Marks which consist only of a representation of a UK national flag will attract objection under section 3(1) (b) of the Act, on the grounds that such marks are non distinctive. Furthermore, objections under section 3(3) and 4(2) of the Act may be appropriate if the mark is judged to be misleading or deceptive.

Marks consisting of a UK national flag with other features have to be considered in their totality, and may meet the requirements of section 3(1). Objections under sections 3(3) and 4(2) of the Act may be appropriate if the mark is misleading or grossly offensive.

A mark incorporating a UK national flag could be misleading if it:-

- a) Suggests goods are made in the U.K. when they are not; or
- b) Suggests that the applicants have official endorsement when they do not.

The mark should be considered in relation to the goods applied for. Many people will be influenced to purchase goods or services simply because they appear to be British in origin. Objection under section 3(3)(b) should therefore be taken unless the specification of goods or services is specific on this point. Similarly, unless the goods or services are of such a nature that there is unlikely to be any prospect of official endorsement, e.g. matches, cigarettes, motor cars, an objection under section 4(2) is appropriate.”

Also:

#### **“5 Royal places of residence**

The names and pictorial representations of Royal places of residence are objectionable under section 3(5) if they would be, in the words of section 4(1)(d) of the Act, “likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation”. Such a trade mark may not be registered unless consent is given by or on behalf of Her Majesty or the relevant member of the Royal Family.”

43) There was some discussion as to who the relevant consumer would be with regard to the goods and services that the applicant is seeking to register. The opponent believed that it should be restricted to current and ex-servicemen and women, whilst the applicant clearly thought that members of the general public, in particular potential recruits to the armed forces, should also be taken into account. To my mind, both groups are potential consumers as there is no restriction in the specification. The types of services included in the specification are not purchased without some consideration of who is providing them. Advice on such things as insurance, financial affairs, travel etc are decisions made after some consideration. In this context this issue of whether the average consumer will view the mark in suit as suggesting that the applicant has official endorsement is particularly crucial.

44) For ease of reference I reproduce the mark in suit below:



45) Firstly, I accept that the crown shown in the middle of the Union Jack is not the Royal Crown. This has been confirmed by the Lord Chamberlain, and accepted by the opponent. However, one issue that I have to consider is whether the average consumer would be aware that the device shown was not the Royal crown. When one has the conventional representations of the Royal crown available for a direct comparison then the differences are clear. To illustrate this I provide below the conventional representations of the Royal Crown.



46) When both the mark applied for and the conventional representations are seen in such a large scale it is clear that there are differences. The issue I have to consider is whether the average consumer knows what the Royal crown looks like in sufficient detail to know that the crown shown in the mark in suit is not the Royal crown. This task will be made more difficult when the mark in suit is used in a smaller scale, which is extremely likely. The average member of the general public will, I believe, have an imperfect idea of what the Royal crown looks like from the occasions when it is worn such as the opening of Parliament, which is televised. They may also have seen a representation used on the reverse of some coins, usually in conjunction with other items such as the lion, a thistle etc. However, the image of Her Majesty as used on the obverse of coins, on postage stamps and bank notes show her wearing a totally different crown to the Royal crown. Thus, to my mind, the public would be aware that there are a number of different crowns worn for different occasions by the Queen all of which are “royal” in some manner.

47) When considering the same issue with regard to current and ex members of the armed forces all of the above will apply. They are perhaps more likely to be aware of the form of the Royal crown, if only because they have a version of the crown incorporated into their uniform, often in the form of a metallic badge. They too will be aware that there are a number of crowns worn by Her Majesty.

48) On its own the use of a crown will not be taken as a sign of Royal patronage, partly because the average member of the public will be unsure of precisely what the Royal crown does look like.

49) Both groups of consumers will be aware that companies who work regularly for government departments can be placed on an approved list. This is often used in their marketing as if they are “approved” by the government it lends a cache to their organisation. Both groups of consumers will also be aware that all of the royal family, with the odd exception, hold military rank and that they are incredibly supportive of the armed forces and are patrons of organisations which are

concerned with the welfare of the armed forces and their families, including ex-service personnel.

49) The mark in suit is unusual in that the flag post is to the right of the flag, it is more usual for flags to be shown with the flag post on the left of the flag rather than the right as it is in the instant mark. Here the flag is being viewed as though one were behind it, as one can tell from the position of the red stripe within the white cross. It consists of three elements:

a) The Union Flag: often associated with Royalty and official organs of the State;

b) The words “The Combined Armed Forces Federation UK”: the armed forces are, self evidently an aspect of the State, and one with which the Royal family has a well known association, particularly in relation to troop welfare organisations. .

c) A crown: this has a passing resemblance to the first of the three crowns shown on page 15, which are often used to identify official items and organisations of the State.

50) To my mind the average consumer will react to the combination of the three elements, all of which have State and Royal connotations. It is the combination of the three elements which will lead the average consumer into thinking that the user of the mark has Royal Patronage or mislead them into believing that it is an organ of the State.

51) I reject the opponent’s contention that the use of a crown on other flags such as that of the Queen’s Harbour Master will lead the average consumer into believing that there is a Royal linkage as I very much doubt that, with the rare exception, any of them have ever come across the flag of the Queen’s Harbour Master or that of the Consular Officers ashore.

52) The applicant relies upon the letter from the Lord Chamberlain and also the Queen’s Regulations. Firstly, with regard to the Lord Chamberlain he does not have any expertise in trade mark issues and does not consider the matter against the same criteria that I have to. As to the Queen’s Regulations these give service personnel the right to join a Trade Union or Professional Association. Mr Robson states that “all Trade Unions and Professional Associations of representation are automatically authorised by the United Kingdom’s Government...The Combined Armed Forces Federation UK is a Professional Association.” Whilst the government may recognise such organisations, in that they will deal with them and authorise service personnel who wish to belong to them it does not mean that it endorses such organisations. There is a considerable difference between recognition and authorisation/endorsement.

53) For these reasons it is my view that the mark in suit offends against Sections 4(1)(d) and 4(2)(a) of the Trade Marks Act. The opposition under both these sections therefore succeeds.

## **COSTS**

54) The opponent is entitled to a contribution to its costs. It has represented itself during the course of this action. In *Adrenalin Trade Mark*, BL O/040/02, Simon Thorley Q.C. sitting as the Appointed Person on appeal, observed that:



“6. Under section 68 of the Trade Marks Act 1994, the Registrar is given a wide discretion to award costs. The principles upon which the Registrar will exercise that discretion are set out in a Tribunal Practice Note (TPN 2/2000 – see *Kerly’s Law of Trade Marks* 13<sup>th</sup> edition page 1009). In general the Registrar proceeds by reference to a scale of costs and it is a long established practice that costs in proceedings before the Registrar are not intended to compensate parties for the expense to which they may have been put. Mr. Knight expressed the policy behind the scale of costs in his decision in this case as follows:

‘That scale of costs is meant to be a reasonable scale based upon the policy that no-one should be deterred from seeking to register their intellectual property rights or indeed defend their intellectual property rights so that, for example, if a litigant in person loses an action before the trade mark registry, he or she would know fairly clearly in advance the sum of money they may have to pay to the other side.’

7. Plainly however a pre-requisite of making an award of costs on the scale of costs is that the award should not exceed the costs incurred.

8. It is correct to point out that the Registrar’s practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.

...

10. As indicated above, the Registrar is given a wide discretion as to costs. The practice note is, and is intended to be, merely guidance as to how the Registrar will, in general, exercise that discretion. It does not and cannot impose a fetter upon the overriding discretion.

11. Part 44.3 of the CPR sets out the circumstances which should be taken into account when a court exercises its discretion as to costs and in my judgment exactly the same principles apply to the Registrar.”

55) I also rely upon the comments of Richard Arnold QC, acting as the Appointed Person in *South Beck B/L O/160/08* where he commented:

“34. The Registrar is not bound by the CPR. On the other hand, the Registrar is entitled to, and does, have regard to the CPR in exercising his powers in circumstances where the Trade Marks Act 1994 and Trade Marks Rules 2000 do not make specific provision. Section 68 of the 1994 Act and rule 60 of the 2000 Rules give the registrar discretion to “award to any party such costs as she may consider reasonable”, but do not place any constraints upon the exercise of that discretion. I agree with Mr Thorley that (i) an award of costs should not exceed the costs incurred and (ii) a litigant in person should not be in any more favourable position in proceedings in the Registry than he would be in High Court proceedings under CRP r. 48.6. So far as the first point is concerned, I note that paragraph 8 of TPN 4/2007 now states:

“Depending on the circumstances the Comptroller may also award costs below the minimum indicated by the standard scale. For example, the Comptroller will not normally award costs which appear to him to exceed the reasonable costs incurred by a party.”

35. Turning to the second submission, I agree with counsel for the opponent that the hearing officer appears to have misapplied CPR r. 48.6 and to have awarded the applicant two-thirds of the scale costs he would have awarded a professionally represented litigant without reference to the applicant’s actual loss or any figure calculated in accordance with r. 48.6(4)(b).

36. In my judgment the approach which should be adopted when the Registrar is asked to make an award of costs in favour of a litigant in person is as follows. The hearing officer should direct the litigant in person pursuant to r. 57 of the 2000 Rules to file a brief schedule or statement setting out (i) any disbursements which the litigant claimed he has incurred, (ii) any other financial losses claimed by the litigant and (iii) a statement of the time spent by the litigant in dealing with the proceedings. The hearing officer should then make an assessment of the costs to be awarded applying by analogy the principles applicable under r. 48.6, but with a fairly broad brush. The objective should be to ensure that litigants in person are neither disadvantaged nor overcompensated by comparison with professionally represented litigants.

37. In the present case I directed the applicant to provide such a schedule. The applicant duly filed a schedule claiming in respect of the proceedings at first instance disbursements of £20 together with mileage of 310 miles. No specific mileage rate was claimed so I propose to apply a rate of 25p per mile, giving a figure of £77.50, making total disbursements of £97.50. The applicant also estimated that it had spent a total of 83 hours dealing with the first instance proceedings. While this seems quite a lot by professional standards, it is appropriate to allow a litigant in person more time for a particular task than a professional advisor would be allowed: *Mealing McLeod v Common Professional Examination Board* [2000] 2 Costs L.R. 223. At the rate of £9.25 an hour, 83 hours comes to £767.75. Accordingly, I shall set aside the hearing officer’s costs order and substitute an order that the opponent pay the applicant the sum of £865.25 in respect of the first instance proceedings.

38. So far as the appeal is concerned, the applicant again claimed disbursements of £20 and mileage of 310 miles. It also estimated that it had spent 21 hours dealing with the appeal. Accordingly I shall order the opponent to pay the applicant the sum of £291.75 in respect of the appeal, making a total of £1157.”

56) In accordance with these principles I direct the opponent to provide a brief schedule of costs setting out any disbursements incurred, any other financial losses claimed and a statement of the time spent in dealing with the proceedings. This should be submitted to the Registry, and copied to the applicant, within one month of the date of issue of this decision.

**Dated this 24<sup>th</sup> day of July 2009**

**G W Salthouse  
For the Registrar  
The Comptroller-General**