

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for a declaration of invalidity in respect of the registration of Trade Mark No. 223633 and in the matter of the Registered Proprietor's opposition thereto.

THE FOOTBALL ASSOCIATION OF IRELAND

Applicant

TRADITIONAL CRAFT LIMITED

Registered Proprietor

The registered trade mark

1. Traditional Craft Limited, an Irish company, of 64, Merrion Square South, Dublin 2 is the registered proprietor of the series of trade marks,

BOYS IN GREEN

BOYZ IN GREEN

BOYS 'N GREEN

BOYZ 'N GREEN

BOYS 'N GREEN

BOYZ 'N GREEN

which is registered under No. 223633 in Class 25 in respect of articles of clothing included in that Class. The application for registration of the series of marks was filed on 22 February, 2002 and, by virtue of Section 45(3) of the Act, the marks are registered as of that date, which is deemed to be the date of registration. Publication of the registration of the series of marks appeared in Journal No. 1960 dated 22 January, 2003.

Application for declaration of invalidity

2. On 18 July, 2003, The Football Association of Ireland of 80 Merrion Square South, Dublin 2 applied under Section 52 of the Act for a declaration of invalidity in respect of the registration and included with the application a statement of the grounds on

which it was made. On 27 May, 2004, the Proprietor filed a Notice of Opposition against the application under Rule 41(3) of the Rules. On 8 June, 2004, the Office wrote to the Proprietor requiring the submission of certain evidence in accordance with Rule 41(4) and that evidence was subsequently filed on 26 November, 2004.

3. The matter became the subject of a hearing before me, acting for the Controller on 8 November, 2005. The parties were notified on 29 November, 2005 that I had decided to grant the application and to declare the registration of the mark invalid. I now state the grounds of my decision and the materials used in arriving thereat.

Grounds of the application

4. In its Statement of Grounds in support of the application for a declaration of invalidity, the Applicant makes a number of statements and claims, which I would summarise as follows:

- (i) The term BOYS IN GREEN has been in use, both by the Applicant and generally, to describe the Republic of Ireland soccer team.
- (ii) The trade marks registered under No. 223633 are devoid of distinctive character; they consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose or other characteristics of clothing; they consist exclusively of indications that have become customary in the current language or in the *bona fide* and established practices of the trade.
- (iii) The registration of the marks registered under No. 223633 in the name of the Proprietor could seriously hinder the Applicant's use of the term BOYS IN GREEN in the promotion of the national soccer team and in the sale of merchandise, including t-shirts and other clothing.

5. In support of the assertion at paragraph 4(i), the Applicant enclosed with its Statement of Grounds some "exhibits", which are said to be the results of internet searches for references to the term BOYS IN GREEN.

Notice of opposition and Proprietor's evidence

6. In its notice of opposition against the application for a declaration of invalidity, the Proprietor denies that the Applicant has any genuine or legitimate right to merchandise or sell clothing items under the trade mark BOYS IN GREEN. It asserts that the fact that the term BOYS IN GREEN may be used colloquially to refer to the Irish soccer team or by other sporting organisations that may describe their teams accordingly is of no relevance to the validity of the registration of the trade mark. It says that it has spent over €30,000 advertising and publicising goods under the trade mark since 2001, that it has exported goods bearing the mark to the United Kingdom and that it is the only entity to have used and registered the trade mark in respect of clothing items.

7. The evidence filed by the Proprietor under Rule 41(4), in response to the requirement imposed by the Office to that effect, was in support of these latter statements with regard to its promotion and exclusive use of the trade mark in relation to clothing. It consisted of a Statutory Declaration (and Exhibits PM1-PM6) dated 15 November, 2004 of Paul Martin, a Director of the Proprietor. He says that –
 - the Proprietor has used the trade mark BOYS IN GREEN since 2001 in respect of clothing items, including t-shirts, football shirts, hats, shorts, socks and in respect of other goods, including dolls and flags (sample products exhibited);
 - approximate turnover in goods sold under the trade mark in the period 2001-2003 amounted to €65,000 and advertising expenditure for the same period was approximately €2,000 (copy flyers and other promotional material exhibited);
 - goods bearing the mark are available throughout the State in retail clothing shops, airport shops and giftware and souvenir shops and goods have also been exported to the United Kingdom, Dubai and the United States of America (customer names and sample invoices exhibited); and
 - to the best of his knowledge, no other company has traded under the mark in Ireland in relation to clothing.

The hearing

8. At the hearing, the Applicant was represented by Mr. Cliff Kennedy, Trade Mark Agent of Messrs. MacLachlan & Donaldson, and the Proprietor by Ms. Mary Rose O'Connor, Trade Mark Agent of Messrs. Cruickshank & Co.. Mr. Kennedy argued that grounds for a declaration of invalidity existed because the mark was devoid of any distinctive character and consisted exclusively of a sign designating a characteristic or characteristics of the relevant goods. He asserted that the term BOYS IN GREEN, being the nickname by which the Republic of Ireland national soccer team is commonly known, cannot function as a badge of commercial origin in respect of clothing marketed to supporters of the national team and that it served only to identify the nature of the clothing in question, viz. Republic of Ireland soccer team supporter's clothing. To the extent that BOYS IN GREEN might be regarded as meaning something other than the Republic Of Ireland soccer team, he argued that the phrase consists of terms that designate features of clothing, namely size ("boys") and colour (green") and that it was equally objectionable under Section 8(1)(c) for that reason. In response Ms. O'Connor asserted that BOYS IN GREEN is a distinctive trade mark in relation to items of clothing, that it does not designate any characteristic of such items and that it has been used by the Proprietor as a trade mark for clothing to the extent that the Proprietor enjoys rights at common law under the mark. She objected to attempts by Mr. Kennedy to introduce alleged facts with regard to the Proprietor's use and/or proposed registration of other sports-related names and stated that the present application must be determined on the basis of the acts established by the evidence; in this regard, she denied that the Applicant's allegations as to the non-distinctiveness and descriptiveness of the mark in suit had been proven.

Meaning of "BOYS IN GREEN"

9. The question arose at the hearing as to whether the Applicant's assertion that the phrase BOYS IN GREEN designates the Republic of Ireland soccer team had been substantiated and could be accepted as a matter of fact. In this regard, I observed that the so-called "exhibits" filed with the application for a declaration of invalidity had no evidentiary value as they did not form part of any Statutory Declaration as to

matters of fact that had been filed as evidence¹ in support of the application. I indicated, however, that, subject to any observations that might be made on behalf of the Proprietor, I did not think it necessary for the Applicant to adduce evidence to prove the fact that the term BOYS IN GREEN designates the Republic of Ireland soccer team insofar as this appeared to be a matter of common knowledge and something of which judicial notice could be taken. The Office did not invoke the Controller's power² to require the filing of evidence in support of the Applicant's claim with regard to the meaning of the phrase and nor was the claim denied in the Proprietor's notice of opposition.

10. Ms. O'Connor acknowledged that the Proprietor had not disputed the fact that the phrase BOYS IN GREEN may have been used colloquially to refer to the national soccer team but she denied that the phrase was used exclusively for that purpose. The Applicant's own "exhibits" show that other teams are also known by the term and that there is a racehorse which bears the name, so that the words BOYS IN GREEN cannot be taken, in all instances, to mean the Republic of Ireland soccer team and nothing else.

11. Notwithstanding these submissions on behalf of the Proprietor, I believe that the meaning that would be attributed to the words BOYS IN GREEN by the average person resident in this jurisdiction is the national soccer team, first and foremost. To the best of my knowledge and belief, the phrase was first used to designate the national soccer team some 17 or 18 years ago and it has been continuously used for that purpose since. While it may have also been used to designate other sports clubs, etc. in the meantime, I believe that such use would have stemmed from the primary use of the phrase in relation to the national soccer team. For these reasons, I have decided to accept, without formal proof, the fact that BOYS IN GREEN is a nickname for the national soccer team and, furthermore, that it is as that nickname that the phrase is primarily used.

¹ See Section 92 of the Patents Act, 1992

² under Rule 41(4) of the Rules

The question at issue and the relevant date

12. Of the grounds specified in the Applicant's statement of grounds in support of the application for a declarations of invalidity, Mr. Kennedy canvassed only two at the hearing, namely that the mark is devoid of any distinctive character and that it consists exclusively of an indication of the nature of the relevant goods. Those objections arise under Section 8(1)(b) and Section 8(1)(c) of the Act, respectively, and they can be raised in the context of an application for a declaration of invalidity by virtue of Section 52(1), which reads as follows:

“The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 8 or of any of the provisions referred to in that section; but where a trade mark was registered in breach of subsection (1) (b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

13. The question of whether a mark that is the subject of an application for registration is open to objection under Section 8 is determined by reference to the state of affairs as of the date of filing of the application, which may be referred to as the relevant date. It follows from the language of Section 52 that that date must also be used as the reference point for determining an application for a declaration of invalidity based on Section 8 grounds. In the present case, the relevant date is 22 February, 2002 and the question of the distinctiveness or otherwise of the mark must be judged as of that date. If it is found to have been prohibited from registration by virtue of either of the specified provisions of the Act as of that date, the registration must be declared invalid unless the Proprietor's evidence shows that it has since become distinctive of its goods by virtue of its use as a trade mark. I look at each question in turn below.

Section 8(1)(b) – devoid of any distinctive character

14. Section 8(1)(b) of the Act prohibits the registration of trade marks that are devoid of any distinctive character. In doing so, the Section implements the mandatory provisions of Article 3(1)(b) of Council Directive 89/104/EEC to Approximate the Laws of the Member States relating to Trade Marks, of 21 December, 1988 (the

Directive). The purpose and effect of that prohibition has been expounded upon at length by the European Court of Justice (ECJ) in several cases³ concerning the interpretation of the Directive or laws made thereunder and it is now well established that the prohibition serves to withhold the protection conferred by registration from marks that cannot perform the essential function of a trade mark, namely to identify the goods or services of the undertaking that is its proprietor and to distinguish them from goods or services that have a different commercial origin. The distinctive character required of a mark in order to qualify for registration is that which enables it to perform this essential function.

15. To assess whether a given mark possesses the requisite distinctive character, it is necessary to consider whether the average consumer of the goods or services in question could, by reference to the mark alone and without the possibility of error, identify the goods or services of the mark's proprietor such that he could repeat the positive experience or avoid the negative experience, as the case may be, that he has had of those goods or services on the occasion of a previous purchase. In all cases, that question requires consideration of the goods or services in question, the typical consumers of those goods or services and the circumstances of the trade in them, including the kinds of trade marks normally used in relation to the goods and services and the way in which those marks are used. The determination of whether a given mark displays the distinctive character that would allow it to function as a trade mark calls for a global assessment of these various factors and of the interaction of them in the practical circumstances of ordinary trade.

16. In the present case, the goods for which the Proprietor's mark is registered are articles of clothing included in Class 25. These include everyday clothing items such as jackets, trousers, skirts, etc., but also speciality items such as those traded in by the Proprietor in what I would call the niche market of international soccer supporters' attire. So, for example, t-shirts emblazoned with slogans and images of support for the national soccer team, tricolour hats and scarves, novelty "Republic of Ireland" socks and underwear, etc. all fall within the specification of goods for which the

³ including Case No. C-39/97 Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc., Case No. C-299/99 Koninklijke Philips Electronics NV and Remington Consumer Products Ltd. and Case C104/01 Libertel Groep BV and Benelux-Merkenbureau

Proprietor's mark stands registered. For that reason, I regard it as legitimate, in fact essential, that the question of whether the mark is or is not devoid of any distinctive character should be considered in the context of those specific items of clothing rather than simply in the context of clothing generally. It would be pointless to speculate as to whether BOYS IN GREEN might be apt to function as a trade mark in respect of, say, dress suits or bridal gowns when the real question at issue is whether it can do so in relation to the novelty clothing articles favoured by soccer supporters.

17. The average consumer of clothing is the average person as clothing is, of course, required and used by consumers generally. The consumers of clothing of the kind traded in by the Proprietor, on the other hand, constitute a subset of the general populace, namely, those that support the national soccer team and wish to express that support by wearing articles of clothing in the national colours and bearing slogans of support for the national team. I think it is undeniable that the primary selection criterion considered by such persons in their decisions as to which items to purchase is the extent to which a given article of clothing will function to express their allegiance to the team. Certainly, the normal considerations of style, comfort, durability, etc. take second-place to the overriding concern of expressing allegiance to "the cause"; why else would an otherwise sensible person happily parade through the streets of a foreign city wearing nothing but a tricolour hat with fake green dreadlocks attached, tricolour boxer shorts and a pair of flip-flops?!
18. As to the circumstances of the trade in these items of clothing, it is apparent from the Proprietor's evidence that, in addition to clothing retail outlets, they are also sold through airport and souvenir shops, where I think it would be reasonable to assume that they are marketed alongside other paraphernalia related to Ireland and "Irishness" – flags, shillelaghs, inflatable plastic shamrocks, etc.. Those circumstances of the trade in these goods reinforce the basic difference between them and ordinary articles of clothing and place in clear focus the context in which the items in question are normally purchased by the average consumer, i.e., not the need to provide oneself with clothing, *per se*.
19. In considering whether the present mark is apt to distinguish the Proprietor's goods from those of other undertakings, it is also essential to look at the manner in which

trade marks are normally used in relation to articles of clothing and to ask whether, if used in that manner, this mark might be expected to fulfil the essential function of a trade mark. In this regard, Ms. O'Connor pointed out that, the words BOYS IN GREEN do not only appear in prominent positions on the Proprietor's goods such that they are visible when the articles of clothing in question are worn, but that the words are also used on swing tickets and sewn-in labels attached to the goods, i.e., in the way in which trade marks are normally applied to items of clothing. I understood her to argue that, when used in that way, the words BOYS IN GREEN could not but be perceived as a trade mark indicating commercial origin in the relevant goods rather than simply as a slogan of support for the national team. I agree that swing tickets and sewn-in labels are the traditional ways in which trade marks are applied to items of clothing but I am also aware, from my own experience, that, in relation to the type of leisure or sports-related clothing with which the Proprietor's goods would be most closely associated, goods sold under a number of the well-known brands, including NIKE, ADDIDAS and DIADORA, include articles of clothing on which the respective trade marks appear prominently and are visible in use as well as being applied to the articles in the traditional manner. I would not agree, therefore, that the use of a trade mark in respect of clothing items by its application to, say, the front of a t-shirt in an obvious and prominent manner could be regarded as an abnormal or untypical form of use.

20. In light of these various considerations, I turn to the fundamental question of whether the words BOYS IN GREEN would be likely to be used by the average consumer of Irish soccer supporters' attire to identify the goods of the Proprietor alone and to distinguish those goods from the goods of other undertakings operating within that market. In my opinion, they would not. The meaning of those words and their significance in the context of the relevant goods is so obvious as to make them unsuited to the job of identifying the goods of one trader only. I believe that consumers of the relevant goods would perceive the words as indicating the purpose of the goods, viz. to show support for the Irish team, rather than as designating their commercial origin. In practical terms, I think it would be bizarre to suggest that a person who had once purchased an item of clothing bearing the words BOYS IN GREEN would, on the occasion of a subsequent purchase, rely on those words alone to identify a garment emanating from the same maker and assume that the words in

question served to guarantee him a similar quality of manufacture as he had experienced from the garment he bought previously. Even if used in the traditional manner on swing tickets and sewn-in labels, I think that the primary meaning of the words BOYS IN GREEN would not be displaced to the extent that the average consumer would perceive them as having trade mark significance, i.e., as serving to indicate the goods of one trader only. It is much more likely that such use, if it were noticed at all, would be understood as simply reinforcing the message that the goods in question are aimed at and intended for supporters of the national team.

21. For the reasons just outlined, I believe that the words BOYS IN GREEN are devoid of any distinctive character, within the meaning of the Act, in relation to articles of clothing in Class 25, specifically those articles in which the Proprietor trades. I do not believe that the situation would have been any different at the relevant date as the meaning of the words and their relevance to clothing of this nature was well established at that time. It follows that I find that the mark was registered in breach of Section 8(1)(b) of the Act and that the registration must be declared invalid under Section 52.

Section 8(1)(c) – sign designating essential characteristic of goods

22. Section 8(1)(c) of the Act prohibits the registration of trade marks that consist exclusively of signs or indications that may serve, in trade, to designate the goods or services in respect of which registration is sought or essential characteristics of those goods or services. In this area also, the ECJ has given considerable guidance as to the scope of, and policy underpinning, that prohibition. In Case No. C-191/01, *Office for Harmonisation in the Internal Market (Trade Marks and Designs) –v- Wm. Wrigley Jr. Company [DOUBLEMINT]*, the ECJ reiterated its earlier finding that the prohibition against registration contained in Section 8(1)(c) “*pursues an aim which is in the public interest, namely that descriptive signs or indication relating to the characteristics of goods or services in respect of which registration is sought **may be freely used by all***” (my emphasis). In light of that, the ECJ found that a sign must be refused registration if at least one of its possible meanings designates a characteristic of the goods or services concerned.

23. I have already set out in detail my opinion as to the meaning of the term BOYS IN GREEN and its significance in designating an essential characteristic of clothing that is marketed towards Irish soccer supporters and I do not need to go over that ground. It is sufficient for me to say that, in view of the relevance of the words BOYS IN GREEN, whether alone or in combination with other words, to the expression of support for the national team, I cannot see how those words could be legitimately reserved for use by one undertaking only (the Proprietor) to the detriment of all other undertakings operating within that market. The words BOYS IN GREEN constitute the manner in which the team itself is colloquially designated in common parlance and they are required for use by all undertakings who produce speciality clothing for use by supporters of the team. Without labouring the point, therefore, I find that the Proprietor's mark consists exclusively of a sign designating an essential characteristic of the relevant goods and that its registration was also in breach of Section 8(1)(c) of the Act.

Has the mark become distinctive through use?

24. As I indicated above, Section 52 provides for the invalidation of a registration in circumstances such as those that apply unless the mark has become distinctive of the Proprietor's goods by virtue of the use that has been made of it. In Joined Cases Nos. C-108 and 109/97, *Windsurfing Chiemsee Produktions- und Vertriebs G.m.b.H. –v- Boots- Und Segelzubehör Walter Huber and Another*, the ECJ set out the criteria to be taken into account in deciding whether an existing word that had, through use as a trade mark, acquired a secondary meaning as indicating the goods of the trade mark proprietor such that it could be said to have acquired the requisite distinctive character. Those factors include the market share held by the mark; how intensive, geographically widespread and long-standing the use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as emanating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations.

25. In the present case, the Proprietor has adduced evidence of use and promotion of the mark on a fairly modest scale for the period 2001-2003. The mark has been used in relation to items other than those in respect of which it is registered and the Proprietor

has not specified the proportion of turnover and advertising that relates to goods for which the mark is registered and those for which it is not. It is clear from several of the exhibits filed that the mark has been used in a manner that cannot be assumed to have been perceived as use of a trade mark by the relevant consumers but might, more likely, have been perceived simply as an integral part of the relevant goods. No independent evidence from third parties as to the perception of the mark in the trade or among the relevant public has been provided.

26. In these circumstances, I do not have a basis on which to find, as a matter of probability, that the words BOYS IN GREEN have acquired a secondary meaning in relation to articles of soccer supporters' attire such that their primary meaning in that context has been displaced and that they now serve to designate the goods of the Proprietor alone. That being the case, the proviso to Section 52 of the Act does not apply and the registration of the mark must be declared invalid in accordance with the findings I have made in paragraphs 21 and 23 above.

Tim Cleary
Acting for the Controller

23 December, 2005