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Surprise defeat for the Tartan Army in Scotland

Julius Stobbs (Stobbs IP) · Monday, March 27th, 2017

It is one of the quirks of the EUTM system that while rights can be granted and challenged centrally at the EUIPO, they can only be enforced through the national courts of EU member states. And whilst Scotland is not (yet) an independent nation, or a member state of the EU, it possesses its own separate court system which can be used to enforce UK and EU rights, a fact often overlooked south of the border.

That opportunity to enforce their rights on home soil was not missed by Tartan Army Limited, who brought proceedings for passing off and infringement of their UK and EU rights in a suite of TARTAN ARMY trade marks. Naturally, the defenders (to use the Scottish term) brought a counterclaim for invalidity and revocation of the pursuer's (technical term) trade marks, and the Court of Session gave its decision in the matter on 10 February 2017.

The facts of the case are not particularly remarkable. The pursuer obtained three UK registrations during the period 1996-98, and one EU registration in 2006, all protecting the mark THE TARTAN ARMY or TARTAN ARMY in relation to, inter alia, classes 16, 25, 39 and 41. The defenders and their predecessors in title produced a magazine called THE FAMOUS TARTAN ARMY MAGAZINE and offered travel services, organising travel for Scottish football supporters to their national team's away games. Whilst the pursuer originally indicated that they had no objection to the use of the mark on the magazine, they later withdrew that consent, and no consent was ever given to use the mark in relation to travel services.

The decision on revocation was fairly straightforward: the marks had only been used on some of the goods and services for which they were registered during the relevant five-year period, and they were revoked accordingly. After some classes were not renewed at expiry, the pursuer was left with coverage in classes 24, 25, 27, 32, 35 and 41. So far, so good. But on the other parts of the decision, the court went surprisingly off-piste.

Significant amounts of evidence were submitted to the effect that the phrase 'Tartan Army' had been used to refer to Scottish football supporters since at least the 1970s. Witness after witness stated that they understood the phrase 'Tartan Army' to refer to the 'disorganisation' of Scottish football supporters, and did not see it as an indication of origin. The judge found that the term 'is and has for a long time been used as a collective noun for the "disorganisation" of Scottish football fans […] certainly that is how it was understood when the applications for UK and EU Trade Marks were submitted.' On that basis, it might be expected that the marks would be declared invalid, and that the passing off claim similarly would fail.

Not so. Having made this statement, the judge immediately went on to state that this 'does not preclude [the mark] being distinctive in the sense used in ground (b) [Section 3(1)(b) UK Trade Marks Act/Article 7(1)(b) EUTMR]'. The reasoning, insofar as it is discussed, seems to be that because the term had not been used as a brand by any third party prior to the date of application, it could serve as a valid trade mark as soon as any party chose to file an application for it.

Having decided that the registrations were inherently distinctive, the court then turned to the question of infringement. One might think that the use of the mark FAMOUS TARTAN ARMY MAGAZINE in relation to a magazine would infringe a registration for THE TARTAN ARMY covering 'on-line publishing', if that registration were valid. Or at least, that any finding that it did not infringe would in turn rely on a finding of dissimilarity between printed magazines and online publishing or on an acknowledgement of the limited distinctive character of TARTAN ARMY when used in the context of support for the Scottish national football team. Not here. The court decided that there was no likelihood of confusion because 'the wording of the magazine title is such as to direct attention to the famous tartan army, the "disorganisation" of Scotland football fans, and to hold the Magazine out as a magazine belonging to the fans. It does not point naturally to an association with the pursuer.' (This was not sufficient, however, to shake the court's faith that the mark TARTAN ARMY was inherently distinctive of the pursuer.)

As this was a first instance decision, it is open to the parties to appeal to a higher court. The decision seems to leave many avenues open to challenge on appeal, should the parties so desire.

Brand owners should be aware that the Scottish courts are available as an alternative avenue to the courts of England and Wales to enforce UK and EU trade mark rights. However, the quality of this decision and its surprising outcome may give reason for pause.

Whilst a devolved Scotland with its own law-making powers and its own courts clearly has the capacity to function independently of London, this decision suggests that presently there may be a less nuanced understanding of the details of trade mark law north of the border compared with the London courts, and particularly the specialist Intellectual Property Enterprise Court. Of course, that would be highly likely to change in an independent Scotland if more trade mark infringement cases were brought in its courts, but it seems possible that there would be an intervening period of uncertainty for brand owners.

This entry was posted on Monday, March 27th, 2017 at 10:44 am and is filed under Lack of distinctiveness, United Kingdom
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