

## Liverpool FC score an own goal

European football champions Liverpool FC came a cropper in a recent trade marks case – in quite an instructive way.

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I head up Bates Wells' in-house team of specialist trade mark lawyers.

At Bates Wells, we have a wealth of experience in trademarking the untrademarkable, for businesses and charities alike. A lot of my work focusses on advising clients how they can best protect descriptive names and commonplace phrases.



Names of football clubs, like so many things we cherish – bands, authors, movie franchises – are also, unquestionably, trade marks. This is because, on a very basic level, they allow people to tell one club (artist, writer, film) from another – they function as ‘badges of origin’. Most things in this category are naturally and inherently ‘distinctive’ (to use the trade marks language): names like Apple, Oxfam and Arsenal are all arbitrary as far as their owners’ activities are concerned and are immediately recognised as brands.

There’s a second way in which a word or expression can become a ‘brand’, even if it does not have this innate character. This is by building up appropriate recognition through use – lawyers call this state of affairs ‘acquired distinctiveness’. Examples include names like Shredded Wheat and Save the Children. The net effect is that these apparently-ordinary words are, via trade mark registration, capable of being monopolised by their owners – at least as the names of products – even though

they form part of the everyday English lexicon. These are significant powers and the courts and tribunals are careful around granting them unduly.

It was against this background that ‘Liverpool Football Club and Athletic Grounds Ltd’ (as superb a registered company name as you’ll encounter, and a constant since 1892) applied to trade mark the word LIVERPOOL for various goods and services including entertainment, clothing, retail, sports equipment and broadcasting. It already had registered marks for LIVERPOOL FOOTBALL CLUB and LIVERPOOL FC but was seeking a right, in the last analysis, to stop others using the name of the city per se, without the club’s permission.

On the face of it, that would seem an extreme state of affairs, and it was not a popular one: Supporters union Spirit of Shankly encapsulated the feelings of many Liverpoolians when it went on record as saying: ‘the word ‘Liverpool’ is not for FSG

[Fenway Sports Group, Liverpool's ultimate owners] or anybody else to own – it belongs to the city of Liverpool and its people. We should all be allowed to use it freely, however we see fit, without fear of legal letters dropping through our doors.'

However this is possibly to misunderstand the right that trade mark registration would provide. It would, in the last analysis, principally stop others using the name LIVERPOOL in a brand name sense, in respect of competing goods and services in the area of the trade mark. It would not, and never would, stop Everton or Tranmere Rovers (Merseyside's third club) describing themselves as being based in Liverpool. It would not stop a clothing manufacturer advertising its goods as being made or designed in Liverpool. It would of course, stop others selling Liverpool-branded t-shirts and footballs: but we tend to think this would be a fair outcome as, owing to the club's reputation, people would almost inevitably associate the brand with the football club.

As it goes, 'Spirit of Shankly' and others need not have been concerned: the trade mark application was refused by the IPO. Although the football club was able to show very significant recognition and reputation in its name, this was outweighed, in the IPO's view, by the sheer weight of recognition of 'Liverpool' as a place name. The dynamics at play are complex but, in brief, there is a balancing act to be done between the strength of the name's association with the trade mark owner, and the recognition of the place in question more generally. The IPO's decision said that the primary reason for rejecting the application relates to the 'geographical significance' of Liverpool as a city. We note that Crystal Palace FC's EU Trade Mark for simply CRYSTAL PALACE (a lovely but not necessarily

famous area of South London) fared rather better\*, and with good reason: one of the primary links in consumers' minds formed by the name is with the football club, and this will obviously be especially so where sports-related activities are concerned.

The overarching point is a good one for charities, however, whose names often tend towards the 'ordinary English' end of the spectrum (think ActionAid, British Council, and many others). They should, under this rule, be able to fully protect their names – provided they can show the requisite goodwill and recognition in them. Also, in cases like these, where there are not whole cities (or other defined groups of people) liable to feel disenfranchised, a PR-related storm seems unlikely. That said, whenever a client of ours angles to trade mark a name, word or slogan which could be seen as 'contentious', we do tend to warn them of how it could be perceived in the outside world.

\* We also noticed this registration, owned by a BVI company, dating to the 1890s and covering 'fireworks': <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00000155036>.

*This seems remarkably portentous given the fate of the actual Crystal Palace 40 years later.*

