

O-035-05

IN THE MATTER OF APPLICATION NO. 2313504 IN THE NAME OF LINKIN
PARK LLC

DECISION

Introduction

1. On 18 October 2002 Linkin Park LLC applied to register the trade mark LINKIN PARK (“the Mark”) in respect of a wide range of goods and services in Classes 9, 14, 16, 18, 21, 25, 26 and 41. The only part of the application that remains contentious is that which seeks registration in respect of “printed matter, posters and poster books” in Class 16 (“the Goods”).
2. Objection was taken by the examiner that registration of the Mark in respect of certain goods covered by the application would be contrary to section 3(1)(b) and (c) of the Trade Marks Act 1994, which provide:
 - 3.(1) The following shall not registered -
...
 - (b) trade marks which are devoid of any distinctive character,
 - (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.
3. The applicant did not file any evidence in support of the application, but argued for registration upon the basis of the inherent qualities of the Mark.

4. Following a hearing, the objection was maintained in respect of the Goods for reasons set out in a written decision of Mr A.J. Pike acting for the Registrar dated 3 August 2004 (BL O/255/04) [2005] ETMR 17. The applicant now appeals against that decision.

The background facts

5. There is no dispute as to the facts which form the background to this application. The applicant is the corporate vehicle of an American rock group called LINKIN PARK (“the Group”). The Group was formed in 1996. The word LINKIN which forms part of the Group’s name was coined by the Group. The Group released its first album *Hybrid Theory* in 2000. This was very successful. By October 2002 the Group was well known in the United Kingdom, particularly amongst those interested in rock music. The present application was filed to support and protect the Group’s merchandising activities.

The Registrar’s practice

6. Since this appeal questions the correctness of the Registrar’s current practice when it comes to the registration of the names of celebrities for goods such as posters, it is appropriate to set out that practice and to explain its basis in case law.

Basis of the practice

7. The Registrar’s representative acknowledged that the current practice can be traced back to the law under the Trade Marks Act 1938, and in particular the decisions of the Court of Appeal in *TARZAN Trade Mark* [1970] RPC 450 and *ELVIS PRESLEY Trade Marks* [1999] RPC 567. As has often been observed, the 1994 Act constitutes a new law of trade marks which implements Council Directive No 89/104/EEC to approximate the law of the Member States relating to trade marks (“the Directive”). Accordingly, cases decided under the 1938 Act are no longer authoritative and may be positively misleading. On

other hand, sometimes the reasoning in such cases can illuminate similar problems arising under the new legislation. The Registrar contends that this is such a situation.

8. In *TARZAN Trade Mark* the applicant filed two applications to register the word TARZAN as a trade mark in respect of (i) films prepared for exhibition and magnetic tape recordings and (ii) games, toys, playthings, gymnastic and sporting articles. The applicant had been exclusively licensed by the owner of the copyrights in the works of Edgar Rice Burroughs to produce films, records and merchandise centered on the fictional character Tarzan created by Burroughs. The applications were refused on the grounds that the marks did not comply with the provisions of section 9 and 10 of the 1938 Act, and successive appeals to Graham J and the Court of Appeal were dismissed. For present purposes, the principal points of interest are the Court of Appeal's rejections of the appellant's arguments that (1) TARZAN was an "invented word" within the meaning of section 9(1)(c) of the 1938 Act and (2) TARZAN was a word "having no direct reference to the character or quality of the goods" within section 9(1)(d) of the 1938 Act.
9. So far as the first of these arguments is concerned, the Court of Appeal accepted that Burroughs had invented the word TARZAN at the time when he wrote the first of his works featuring that character. The Court held, however, that the issue under section 9(1)(c) was whether TARZAN was an invented word at the date the applications were filed. On that issue, the Court upheld Graham J's conclusion that the word TARZAN was very well known by that date and therefore had ceased to be an invented word.
10. As to the second argument, the Court dismissed it for reasons which Salmon LJ expressed at page 454 lines 34-42 as follows:

The next point is whether the word had a direct reference to the character or quality of the goods in respect of which it was sought to register it. I asked Mr Burrell [counsel for the applicant] during the course of his argument if he could think of a more direct reference to the character of a film dealing with some exploits of Tarzan than the

description that it was a ‘Tarzan’ film. This was a question which Mr Burrell, despite his wide experience and ingenuity, was quite unable to answer. Indeed, it seems plain that such a film could not be better described or referred to than as a ‘Tarzan’ film. The learned judge so found. I agree with him, and Mr Burrell’s second point accordingly fails also.

Edmund Davies and Cross LJ expressed themselves in similar terms.

11. In *ELVIS PRESLEY Trade Marks* the applicant was the successor in title to Elvis Presley’s merchandising business. It filed three applications to register the marks ELVIS PRESLEY, ELVIS and a signature reading “Elvis A. Presley” in respect of toiletries in Class 3. The applications were opposed by the opponent, who traded under the name ELVISLY YOURS, which was registered for a variety of goods in Class 3. The opponent had sold toiletries bearing the name ELVIS and the image of Elvis Presley on a substantial scale for a number of years, but there was no evidence that anyone had ever associated such goods with the applicant. The opponent contended *inter alia* that none of the three marks was registrable under sections 9 and 10 of the 1938 Act. This contention was upheld by Laddie J. The Court of Appeal dismissed an appeal, although a majority of the Court of Appeal held that the signature mark was registrable under section 9(1)(b).
12. With regard to the mark ELVIS, the applicant contended that this was registrable under section 9(1)(d). Morrill LJ (with whom Simon Brown LJ agreed) rejected this contention for reasons which he expressed at page 593 lines 10-18 as follows:

I agree with counsel for Mr Shaw [the opponent] that that case [sc. *TARZAN*] is indistinguishable from this. It is true that the goods in respect of which registration is sought, for instance soap, are consumer items. To market those goods under the mark ELVIS would obviously seek to turn to account the name and memory of Elvis Presley; but it would seek to do so as descriptive of a popular hero not as distinctive of the connection between EPEI [the applicant] as the proprietor of the mark. The soap would be sold as Elvis soap. The character of the soap would be Elvis soap. To my mind it is clear that the mark could not come within section 9(1)(d) for it would be a direct reference to the character of the soap.

The reasoning of Robert Walker LJ (with whom Simon Brown LJ also agreed) at page 585 lines 17-32, although not couched in terms of the statutory language, was to similar effect.

13. As to ELVIS PRESLEY, the applicant did not contend that this mark was registrable under section 9, but only under section 10 of the 1938 Act. Morritt LJ rejected this contention for reasons which he expressed at page 593 line 45 to page 594 line 32 as follows:

In a sustained criticism of the judge's conclusion counsel for EPEI submitted that the fame of Elvis Presley in fact confirmed the conclusion [that the mark was capable of distinguishing its goods] because of the effect of what has now come to be known as 'character merchandising'. That activity is one in which a notable public figure lends his name to a particular product or range of products so as, apparently, to endorse that product. The consequence relied on is that the consumer comes to regard goods bearing that name as having the approbation of or licence from his or her 'idol'. EPEI relied on a number of reported cases so as to suggest that over the last 20 years the court has come to conclude, without the need for affirmative evidence on the point, that such endorsement does distinguish the goods he or she endorses from those he or she does not. Robert Walker LJ has considered those cases in detail and it is unnecessary for me to repeat the exercise.

I do not accept that submission. First, the judge concluded that there was no evidence of use by EPEI of ELVIS PRESLEY in the United Kingdom. There is no appeal from that conclusion. Second, Mr Shaw has sold in the United Kingdom quantities of his products by reference to Elvis, which, the public would generally appreciate, was a reference to Elvis Presley. For example his band of soap was called Elvis Soap because it was impregnated with an 'image [of Elvis which] remains right to the end'. It is not suggested that Mr Shaw has ever claimed any connection with EPEI. Third, the fame of Elvis Presley was as a singer. He was not a producer of soap. There is no reason why he or any organisation of his should be concerned with toiletries so as to give rise to some perceived connection between his name and the product. In these circumstances I do not accept without evidence to that effect that the mark ELVIS PRESLEY would connote to anyone a connection between EPEI and Elvis soap so as to distinguish their soap from that of Mr Shaw's soap.

Counsel for EPEI forcefully contended that such a conclusion would leave the door wide open to unscrupulous traders seeking to cash in on the reputations of others. This is true if, but only if the mark has become so much a part of the language as to be descriptive of the

goods rather than distinctive of their source. But in that event I can see no objection to any trader being entitled to use the description. In the field of memorabilia, which I consider includes consumer items bearing the name or likeness of a famous figure, it must be for that person to ensure by whatever means may be open to him or her that the public associate his or her name with the source of the goods. In the absence of evidence of such association in my view the court should be very slow to infer it.

14. Simon Brown LJ added at page 597 line 41 to page 598 line 4:

On analysis, as it seems to me, all the English cases upon which Enterprises seeks to rely (*Mirage Studios* not least) can be seen to have turned essentially upon the need to protect copyright or to prevent passing off (or libel). None creates the broad right for which in effect Mr Prescott [counsel for the applicant] contends here, a free standing general broad right to character exploitation enjoyable exclusively by the celebrity. As Robert Walker LJ has explained, just such a right, a new 'character right' to fill a perceived gap between the law of copyright (there being no copyright in a name) and the law of passing off was considered and rejected by the Whitford Committee in 1977. Thirty years earlier, indeed, when it was contended for as a corollary of passing off law, it had been rejected in *McCulloch v Lewis A. May* [1947] 2 All ER 845. I would assume to reject it. In addressing the critical distinctiveness there should be no a prior assumption that only a celebrity or his successors may ever market (or licence the marketing) of his own character. Monopolies should not be so readily created.

15. If the approach taken in these two cases were to be applied to applications under the 1994 Act, the result would be that many applications for registration of trade marks consisting of the names of famous people and fictional characters would be refused. The Registrar's practice has, however, influenced in favour of a more lenient approach to registrability by a subsequent decision under the 1994 Act, namely the judgment of Laddie J in *Arsenal Football Club plc v Reed* [2001] RPC 46. In that case the claimant was the proprietor of two word marks, ARSENAL and ARSENAL GUNNERS, and two device marks, the Arsenal crest and the Arsenal cannon, registered in respect of articles of outer clothing, articles of sports clothing and footwear in Class 25. The claimant sued the defendant, a trader in football merchandise, for infringement of these marks and passing off. The claim for infringement ultimately succeeded in the Court of Appeal after a reference to the European

Court of Justice. For present purposes, however, what is most important is Laddie J's conclusion as to validity, which was not the subject of any appeal.

16. The defendant attacked the registrations on two grounds. The first was that the registrations should be revoked for non-use. The second was that the marks were incapable of distinguishing Arsenal's goods in a trade mark sense and offended against section 3(1)(a) (see paragraph [53]). I think it is worth quoting Laddie J's reasoning with regard to both grounds in full:

66. This only leaves the issues of validity. In my view they can be disposed of quite briefly. Mr Roughton [counsel for the defendant] argues first that AFC have not used their registered marks as trade marks in the relevant period of five years. They have used the signs which are the subject of registration only in a non-trade mark way, Once again both Mr Roughton and Mr Thorley accept that the determination of whether there had been use as a trade mark is a matter of perception, the court looking through the eyes of the average normally observant customer.

67. If AFC had only used the signs in the way that they have been used on Mr Reed's products, I would have held that there has been no relevant trade mark use. On this, it is not necessary to repeat what I have said above. However AFC's use of the signs is not so limited. As exemplified in Annexes I to III, it has used the signs on swing tickets, packaging and neck labels in just the way that one would expect a trade mark to be used. I have little doubt that they have been used in this way because AFC wants to ensure that they are used in a standard, readily-identifiable trade mark manner. The relevant customer would perceive that to be trade mark use. The argument of non-use fails.

68. I have come to the conclusion that Mr Roughton's alternative argument also fails. He says that any trade mark use of the Arsenal Signs is swamped by their overwhelming acquired meaning as signs of allegiance to the football team. Therefore they are not and have never been distinctive. He says that this argument applies with particular force to the word 'ARSENAL'. I think this fails on the facts. I do not see any reason why the use of these signs in a trade mark sense should not be capable of being distinctive. When used, for example, on swing tickets and neck labels they do what trade marks are supposed to do, namely act as an indication of trade origin and would be recognised as such. There is no evidence before me which demonstrates that when so used they are not distinctive of goods made for or under the licence of AFC. The fact that the signs can be used in other, non-trade mark, ways does not automatically render them non-distinctive.

17. The reasoning in paragraph [68] is somewhat compressed. In my view it is important to appreciate that the argument Laddie J was dealing with was that the marks were unregistrable by virtue of section 3(1)(a). He was not dealing with an argument that the marks were unregistrable by virtue of section 3(1)(c) or even 3(1)(b). It is also important to appreciate that, earlier in the judgment, Laddie J had found that Arsenal had built up a substantial merchandising business in the decade or so prior to the trial. Such merchandise included clothing to which neck labels, swing tickets and pack labels of the kind illustrated in Annexes I to III of the judgment were applied (see paragraphs [7] and [13]). It may be for this reason that the defendant did not rely upon section 3(1)(b) or (c), since an attack under those paragraphs can be overcome by proof of acquired distinctiveness (proviso to section 3(1) and proviso to section 47(1)).

The practice

18. The Registrar's practice is set out in section 21 of Chapter 6 of the Work Manual. This states in relevant part:

21 FAMOUS NAMES

Where a famous name is concerned (and where the reputation does not stem from a trade in the goods/services applied for) it is possible that, when used in relation to certain goods/services, the name may appear to the average consumer as an indication that the goods/services are *about* the person whose name it is rather than as an indication that the goods/services are supplied by, or under the control of one undertaking.

[After references to *ELVIS PRESLEY* and *Arsenal v Reed*:]

Accordingly, the correct approach appears to be to consider whether the famous name put forward for registration is so descriptive in relation to the goods/services for which registration is sought that it could not be perceived by consumers as anything more than a description of the subject matter of the goods/services. The following paragraphs are directed at the main areas of uncertainty.

21.1 Media

The names of famous persons or groups may serve as trade marks for printed publications, recorded sounds, films, videos, TV programs, musical or live performances etc as use of the mark on such goods or services would be likely to imply some form of control of, or guarantee from, the holder. Consequently, there will not usually be a objection to the registration of a famous name for these goods.

21.2 Mere Image Carriers

The name of a famous person or group is likely to be perceived as merely descriptive of the subject matter of posters, photographs, transfers and figurines. Names of famous persons or groups are therefore unlikely to be accepted by consumers as trade marks for these goods because they will usually be seen as mere descriptions of the subject matter of the product. Objections will arise under Section 3(1)(b) & (c) of the Act.

21.3 Badges of Allegiance

The name of a famous person or group may serve to identify the trade source of badges of allegiance (including T-shirts, mugs, scarves etc) even if the possibility of other traders producing unofficial merchandise cannot be ruled out. Consequently, such marks will normally be accepted for such goods unless there is a particular reason to believe that the mark in question cannot fulfil the function of a trade mark, for example, the names of some members of the Royal Family may be incapable of performing a trade mark function for such goods because of the widespread historical trade in Royal souvenirs.

21.4 Names of Deceased Famous Individuals or Defunct Groups

In these circumstances the name is more likely to be seen by consumers as merely an historical reference to the subject matter of the goods or services, rather than to the trade source of the goods. However, each such case must be judged on its own facts taking account of the length of time that has passed since the person concerned died, or the group became defunct, and the relationship (if any) between the goods/services in the application and those associated with the dead person or defunct group. A Team Leader will be involved in each case.

The hearing officer's decision

19. The hearing officer upheld the objection under section 3(1)(c) for reasons which he expressed as follows:

13. Section 3(1)(c) of the Act excludes signs which may serve, in trade, to designate the kind of goods or other characteristics of goods. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods in question. The mark is the name of a music band, and when used as the subject matter of posters etc., it will do no more than represent a characteristic of these goods.
14. In an Opinion issued by Advocate General Jacobs in *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Zapf Creation AG (NEW BORN BABY)* guidance was provided on this point at paragraph 28:
- ‘28. It is an essential characteristic of many toys, and of all those classed as dolls, that they represent something. The characteristics of a toy motorcycle differ from those of a toy giraffe, and are certain to be perceived immediately by potential purchasers as defining the nature of the toy (and as relevant to their purchasing choice). In trade, the terms ‘motorcycle’ and ‘giraffe’ (or ‘racing motorcycle’, ‘baby giraffe’ etc) are important to both buyer and seller in identifying the class or subclass of toy in question. It would surely not be compatible with Article 7(1)(c) to register ‘Giraffe’ or ‘Motorcycle’ for the relevant class of toy. The situation is the same for a child’s doll representing a new-born baby, a princess, a soldier or any other kind of person.’
15. Although that application was concerned with goods in Class 28 I believe that the same principle holds for this application. The purchasers, and potential purchasers, of posters etc purchase particular posters because they represent something to them. In this case the name LINKIN PARK represents the band who produces music to which the purchaser enjoys listening. The name LINKIN PARK appearing on posters etc. is the subject matter of the goods which itself is an essential characteristic of such goods. By contrast, whereas the name LINKIN PARK would be perceived as subject matter when used on or in relation to posters etc the same cannot necessarily be said about the use of the name ARSENAL when used in relation to articles of clothing.
- ...
18. I must consider if there is, or is liable to be, a wide demand for posters etc. bearing the name LINKIN PARK. I have already concluded that LINKIN PARK is the name of a well known music band with an established following in the United Kingdom. In the circumstances there is likely to be a wide demand for such goods. The next question to be considered is, given that there is likely to be a wide demand for posters etc. bearing the name LINKIN PARK then are there reasons for assuming that third parties will be able to legitimately enter such

trade. Third parties are, of course, entitled to take and exploit pictures of celebrities – the copyright in a picture of LINKIN PARK belongs to the creator of it and not necessarily to the group itself. A party wishing to trade in a product which is essentially the embodiment of a work in which it owns the copyright – e.g. a poster – positively needs to use the name of the subject matter in order to conduct such a trade. The name is not therefore merely ‘capable’ of designating a characteristic of the product – it is essential.

20. The hearing officer upheld the objection under section 3(1)(b) for reasons which he expressed as follows:

22. In my view the consumer, bearing in mind that it is likely to be common practice for third parties to market and trade in posters and poster books which carry the name of a music band, would not consider this mark to denote trade origin. I am not persuaded that the combination of the words LINKIN PARK is sufficient, in terms of bestowing distinctive character on the sign as a whole, to conclude that it would serve in trade to distinguish the goods of the applicants from those of other traders.

23. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark...

Standard of review

21. This appeal is a review of the hearing officer’s decision. The decision under challenge is essentially an assessment of the distinctiveness of the mark sought to be registered. As explained by May LJ in *DU PONT Trade Mark* [2003] EWCA Civ 1368, [2004] FSR 15 at [94], the appropriate degree of respect to be accorded to a decision of a lower tribunal on such a review depends on the nature of the tribunal, the evidence and the issue. In my judgment, the degree of respect to be applied in the present case is that articulated by Robert Walker LJ in *REEF Trade Mark* [2002] EWCA Civ 763, [2003] RPC 5 at [28] as follows:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

Grounds of appeal

22. The applicant contends that the hearing officer erred in principle on four main grounds. First, that the hearing officer wrongly failed to take into account the fact that the Mark was coined by the Group and was therefore an invented word. Secondly, that the Mark was not descriptive because subject matter was not a “characteristic” of the Goods within the meaning of section 3(1)(c). Thirdly and most fundamentally, that the hearing officer was wrong, and the Registrar’s practice is wrong, to differentiate between goods such as posters and other goods. In particular, the applicant contends that the Mark is no more descriptive for posters and the like than it is for the goods in relation to which the application has been accepted; but on the contrary is just as distinctive for posters and the like as it is for the other goods. Fourthly, that the hearing officer’s decision was inconsistent with certain other registrations.

Passing off

23. Although the applicant’s trade mark attorney did not rely upon them in support of his client’s case, I think it is appropriate to refer to recent developments in the law of passing off before turning to consider the issues of trade mark law which arise in this case.
24. In *ELVIS PRESLEY* Simon Brown LJ referred, in the passage from his judgment which I have quoted in paragraph 14 above, to *McCulloch v Lewis A May (Produce Distributors) Ltd*. In that case Wynn-Parry J dismissed the claim of the plaintiff, a well-known radio broadcaster, that the use by the defendant of the plaintiff’s performing name Uncle Mac for a breakfast cereal constituted passing off on the ground that there was no common field of activity between the plaintiff and the defendant. While the decision may have been correct for other reasons, the requirement of a common field of activity was contrary to earlier authorities. Nevertheless, this doctrine proved surprisingly influential for many years. Although it was already discredited by the time of *Mirage Studios v Counter-Feat Clothing Co Ltd* [1991] FSR 145 (the Teenage Mutant Ninja Turtles case), it was not definitively overruled until

the decision of the Court of Appeal in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697 (a decision which does not appear to have been cited in *ELVIS PRESLEY*).

25. In the recent case of *Irvine v Talksport Ltd* [2002] EWHC 367, [2002] EMLR 32 (Laddie J) and [2003] EWCA Civ 423, [2003] EMLR 26 (CA) the first claimant was a well-known Formula 1 racing driver. The other claimants were companies through whom the first claimant had contracted to offer various services, including endorsement services. The defendant broadcast a radio station. To support a change of direction from news and general talk programmes towards sports, the defendant embarked upon a promotional campaign aimed at potential advertisers. Among the materials featured in this campaign was a brochure with a photograph of the first claimant on the front. The photograph had been manipulated so that, instead of holding a mobile telephone as in the original photograph, the claimant appeared to be holding a radio bearing the defendant's then name 'Talk Radio'. The claimants' claim for passing off was upheld both by Laddie J and by the Court of Appeal.
26. In his judgment Laddie J analysed the law of passing off at some length and concluded that a claim would lie where the claimant had a substantial goodwill and the actions of the defendant's activities misled a substantial number of persons into believing that the claimant had endorsed, recommended or approved the defendants' goods or services. The core of his reasoning is contained in paragraph [38] of his judgment:

In my view these cases illustrate that the law of passing off now is of greater width than as applied by Wynne-Parry J in *McCulloch v May*. If someone acquires a valuable reputation or goodwill, the law of passing off will protect it from unlicensed use by other parties. Such use will frequently be damaging in the direct sense that it will involve selling inferior goods or services under the guise that they are from the claimant. But the action is not restricted to protecting against that sort of damage. The law will vindicate the claimant's exclusive right to the reputation or goodwill. It will not allow others to so use goodwill as to reduce, blur or diminish its exclusivity. It follows that it is not necessary to show that the claimant and the defendant share a common field of activity or that sales of products or services will be diminished either substantially or directly, at least in the short term. Of course

there is still a need to demonstrate a misrepresentation because it is that misrepresentation which enables the defendant to make use or take advantage of the claimant's reputation.

27. In paragraph [39] Laddie J added the following observations:

Not only has the law of passing off expanded over the years, but the commercial environment in which it operates is in a constant state of flux. Even without the evidence in this case, the court can take judicial notice of the fact that it is common for famous people to exploit their names and images by way of endorsement. They do it not only in their own field of expertise but, depending on the extent of their fame or notoriety, wider afield also. It is common knowledge that for many sportsmen, for example, income received from endorsing a variety of products and services represent a very substantial part of their total income. The reason large sums are paid for endorsement is because, no matter how irrational it may seem to a lawyer, those in business have reason to believe that the lustre of a famous, if attached to their goods or services, will enhance the attractiveness of those goods or services to their target market. In this respect, the endorsee is taking the benefit of the attractive force which is the reputation or goodwill of the famous person.

28. On the facts of the case, Laddie J held that the claimants did have a substantial goodwill and that the circulation of the brochure by the defendant had led a substantial number of persons to believe that the first claimant had endorsed the defendant's radio station contrary to the fact. The Court of Appeal upheld these conclusions and awarded the claimants damages of £25,000 as representing the minimum fee that the defendant would have had to pay to obtain the first claimant's endorsement.

29. The effect of this case is to bring English passing off law into line with that of Australia. In the leading Australian case of *Henderson v Radio Corporation Pty Ltd* [1969] RPC 218 the claimants were well-known professional ballroom dancers. The defendant released a record of music for ballroom dancing featuring a photograph of the claimants on the sleeve, albeit not very prominently. The claimants had appeared in some advertisements or promotions but had not endorsed any records. The Full Court of New South Wales held that the defendant had wrongfully appropriated the plaintiffs' professional reputation so as to cause them damage by depriving them of the

fee they could have charged for endorsing the record. Subsequently this decision has twice been approved by the High Court of Australia.

30. *Irvine v Talksport* shows that a performer whose name and/or likeness is used in merchandising, advertising or other commercial activities in such a manner as to suggest that he or she has licensed or endorsed those activities contrary to the fact is likely to have a remedy in passing off. It remains the case, however, that the performer does not have any remedy in passing off if his or her name or likeness is used in manner which does not mislead members of the public into believing that he or she has licensed or endorsed the use.

Uncontentious points of law

31. During the course of argument a number of points of law were established to be uncontentious.
32. First, the examination of an application to register a trade mark for compliance with section 3 must be stringent and full in order to ensure that marks are not improperly registered: Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2003] ECR I-3793 at paragraph 59, Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] ETMR 57 at paragraph 123. The Registrar has no discretion to exercise, but must make a judgment as to whether the conditions for registration are met. It is not permissible to refuse applications only in clear cases leaving other cases to be resolved through opposition or post-registration proceedings.
33. Secondly, a mark which is sought to be registered must be assessed for compliance with section 3 as at the application date. In the case of a word mark, this assessment involves having regard to its meaning: *POSTKANTOOR* at paragraph 32. It follows that the meaning of the word or words must be considered as at the application date: *BACH AND BACH FLOWER REMEDIES Trade Marks* [2000] RPC 513.

34. Thirdly, the distinctive character of a trade mark must be assessed by reference to (a) the goods or services in which it is sought to registered and (b) the perception of the average consumer of such goods or services, who is deemed to be reasonably well informed and reasonably observant and circumspect. This proposition has been reiterated by the European Court of Justice in numerous cases.
35. Fourthly, the examining authority must have regard to all relevant facts and circumstances: *POSTKANTOOR* at paragraphs 35-37.

The average consumer in the present case

36. At the hearing before me the argument focused on posters. Both parties agreed that there was no material distinction between posters and the remainder of the Goods.
37. The applicant's attorney was candid that the applicant's intention was to use the Mark in relation to posters depicting the Group or otherwise having the Group as their subject matter, and not for example Kylie Minogue (unless, say, Kylie Minogue entered into a collaboration with the Group), still less non-music related subject matter. I shall therefore consider the position on the basis that the application is for posters and other Goods related in terms of subject matter to the Group, in accordance with the commercial reality.
38. The applicant's attorney not only accepted but positively contended that the consumers of such posters were likely to be fans of the Group. (I shall come to his purpose in advancing this contention below.) It follows that the typical consumer of the Goods is likely to be young, male (although some may be female), knowledgeable about the Group (and no doubt to some extent current popular music generally), but otherwise of no particular sophistication. I also bear in mind that the Goods may be purchased as presents by relatives and friends. The Goods are relatively inexpensive, everyday items and therefore would not be purchased with any special degree of care.

Section 3(1)(c)

39. Section 3(1)(c) implements Article 3(1)(c) of the Directive and corresponds to Article 7(1)(c) of Council Regulation 40/94/EEC of 20 December 1993 on the Community trade mark (“the Regulation”). These provisions have been considered by the European Court of Justice in a number of cases, in particular Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber* [1999] ECR I-2779, Case C-383/99P *Procter & Gamble Co v Office for Harmonisation in the Internal Market (BABY-DRY)* [2001] ECR I-6251, Joined Cases C-53/01 and C-55/01 *Linde AG v Deutsches Patent- und Markenamt* [2003] ECR I-3161, Case C-191/01P *Office for Harmonisation in the Internal Market v Wm Wrigley Jr Co (DOUBLEMINT)* [2004] ETMR 9 and *POSTKANTOOR*. The Court has repeatedly stressed that these provisions serve a public interest, which is to ensure that descriptive terms are free for use by all.

40. In *DOUBLEMINT* the Court stated:

29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or of rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under Article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of

Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provisions itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.

41. In *POSTKANTOOR* the Court stated:

57. It is irrelevant whether there are other, more usual signs or indications for designating the same characteristics of the goods or services referred to in the application for registration than those of which the mark concerned consists. Although Art. 3(1)(c) of the Directive provides that, if the ground of refusal set out there is to apply, the mark must consist exclusively of signs or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics.

...

97. It is not necessary that the signs and indications composing the mark that are referred to in Art. 3(1)(c) of the Directive actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of the provision itself indicates, that those signs and indications could be used for such purposes. A word must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned (see to that effect, in relation to the identical provisions of Art. 7(1)(c) of [the Regulation] Case C-191/01P *OHIM v Wrigley* [2003] ECR I-0000, para. [32].)

Invented words

42. The applicant's first main contention is that the word LINKIN and the phrase LINKIN PARK were invented by the group. Accordingly, the applicant argues, the Mark is meaningless, and therefore it cannot be descriptive. In my judgment the flaw in this argument is that it is looking at the meaning of the Mark at the date when was it coined. What matters, however, is its meaning at the application date. By the application date, the Mark was no longer meaningless, but on the contrary had acquired a well established meaning of denoting the Group. This was particularly so in the perception of the relevant average consumer. It is true that the Mark was not a dictionary term (as was the case in *TARZAN*), but it is clear from *DOUBLEMINT* and *POSTKANTOOR* that it is not a pre-requisite for the application of section 3(1)(c) that the sign in question be a dictionary term.
43. The applicant's attorney argued that this led to a paradox, which was that the applicant was worse off than if it had sought to register the Mark when the Group was unknown. He said that it ought to have a stronger case for registration once the Group was well known. In my judgment there is no such paradox, for two reasons. First, there is no evidence that the Group is (or was at the application date) well known as a trade source of posters and the like. If there was, it could gain registration on that basis. Secondly, as the Registrar's representative observed, a mark may by becoming distinctive for one class of goods or services (here musical performances) become descriptive for another class of goods or services (here the Goods).

Characteristics

44. The applicant's second main contention is that the Mark does not designate a characteristic of the Goods because subject matter is not a "characteristic" of them, and therefore the present situation was distinguishable from cases such as *DOUBLEMINT*. The applicant's attorney argued that to be a "characteristic" something had to be, as he put it, a measurable property of the Goods rather than the information content of the Goods. I cannot accept this

argument, since it is not difficult to think of goods where the information content is a critical characteristic of the goods, notably computer programs.

45. An alternative argument might to say that subject matter is neither “kind” nor “quality” nor “intended purpose” nor “value” nor “geographical origin” nor “time of production” and that “other characteristics” must be construed *ejusdem generis* with these expressions. I cannot accept this argument either, however. In my view these expressions do not constitute any recognisable genus. On the contrary, they show that a considerable diversity of characteristics is embraced by section 3(1)(c). In my judgment the purpose of the words “other characteristics” is to make it clear that section 3(1)(c) extends beyond the specific types of characteristics mentioned. I see no reason why subject matter should not qualify.
46. I put to the applicant’s attorney a similar question to the one that Salmon LJ put to Mr Burrell in *TARZAN*: could he think of a better – or even just an alternative – way to describe a poster depicting the Group than “a LINKIN PARK poster”? His response was that it might be described as “a poster of LINKIN PARK”. In my judgment this is insufficient to avoid the application of section 3(1)(c), for two reasons.
47. First, if one imagines a consumer who wants a poster depicting LINKIN PARK asking a shop assistant whether that shop stocks such things, he would be very likely to say “Do you have any LINKIN PARK posters?”. I accept that he might use the alternative formulation, but in my judgment this is less likely. In the question “Do you have any LINKIN PARK posters?” the Mark is clearly being used to describe a characteristic of the Goods being sought, namely their subject matter.
48. Secondly, even in the alternative formulation, “Do you have any posters of LINKIN PARK?”, the Mark is still being used descriptively.
49. The applicant’s attorney argued that it was not necessary for someone wishing to trade in posters depicting the Group to use the Mark, as the hearing officer

held. In my view it would be for difficult if not impossible for a trader to market such posters without using the Mark. How else, for example, would he describe the posters to wholesalers and retailers? Even so far as consumers are concerned, I do not believe that the members of the Group are as recognisable as, say, David Beckham – which, if it were the case, might permit posters to be sold to consumers by image alone. Even assuming that it would be possible for a trader to market posters without using the Mark, however, it is clear from cases such as *POSTKANTOOR* that this would not prevent the application of section 3(1)(c). The correct test is whether the mark sought to be registered is capable of being used descriptively.

The nature of the goods and the Registrar's practice

50. The applicant's third main contention is that the hearing officer wrongly distinguished between the Goods and other goods in relation to which the Mark has been accepted. This argument has two strands to it. The first and most fundamental is the Registrar's practice as set out above, which the hearing officer substantially followed, is wrong insofar as it distinguishes between "mere image carriers" and other types of goods.
51. Underlying this contention, as the applicant's attorney did not shrink from arguing, is the proposition is that performers such as the Group should be able to stop use of their names without their consent in relation to any goods or services without exception. It will be seen that this is exactly the proposition that the Court of Appeal rejected in *ELVIS PRESLEY*. The applicant's attorney argued that the law was different under the 1994 Act, the Directive and the Regulation, but he was unable to cite any authority which demonstrates that is so.
52. It is certainly possible that Parliament or the European Union might legislate to confer a right of personality upon performers and other celebrities, as many states in the USA have. It is also possible that such a right might be held to be encompassed within the right to a private life under Article 8 ECHR, by extension from cases such as *Von Hannover v Germany* [2004] EMLR 21.

Neither development has yet occurred, however, and in any event such developments would not necessarily support the registration of a trade mark in a case such as the present.

53. Nor is the applicant's argument supported by the development of the law of passing off exemplified by *Irvine v Talksport*. This still requires proof of goodwill and likelihood of confusion, whereas registration of the Mark in relation to the Goods would free the applicant from having to prove either in the case of use of an identical sign on identical goods.
54. Returning to the field of trade marks, the authority which provides the most support for the applicant's contention is *Arsenal v Reed*. So far as Laddie J's judgment is concerned, however, as he was careful to say, it was a decision on the facts of the case. The decision does not establish the general principle for which the applicant contends. This is particularly so given that section 3(1)(b) and (c) were not relied upon by the defendant in that case. Strictly speaking, all that Laddie J decided was that the various signs in issue were capable of being trade marks. If and in so far as his *dicta* go wider than this, it seems to me that they are explicable upon the basis that the marks, although originally descriptive and still capable being of used descriptively, had nevertheless acquired a distinctive character through use. In saying this, I bear in mind that that it is sufficient for this purpose that the sign should be perceived by a significant proportion of the relevant class of persons as distinguishing the goods or services of one undertaking from those of other undertakings: Case C-299/99 *Koninlijke Philips Electronics NV v Remington Consumer Products Ltd* [2002] ECR I-5475 at paragraph 61.
55. It may be noted that the argument which failed in *Arsenal v Reed* succeeded on different facts in *Rugby Football Union v Cotton Traders Ltd* [2002] EWHC 467, [2002] EMTR 76. In that case Lloyd J held that a Community trade mark registration consisting of the rose emblem used on the English RFU team's jerseys from about 1920 to 1998 was invalid under Article 7(1)(a) of the registration since replica jerseys bearing it had been widely marketed by

undertakings operating without authority from the RFU. For good measure, he also held that the mark was invalid under Article 7(1)(c) and (d).

56. It may also be noted that the argument advanced under section 3(1)(a) and Article 7(1)(a) in these cases can now be seen to be flawed in any event. This is because the European Court of Justice has held that these provisions are limited to signs which are incapable of functioning as trade marks regardless of the goods in relation to which they are used: *POSTKANTOOR*, paragraph 80.
57. The Registrar's representative submitted that the starting point for any consideration of distinctiveness, and hence descriptiveness, was the essential function of a trade mark. As the European Court of Justice has repeatedly held, this is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from those which have another origin. In order to perform this function, the mark must offer a guarantee that all the goods or services bearing it have been manufactured or supplied under the control of a single undertaking which is responsible for their quality.
58. On this basis, it might be argued that the decision of the European Court of Justice in Case C-206/01 *Arsenal v Reed* [2002] ECR I-10273 sheds light on the registrability of marks such as the one in issue in the present case. In that case, the Court held in paragraph 56 that the use of the word ARSENAL by the defendant was "such as to create the impression that there was a material link in the course of trade between the goods concerned and the trade mark proprietor". Although this finding is controversial, it was subsequently endorsed by the Court of Appeal ([2003] EWCA Civ 696, [2003] RPC 39). One difficulty with this argument, as the applicant's attorney accepted, is that the decisions of the Court of Justice and of the Court of Appeal were predicted on a finding that the marks in suit were validly registered and were concerned with the extent of the rights conferred by those registrations. Another difficulty is that, as I have pointed out above, the marks in suit had been used as trade marks by the claimant. In any event, the decisions were concerned

with marks relating to sports teams, which may give rise to different considerations to names of performers and other celebrities.

59. A factually closer case to the present is *R v Johnstone* [2003] UKHL 28, [2003] 1 WLR 1736. In that case the defendant was a trader in compact discs which reproduced bootleg recordings of well-known performers. Some of the names of the performers in question were registered as trade marks in Class 9. He was charged, not with offences of infringement of performers' rights, but with offences of trade mark infringement. His defence was that the use of the performers' names on the discs was not trade mark use, since it did not indicate trade origin but merely the identity of the performers. After the judge had ruled that this was not a defence in law, he pleaded guilty. His appeal was allowed by the Court of Appeal Criminal Division and an appeal by the Crown to the House of Lords was dismissed. Lord Nicholls of Birkenhead and Lord Walker delivered the principal speeches, with which Lord Hope of Craighead, Lord Hutton and Lord Rodger of Earlsferry agreed.

60. Lord Nicholls said:

35. I turn to apply section 92(1)(c) to the facts of the present case, taking count 1 for ease of reference. 'Bon Jovi' is, it seems, registered as a trade mark for compact discs. Clearly Mr Johnstone would commit an offence under section 92(1) if he sold compact discs under the brand name 'Bon Jovi'. Used in this way the sign 'Bon Jovi' would be an indication of trade origin, in the same way as household names such as EMI or Sony are used to indicate the trade origin of compact discs marketed under those brand names. This use of the sign 'Bon Jovi' would be as an indication that the discs themselves all came from a source known as 'Bon Jovi'.

36. That is not what Mr Johnstone did. What he did was to include on the CD labels and, I assume, the accompanying packaging, the name of the group or artist whose performance was recorded on the CD in question: Bon Jovi in the case of count 1, U2 in the case of count 2, Rolling Stones in the case of count 3, and so on. Considered as a matter of principle, the position in this type of case is as follows. If the name of the artist or group affixed to the compact disc and displayed on the packaging is *exclusively* an indication of the name of the performer whose performance is recorded on the compact disc, and if this use of the name of the performer is not likely to be understood as indicating any other connection between the performer and the

compact discs, then such use would be descriptive only. By identifying the performer it would be descriptive of the contents of the disc and nothing more. It would not be an indication of the trade 'origin' of the disc itself. Whether particular labelling and packaging satisfy this test, and consequently are innocuous for trade mark purposes, is a question of fact in each case.

37. On this question of fact different minds may sometimes reach different conclusions. This is illustrated by the decision of the Federal Court of Australia, sitting as a Full Court, in *Musidor BV v Tansing (t/a Apple Music House)* (1994) 123 ALR 593. Tansing manufactured and sold compact discs bearing bootleg recordings of live performances by the Rolling Stones group on the 1960s. The packaging bore a photograph of the Rolling Stones and the name Rolling Stones in prominent lettering. The compact discs also bore the name Rolling Stones. 'Rolling Stones' was registered as a trade mark for compact discs. The majority of the court, comprising Gummow and Heerey JJ, held that this use did not infringe the trade mark because it was not use as a trade mark. Use of the words 'Rolling Stones' on the packaging and discs would convey to the prospective purchaser that if he bought the disc and played it there would emerge music of the well known group Rolling Stones. There is no other way of readily identifying the group whose performance was recorded on the disc.
38. In his dissenting judgment Davies J reached a different conclusion on how this use of the words Rolling Stones would be understood. He expressed himself in quite general terms. If a trade mark is used in relation to sound recordings, and the name is that of a musical group, 'the use of the mark will ordinarily inform the public that the article as a recording of a performance by the group *and that its release has been authorised by them or their organisation*' [my emphasis]: see at p. 594.
39. In the present case the Court of Appeal preferred the minority opinion of Davies J, while emphasising that whether a mark is used as a trade mark is a question of fact in every case. I do not understand the Court of Appeal to have been saying that the test applicable when deciding this question of fact is different from what I have set out above. If they were, I respectfully disagree.
40. The crucial issue here, as I have said, is one of fact. I add a general comment. Difficulties can be expected to arise if trade mark law is utilised as a means of enforcing performers' rights in respect of recordings of their performances. Trade mark law, as already emphasised, is concerned essentially with the trade origin of goods. Protection for the rights of performers as such as properly found elsewhere: nowadays, in Part II of the Copyright, Designs and Patents Act 1988, as amended by the Duration of Copyright and Rights in Performers Regulations 1995 (SI 1995 No. 3297), the Copyright and Related Rights Regulations 1996 (SI 1996 No. 2967) and the

Copyright etc. and Trade Marks (Offences and Enforcement) Act 2002. This legislation contains an elaborate code concerning rights of performers, together with remedies and criminal sanctions for infringements of performers' rights by making, possessing or selling illicit recordings. The code includes like provision for persons having recording rights. I recognise that, given the control performers have over recordings of their performances, a buyer of a compact disc may expect the recording has been approved by or on behalf of the performer. But that expectation, where it exists, is not necessarily indicative that the performer's name is being used on the compact disc as a trade mark or that the average buyer so understands.

41. For completeness I add the decision of the European Court in *Arsenal Football Club plc v Reed* (Case C-206/91) [2003] 3 WLR 450 ... does not assist either way on this point in the present case...
61. Following a discussion of *Arsenal v Reed*, Lord Walker said:
 86. The difficulty arises, I think, because between cases which are clearly at the opposite extremes of 'distinctiveness' and 'descriptiveness' there is something of a no man's land of debateable cases, and the problem of analysis varies with the character of the mark and the character of the goods to which it is affixed. Disputes about books, and scarves, and compact discs, cannot easily be resolved by a single test. Most people would have an intuitive feeling that to label a compact disc with the words 'Rolling Stones' is less purely descriptive than entitling a biography 'Wet Wet Wet'. That is no doubt because a group of musicians are in some sense the authors (or at least the performers) of what is on the disc, but are not the authors of an unauthorised book about themselves. But in that case is not their real grievance infringement of their copyright or their performing rights, rather than of their trade mark? Was not Mr Holterhoff's real complaint (*Hölterhoff v Freisleben* (Case C-2/00) [2002] ECR I-4187) infringement of his design right in two new methods of cutting precious stones (if indeed he had invented those methods) rather than of his trade mark?
 87. These are difficult questions which it is not necessary for your Lordships to determine in order to dispose of this appeal. Whatever uncertainties there are about the decision of the European Court of Justice in *Arsenal*, its likely effect is that the province of trade mark use has annexed a significant part of the no man's land in which elements of distinctiveness and descriptiveness overlap. But it would be idle to speculate whether the view taken by the European Court of Justice in the *Arsenal* case is reconcilable with the majority view in *Musidor* because (as Lord Nicholls has emphasised in his speech, and as I respectfully agree) trade mark use is essentially a question of fact (of a fairly complex sort). *Musidor* can indeed be seen as turning on

whether it was right for the Federal Court to differ from the trial judge on an issue of that sort. The judgments mention some of the factors which may contribute to the eventual conclusion: the prominence and apparent purpose with which the group's name (and registered trade mark) is used on the disc and its packaging; what other brand marks (registered or unregistered) are used on the disc and its packaging; the terms and prominence of any disclaimer (although a disclaimer, by itself, cannot be conclusive); and any other matters going to the alleged infringer's good faith and honesty.

...

89. On the second issue (the proper limits of trade mark use) I would not go so far as the Court of Appeal went in preferring the minority view in the *Musidor* case and in inclining to the view that every bootlegging case of this sort would involve trade mark use. It seems likely that Mr Johnstone would have had a difficult task in making good the defences which he wished to run. However, he should have been permitted to run them...
62. The name of a performer, like the name of an author of a literary or musical work, undoubtedly indicates the origin of the performance or the work, as the case may be. Accordingly performers and authors may in appropriate circumstances have a remedy in passing off if performances or works of others are marketed under their names or confusingly similar names (see e.g. *Sutherland v V2 Music Ltd* [2002] EWHC 14, [2002] EMLR 28). As Lord Nicholls and Lord Walker say, however, it does not necessarily follow that the name of a performer or author acts as an indication of the trade origin of a product (a CD or a book or even an MP3 file) which embodies the performance or work.
63. Even where the performance or the work is protected by performers' rights or copyright, as the case may be, I believe that consumers are very well aware of the existence and availability of unauthorised reproductions of such performances and works. Where a consumer has, say, downloaded a Rolling Stones track using a peer-to-peer Internet network, the term ROLLING STONES continues accurately to designate a characteristic of the track, namely the origin of the performances, even though (a) the consumer has infringed various intellectual property rights (such as the Rolling Stones'

performers' rights) and (b) the consumer is likely to be aware of this (although not necessarily of the precise legal details).

64. Furthermore, it must not be forgotten that performers' rights and copyrights have a finite duration and eventually expire through effluxion of time. Once the relevant rights have expired, the performer or the author no longer has the power to authorise or prohibit the reproduction and distribution of the performance or the work. In such circumstances, the performer's or the author's name cannot function as a trade mark even on the basis of authorisation as Davies J held in *Musidor*. Yet whether the performer's or the author's name functions as a trade mark surely cannot depend on whether the performance or the work is within or outside of the period of protection, particularly since different performances by the same performer will come out of protection at different times depending on when the performances were given.

65. The Registrar's representative argued that the extent to which consumers expected goods to be authorised or endorsed by persons who were, or whose performances or works were, the subject matter of such goods depended on the nature of the goods, and that consumers were less likely to expect this in the case of posters than in the case of CDs or books. I accept that the nature of the goods is an important factor, but I am not convinced that this means that the line should be drawn between "media" and "mere image carriers". In *R v Johnstone* Lord Walker referred to *Bravado Merchandising Services Ltd v Mainstream Publishing (Edinburgh) Ltd* [1996] FSR 205. In that case the petitioner was the proprietor of a registration for the mark WET WET WET, the name of a pop group, in respect of printed matter, books and book covers. It was held that use of the expression WET WET WET as a part of the title of a biography of the group was not an infringement by virtue of section 11(2)(b). It seems to me to be arguable, bearing in mind the public interest which underlies section 3(1)(c) and the approach indicated in *DOUBLEMINT* and *POSTKANTOOR*, that the registration was invalid on the basis that the mark was descriptive of the subject matter of the goods in relation to which the proprietor used or intended to use it.

66. The applicant's attorney argued that the relevant consumers in the present case, being mainly fans of the Group, would be knowledgeable about intellectual property rights and would expect merchandise relating to the Group, including posters, to be licensed by the Group or its vehicle the applicant. I am not satisfied that this is correct. As the hearing officer held and the Registrar's representative submitted, consideration of the copyright position suggests the opposite. The first owner of copyright in a photograph of the Group will be the photographer or the photographer's employer. Accordingly, exploitation of photographs of the Group will not necessarily require the Group's licence. Accordingly, even if performers' or authors' names may be registered in respect of compact discs and books on the basis that members of the public would expect such items to be authorised by the performer or author (contrary to what is suggested above), that would not mean that such marks were registrable for posters.
67. Furthermore, this seems to me to be a matter for evidence. If the applicant wishes to secure registration on the basis that consumers would expect posters depicting the Group to be licensed by the Group, then in my judgment it is incumbent on the applicant to adduce evidence to show that the perception of the average consumer is as it contends. It has not done so.
68. My conclusion is that paragraph 21.2 of the Work Manual represents a correct application of the law as it presently stands. For the reasons I have given, I am less sure about paragraphs 21.1 and 21.3; but, if they are wrong, it is because they are unduly lenient to applicants, which does not assist the present applicant.
69. The second strand of the applicant's argument was specific to the facts of this case. The applicant's attorney pointed out that the Mark had been accepted for registration in respect of "calendars, decals, stickers". He argued that the Mark was no more descriptive of the Goods than it was of those goods. This argument has obvious force, and the Registrar's representative was unable satisfactorily to explain why the Mark should be registrable for "calendars, decals, stickers" but not for the Goods. Nevertheless, the question of the

registrability of the Mark in respect of “calendars, decals and stickers” is not before me. All that I have to decide is whether the Mark is registrable for the Goods. It may be that the Mark was wrongly accepted for “calendars, decals, stickers”; but that is not a matter that I have to decide.

Other registrations

70. The applicant’s fourth main argument was to rely upon two other registrations. First, the applicant relied upon the fact that its corresponding CTM application had not been objected to by OHIM. I asked whether there was any statement by OHIM of its practice or any reasoned decision in this field, but neither party was aware of either. In those circumstances, the fact that OHIM accepted the application is not even of persuasive value. It may be that the examiner was not aware of the meaning of LINKIN PARK.
71. Secondly, the Applicant also relied on the fact that ARSENAL is registered in Class 16. The problem with this is that I do not know why that application was accepted. For all I know it was accepted on the basis of acquired distinctiveness. Furthermore, as I have already observed, it is possible that names of sports teams fall to be treated differently to names of performers and other celebrities.
72. In short, the present case is no exception to the normal rule that the state of the register is irrelevant: *British Sugar plc v James Robertson & Co Ltd* [1996] RPC 281 at page 305.

Section 3(1)(b)

73. Since I am satisfied that registration of the Mark in respect of the Goods is precluded by section 3(1)(c), it is unnecessary for me to reach any conclusion with respect to section 3(1)(b).

Conclusion

74. The appeal is dismissed.

Costs

75. In accordance with the usual practice in this type of case I shall make no order for costs.

7 February 2005

RICHARD ARNOLD QC

Richard Gallafent of Gallafent & Co appeared for the applicant.

Allan James appeared for the Registrar.