

**TRADE MARKS ACT 1938 (AS AMENDED) AND  
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATIONS NOS. 1510338, 1510339, 1510340, 1510342,  
1510343 AND 1510344 BY AMBLESIDE INTERNATIONAL LIMITED  
TO REGISTER THE MARK MARLENE IN CLASSES 9, 16, 21, 26, 41 AND 42**

**AND**

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO  
UNDER NOS. 38220, 38221, 38222, 38223, 38224 AND 38225  
BY MARLENE, INC**

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**AND**

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS  
THERE TO UNDER NOS. 38220, 38221, 38222, 38223,  
15 38224 AND 38225 BY MARLENE, INC**

**DECISION**

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On 14 August 1992 Friedrich Kurz applied under Section 29(1)(a) of the Trade Marks Act 1938 to register the mark MARLENE in the following classes and for the following specifications of goods:-

25	<b>No.</b>	<b>Class</b>	<b>Specification</b>
	1510338	09	Sound and video recording and reproducing apparatus and instruments; pre-recorded or blank audio and video tapes and cassettes therefore; phonograph records; audio and/or video recordings; cinematographic films and photographic films all prepared for exhibition; electronic games and computer games; computer programmes; magnetic tapes and cassettes therefor; sunglasses, sunglass cases; parts and fittings for all the aforesaid goods; all included in Class 9.
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	1510339	16	Printed matter and printed publications; books, newspapers and periodicals; instructional and teaching materials; pencils, pens, stationery; greeting cards and postcards; transfers (decalcomanias) and stickers; photographs; posters and pictures; boxes, bags and containers, all made of paper or of cardboard; ordinary playing cards; plastic substances for modelling; all included in Class 16.
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	1510340	21	Domestic utensils and containers; glassware, porcelain and earthenware; all included in Class 21.
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- 1510342 26 Badges; brooches; buttons; buckles; appliques and ribbons; all included in Class 26.
- 5 1510343 41 Audio and visual entertainment services; organisation and production of audio and visual shows, programmes and recordings; production of stage and theatrical performances and concerts; theatre ticket agency services; production of radio and television shows and programmes; production and distribution of films and recordings; arranging and conducting exhibitions, shows and tours, all for entertainment purposes; publication of printed matter relating to the aforesaid; information and advisory services relating to the aforesaid; all included in Class 41.
- 10
- 15 1510344 42 Issue and negotiation of licensing rights relating to audio and visual productions, films, shows and recordings; design of sets and scenery, all for productions of theatrical shows and concerts, films and programmes; composition of music for films, shows and recordings; information and advisory services, all relating to the aforesaid; all included in Class 42.
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Each of the above applications has subsequently been assigned to Ambleside International Limited.

On 7 January 1994 Marlene, Inc of New York, United States of America filed notices of opposition to the above applications. The grounds of opposition are in summary:-

- 30 (i) under Section 11 in that the mark applied for is likely to be deceptive or confusing by reason of the use of MARLENE by Marlene Dietrich and, since her death, by the opponents. The opponents also say that the applications should be refused under this Section in the absence of the written consent of the legal representatives of Marlene Dietrich (as required by Rule 18 of the Trade Marks and Service Marks Rules 1986).
- 35 (ii) under Section 12(3) in that the mark applied for resembles a mark sought to be registered by the opponents for the same goods, or goods of the same description (see Annex for details).
- 40 (iii) under Section 17(1) in that the mark sought to be registered is not the applicant's mark. The opponents also say that, as a consequence (and having regard to the fact that the applications were originally made under Section 29(1)(a)) the applicant had no right to assign the marks.

The opponents also ask the Registrar to refuse the applications in the exercise of his discretion.

45 The then applicant filed counterstatements denying the above grounds.

Both sides ask for an award of costs in their favour. Both sides filed evidence in these proceedings and the matter came to be heard on 9 March 1999 when the opponents were represented by Mr N M Wilson of Withers & Rogers, Trade Mark Attorneys and the applicants by Mr J Hornby of Clifford Chance, Solicitors.

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By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

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### Opponents' evidence

The opponents filed a statutory declaration dated 18 December 1995 by John Peter Riva, the grandson of Marlene Dietrich and an officer of Marlene, Inc.

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Mr Riva says that Marlene, Inc is the operating company of Maria Elizabeth Riva who is the daughter and beneficiary of the estate of Marlene Dietrich. In support of this he exhibits (JPR1)

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- a copy of the last Will of Marlene Dietrich
- a copy of the first and only codicil to the Will
- a copy of the letters of Testamentary issued by the Surrogates' Court in New York in favour of Maria Riva.

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Maria Riva is, he says, solely entitled to all intellectual property rights in the name and image of Marlene Dietrich and has transferred all rights in the name to Marlene, Inc. He further exhibits (JPR2) a notarially attested Affidavit from Maria Riva to this effect dated 7 April 1994.

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Mr Riva says that Marlene Dietrich was a world famous actress and entertainer who starred in numerous films and, as a result, was and is well known. He exhibits (JPR3) a filmography detailing the films in which Marlene Dietrich starred. He goes on to say:

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"As can be seen from Exhibit JPR1, Marlene Dietrich was originally given the forenames Marie Magdalena but she subsequently joined the first and last syllables of her two forenames and created the new forename Marlene. There is now produced and shown to me marked "Exhibit JPR4", a copy of the front cover and pages 18-19 and 40-41 of the book entitled "Dietrich" by Donald Spoto, confirming the creating of the name and suggesting this was in 1922. In fact, in Marlene Dietrich's schoolbooks, which form part of Marlene Dietrich's archives currently on public display at Deutsche Kinemathek in Berlin, it can be seen that Marlene had created and was using the name as early as 1915.

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Since being known as Marlene, Marlene Dietrich has been accredited with the creation of that forename, and is associated exclusively with it, and that fact is recognized as such in dictionaries of first names. There is now produced and shown to me marked "Exhibit JPR5", a copy of the front cover of the Third Edition of Everyman's Dictionary

of First Names, together with the entry for "Marlene" which acknowledges the association with Marlene Dietrich. I believe anybody seeing the name Marlene would immediately think of Marlene Dietrich, because Marlene means Marlene Dietrich in view of her notoriety."

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In further support of the above Mr Riva exhibits (JPR6 to 8) further material from biographies, reviews of biographies and back research publications. These references often refer simply to Marlene as being synonymous with Marlene Dietrich. He says that Marlene Dietrich, during her life, "recognised the intellectual property right in her name and image and would not have consented to use of Marlene as a name and trade mark by any unauthorised third party". He exhibits (JPR9) an extract from a Reuter News Service entry in 1990 when Marlene Dietrich sued over use of her picture on a poster opposing German unification

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In relation to the applications in suit Mr Riva says:

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"The applications the subject of the oppositions filed by Marlene, Inc were filed by the applicant on 14 August 1992 at the time when a stage musical relating to Marlene Dietrich was staged in Germany under the name "Marlene". The musical was, I believe, put on by a company by the name of Lighthouse Kultur Holding GmbH and there is now produced and shown to me marked "Exhibit JPR10", a copy of an entry of the Commercial Registry for that company, which shows that the company had been in existence from July 1992 and its principal director was Bernhard Kurz, who I verily believe to be the brother of Friedrich Kurz, the applicant in respect of these applications. The musical in question related to Marlene Dietrich and therefore there is no doubt in my mind that the applications for registration of Marlene, the subject of these oppositions, were in the hope that the musical would be successful in Germany and would be brought to the stage in London. In fact, the musical "Marlene" was not successful, and closed in Germany in June 1993 and there has been no London production. In further support of this contention, there is now produced and shown to me marked "Exhibit JPR11", a copy page 14 of a brief filed on behalf of Bernhard Kurz and Friedrich Kurz, together with a translation, in connection with parallel proceedings being taken in Germany, paragraph 2 of which supports my contention that the selection of the name and trade mark Marlene was simply combined with the performance of the musical on Marlene Dietrich staged under the "Marlene" name, which the Kurz brothers had hoped would be successful for many years.

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There is no doubt in my mind that the mark the subject of the applications under opposition "Marlene" is synonymous with the name Marlene Dietrich, and was filed as a result of the stage musical "Marlene" to which I have referred. As such, I believe the name and trade mark Marlene was a property right of Marlene Dietrich which has passed to Marlene Dietrich's Estate, and no party other than Maria Riva and her operating company, Marlene, Inc., have the right to claim proprietorship in that right."

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#### Applicants' evidence

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The applicants filed a statutory declaration by Friedrich Kurz who describes himself as a producer and promoter of musicals and plays in major theatres predominantly in Germany.

He comments as follows:

5 "Following an agreement dated 27 July 1992 between Josef Weinberger, Lighthouse  
Musical Produktionsgesellschaft mbH and myself I bought the stage rights to "Falling in  
Love Again", a play written by the English playwright Lawrence Romans. This play  
was based on a book written by Martin Flossmann "Marlene - Ein Mythos Mit Musik"  
10 about the life of Marlene Dietrich. The play was substantially re-written and translated  
and was eventually presented as a major musical production at the Theater Am  
Kurfurstendamm in Berlin on 8 April 1993 under the title "Sag Mir Wo Die Blumen  
Sind" (Where Have all the Flowers Gone). In May 1993 the musical was rewritten with  
more reliance on Martin Flossmann's work (I had bought all rights in the book written  
by Martin Flossmann on 13 April 1993). The musical was then relaunched on 6 June  
1993 under the title "Marlene". There is now produced and shown to me marked  
15 "Exhibit FK1" a promotional pamphlet and poster for that show.

The musical Marlene has been promoted through Lighthouse Musical  
Produktionengesellschaft mbH and its associated companies for whom I produced the  
show. There has been substantial investment in the production, promotion and  
development of the show from a wide variety of sources including English investors.

20 It has been my and Josef Weinberger's intention since the inception of the idea for the  
musical that it would be adapted and presented in the UK and theatres worldwide. The  
agreement of 27 July 1992 with Josef Weinberger clearly provides for this.

25 My applications to register the MARLENE trade mark in the UK relate to the  
publicising and presentation of the musical in the UK as well as to the merchandising of  
products related to the musical. Goods to be merchandised will clearly be marketed in  
connection with the musical and the classes of goods I have applied to register the  
MARLENE trade marks for are intended to cover the various categories of  
30 merchandising and promotional goods."

Mr Kurz goes on to say that the musical was not an immediate success in Germany. Following  
a 'rewrite' a relaunch has been delayed pending the outcome of litigation instituted by the  
opponents in Germany (now said to have been decided in the applicants' favour). Mr Kurz says  
35 that it has been his intention to bring the musical to the West End in London and he comments  
on Marlene Dietrich's success and popularity in this country and the United States of America.  
He exhibits (FK2) extracts from newspapers sold in the UK showing the press coverage  
received. So far as I can see all this material is after the relevant date in these proceedings.

40 Mr Kurz goes on to say that his brother Bernhard Kurz has registered the trade mark  
MARLENE in Germany and has successfully defended the registration against cancellation  
proceedings launched by the opponents. He adds that:

45 "As was confirmed by the ruling of the German court referred to in the preceding  
paragraph, I reject the opponent's claim that either Maria Elisabeth Riva or Marlene Inc.  
are solely entitled to the exclusive right to use and to register the MARLENE trade  
mark and the image of Marlene Dietrich as a trade mark in the United Kingdom or

elsewhere. As far as I am aware there is no copyright in a name."

5 He refers to various registrations of the word MARLENE either on its own or in combination with other words (Exhibit FK3) and says that Marlene, as a female proper name, is perfectly acceptable as a trade mark for the classes of goods and services applied for.

10 He concludes by saying that the opponents have neither registered nor used the MARLENE mark in the United Kingdom. He rejects the claim that Marlene Dietrich invented the word Marlene or that Marlene, Inc. has any exclusive right to the mark and points to co-existence of the parties' registrations in Germany.

#### Opponents' evidence-in-reply

15 The opponents filed evidence in reply in the form of a statutory declaration by Frieder Roth, the opponents' legal representative in Germany responsible for ongoing legal proceedings between the parties. In summary he makes the following points:

20 S Mr Kurz is wrong to say that litigation has been finally determined. He exhibits (FR1) a copy of a Writ of Appeal

25 S he disputes Mr Kurz's statements as to the findings of the German Court and claims that he is not entitled to offer, distribute or sell goods bearing the picture and/or name of Marlene if it refers to the late Marlene Dietrich though he would be permitted to use the name if additional information on the life and character of Marlene Dietrich was given

30 S he reiterates the claim that the name Marlene was invented by Marlene Dietrich but says that even if he is wrong in this Marlene has come to mean Marlene Dietrich alone as evidenced, for instance, by the fact that the musical was to be relaunched simply under the title 'Marlene'.

35 S he says that he believes use of the sign MARLENE would lead the public to assume that the goods or services originated from or were sold with the permission of the heirs of the estate of Marlene Dietrich

That concludes my review of the evidence.

40 It is clear from the evidence and submissions at the hearing that the parties take different views of the mark at issue in these consolidated oppositions. The opponents say that the name MARLENE is synonymous with Marlene Dietrich and most people on encountering it would associate it with the singer and actress. The applicants say that that is going too far; that it is a christian name used by many people; and that subject to any other restrictions (such as the Registry's practice in relation to female forenames for certain types of goods) anyone should be free to apply for it. As this conflict of views is fundamental to what I regard as the main  
45 grounds of opposition I propose to come to my own view of the matter before considering the issues of law that arise.

The opponents have filed a body of evidence to suggest that the name MARLENE is strongly associated with Marlene Dietrich. But more than that it is said that she coined the name as a contraction of her forenames Maria and Magdalene. The dictionary extract at JPR5 broadly confirms this. Given that the name was first used in the 1920s it is not altogether surprising that the opponents cannot with absolute certainty credit Marlene Dietrich with its invention but certainly no earlier references have been offered so it is entirely possible that the claim is valid. The extract from Donald Spoto's book (JPR4) also supports this view. It is true, as the applicants point out, that the book suggests 'she had fashionably contracted her first two names'. There is admittedly some ambiguity in that comment but I take it to mean merely that the practice of contracting names was fashionable. The dictionary referred to above suggests that the popularity of the name Marlene may have been at its height in the 1940s and '50s and that variant forms have since been used. The fact that it was a coined name (whether by Marlene Dietrich or not) and that it is no longer common strongly suggests that it will be associated with the only well known individual so far as I am aware who was known by that name. I find nothing in either side's evidence to contradict that view and much to support it. The opponents point to videos and biographical works about Marlene Dietrich which have as their titles 'Marlene' or the christian name with other matter such as 'Marlene, My Friend', 'Marlene, The Mistress of Divine Scorn' and 'StarTurn - Sublime Marlene'. The conclusion they draw from this is that the name Marlene alone is sufficient to indicate the underlying subject matter. If further support for this proposition was needed it seems to me to be contained in the applicants' own evidence. They say that the play 'Falling in Love Again' was based on a book 'Marlene - Ein Mythos mit Musik' and that when a rewrite of the play was turned into a musical, the latter was called simply 'Marlene'. It is true that the musical was staged in Germany but the applicants themselves say that Marlene Dietrich enjoyed greater popularity in the United Kingdom and United States than in her native Germany. I have, therefore, come to the view that the name MARLENE is likely to be overwhelmingly associated with Marlene Dietrich and am not persuaded by the analogy Mr Hornby sought to draw with a name such as John which, he suggested, would not on its own indicate John Lennon say or indeed any other individual with that name. I accept that is likely to be the case with common Christian names but quite different considerations arise where an unusual or invented name is clearly associated with one individual as is the case with MARLENE.

With the above preliminary finding in mind I go on to consider the grounds of opposition. The key to the case seems to me to be the objection based on Section 17(1) which reads:-

"17. - (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register."

In particular the opponents say that the applicants cannot claim to be the proprietors of the mark. A supplementary issue arises in relation to the fact that the applications were made under Section 29(1)(a) (proposed use of a mark by a body corporate that is about to be constituted and assignment thereto) but it was agreed at the hearing that this issue stands or falls with the main Section 17(1) ground.

I indicated at the hearing that I found some assistance in the approach to be adopted in relation

to the name of a well known but deceased individual in the ELVIS PRESLEY case 1997  
RPC 543. In referring to this case I am conscious of the fact that it differed from the case  
before me in one important respect in that it was decided on Section 9 and 10 grounds rather  
than ownership under Section 17. At an earlier interlocutory hearing a request by the  
5 opponents to amend their statement of grounds so as to introduce objections based upon  
Sections 9 and 10 was turned down so the issues raised by those Sections are not before me.  
Given that Laddie J's findings related primarily to issues of distinctiveness I must exercise some  
caution in drawing on the ELVIS PRESLEY case where proprietorship was not an issue.  
However before he dealt with the objections to the individual marks in that case Laddie J made  
10 a number of general observations and the following passage in particular is relevant (it is at  
page 547 lines 4 to 41):-

"Before considering what rights might be acquired under the Trade Marks Act, 1938, it  
is useful to have a basic concept in mind. As Mr. Prescott put it in his skeleton  
15 argument, Enterprises is a company which has "as its principal object the exploitation of  
the name and likeness" of the late Elvis Presley. That it engages in such exploitation  
and benefits financially from Elvis Presley's continued fame is not in dispute. But,  
ignoring for the moment the effect of any registration of trade marks which it may  
secure, it does not own in any meaningful sense the words "Elvis" or "Elvis Presley".  
20 There is nothing akin to a copyright in a name. This has been part of our common law  
for a long time. In *Du Boulay v. Du Boulay* (1869) L.R. 2 P.C. 430 the Privy Council  
said;

"... in this country we do not recognise the absolute right of a person to a  
25 particular name to the extent of entitling him to prevent the assumption of that  
name by a stranger. ... the mere assumption of a name, which is the patronymic  
of a family, by a stranger who had never before been called by that name,  
whatever cause of annoyance it may be to the family, is a grievance for which  
our Law affords no redress."

30 Even if Elvis Presley was still alive, he would not be entitled to stop a fan from naming  
his son, his dog or goldfish, his car or his house "Elvis" or "Elvis Presley" simply by  
reason of the fact that it was the name given to him at birth by his parents. To stop the  
use of the whole or part of his name by another he would need to show that as a result  
35 of such use, the other person is invading some legally recognised right. This also is  
reflected in many cases in the law of passing off. In a well known and frequently cited  
passage in *Burberrys v. J.C. Cording & Co. Ltd.* (1909) 26 R.P.C. 693, Parker J.  
said at page 701:

40 "On the one hand, apart from the law as to trade marks, no one can claim  
monopoly rights in the use of a word or name. On the other hand, no one is  
entitled by the use of any word or name, or indeed in any other way, to  
represent his goods as being the goods of another to that other's injury. If an  
injunction be granted restraining the use of a word or name, it is no doubt  
45 granted to protect property, but the property, to protect which it is granted, is  
not property in the word or name, but property in the trade or goodwill which  
will be injured by its use."

Just as Elvis Presley did not own his name so as to be able to prevent all and any uses of it by third parties, so Enterprises can have no greater rights."

5 The arguments of Counsel on each side in relation to the issue of distinctiveness in that case are recorded as follows:

10 Mr Meade said that the Registrar came to the wrong conclusion as to the registrability of the "ELVIS" mark. He said that there was low inherent distinctiveness. "Elvis" is merely a given name. It may be that in England it is not the most common name but it is well known, no doubt in large part because of the fame of Elvis Presley. He says that the fact that the musician's name is well known does not make the mark more inherently distinctive but less so. He says that Enterprises can not get over their problems by relying on use or other special circumstances. He says that the evidence of use is virtually non-existent and there are no other special circumstances.

15 Mr Prescott asked me to approach this application in an entirely different way by considering what the position would be if Elvis Presley was still alive and had made this application himself. He says that there is no doubt that he would be entitled to a registered trade mark for his own name. In fact he went further back and suggested that I consider what the position would have been had these applications been made not now but before Elvis Presley had burst onto the entertainment firmament. Before he was famous, the word "Elvis" would have been virtually unknown in England. Had he applied then he would have got the mark on the register. Mr Prescott suggested that the position can be no different if Elvis Presley had applied later once he was famous or if his estate or its successors apply after he has died.

20 In the event Laddie J rejected the applicants' arguments and indicated that he needed to decide the position at the date of application and that ELVIS had very little inherent distinctiveness. He went on to consider the applicants' evidence of use and the 'other circumstances' which were prayed in aid. In relation to the latter he concluded:

25 "Mr. Prescott apparently is arguing that the fame of Elvis Presley constitutes "another circumstance" which demonstrates inherent distinctiveness (or capacity to distinguish under section 10). But for reasons given above, it does nothing of the sort. It does not help to identify the goods with a particular *proprietor*, as required by the Act. It only helps to identify the goods with a particular *subject matter*, namely Elvis Presley. In other words Elvis Presley's fame leads away from distinctiveness in the trade mark sense."

30 I emphasise again that I am not dealing here with objections based on distinctiveness grounds but it seems to me to be useful to bear in mind Laddie J's conclusion that, where one is considering the name of a well known individual, use of that name in relation to a certain type of goods will indicate the subject matter rather than being an indication of trade origin. It is true that issues of distinctiveness usually raise quite different considerations to issues of proprietorship but in certain respects they overlap. Thus, to take an example, if the name of the goods or a directly descriptive word cannot serve as a trade mark because it would deny other traders the freedom to use the term then it must also follow that no single trader can

claim to be the proprietor of the word. It seems to me that similar considerations can be said to apply to the name of a well known person. If, to take Laddie J's words, "it [ELVIS] does not help to identify the goods with a particular proprietor" but rather indicates the subject matter then it must follow that others should also be entitled to use the name or word in relation to that same subject matter and, absent some legally recognised right, no single individual can claim to be the proprietor of that name or word. There is no evidence that the applicants have established any common law or other rights in this country. I am not, therefore, persuaded to come to a different view by the analogies offered by Mr Hornby at the hearing.

5 I should also say that the applicants make no secret of their intentions in trying to register the mark. Mr Kurz says:-

15 "My applications to register the MARLENE Trade Mark in the UK relate to the publicising and presentation of the musical in the UK as well as to the merchandising of products related to the musical. Goods to be merchandised will clearly be marketed in connection with the musical and the classes of goods I have applied to register the MARLENE Trade Marks for are intended to cover the various categories of merchandising and promotional goods."

20 Given the conclusion I have reached in relation to the significance of the name MARLENE and the applicants' stated intentions I cannot accept that they can claim to own the mark in any meaningful sense for goods and services connected with a musical about Marlene Dietrich. This conclusion seems to me to be consistent with Laddie J's introductory observations in the ELVIS case quoted above. I have not forgotten that the applicants' evidence (FK3) shows registrations of various marks incorporating the word MARLENE - most notably MARLENE and device for apples and pears, and MARLENE MEDICAL STOCKINGS for medical compression stockings (the other examples are for somewhat different marks) but I do not consider that the goods involved would be likely to be associated with or about Marlene Dietrich, so different considerations apply.

30 I have reached the above view on the issue of proprietorship without needing to consider the opponents' own claim to proprietorial interest deriving from Marlene Dietrich's Will and the affidavit of Maria Elizabeth Riva and the opponents' own later filed applications are not before me in these proceedings. The opponents are, however, successful in their opposition under Section 17(1) for the above reasons.

35 My above decision effectively decides the opposition but I will briefly consider the other grounds advanced by the opponents.

40 Section 11 of the Act reads:

45 "11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design."

The established tests for objection under this Section was set down in Smith Hayden and

Company Ltd's application (Volume 1946 63 RPC 101) later adapted by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, the test may be expressed as follows:-

5            Having regard to the user of the mark MARLENE, is the tribunal satisfied that the mark applied for, MARLENE, if used in a normal and fair manner in connection with any goods or services covered by the registrations proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

10          Reference is made in the statement of grounds to use of MARLENE by Marlene Dietrich and, since her death, the opponents themselves. Whilst the evidence contains information on the creation and use of the name and refers to various biographies and books about Marlene Dietrich I can see nothing that points to use of the name in relation to a trade in goods or services such as might support an objection under Section 11. The opposition fails in this  
15          respect.

Section 12(3) of the Act reads as follows:-

20            (3)    Where separate applications are made by different persons to be registered as proprietors respectively of marks that are identical or nearly resemble each other, in respect of:-

- a.        the same goods
- 25        b.        the same description of goods, or
- c.        goods and services or descriptions of goods and services which are associated with each other,

30            the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or on an appeal (which may be brought either to the Board of Trade or to the Court at the option of the appellants) by the Board or the Court, as the case may be.

35            Thus the Registrar may refuse to proceed with either or both of the conflicting applications. The normal practice under the Trade Marks Act 1938 was that the application with the earliest filing date would normally be allowed to proceed to publication unless the application with the later filing date could show the first use of the trade mark. As neither party has established a persuasive claim to have used the claimed mark prior to the material date the applicants' mark  
40            has proceeded to this stage on the basis of having the earlier filing date. The matter has not been settled by agreement in a manner approved by the Registrar but it is clearly open to me to refer the matter to the Court for the rights to be determined. However as I have been able to reach a conclusion based on my findings in relation to Section 17(1) I do not think I need adopt that course.

45            The opponents also raise an objection based on Rule 18 of the Trade Marks and Service Marks Rules 1986. For ease of reference the Rule reads:

*"Persons living or recently dead*

18. Where the name or representation of any person living or recently dead appears on a mark, the Registrar shall consider whether to refuse to accept an application for the registration of the mark unless the consent of that person or, as the case may be, his executors or other legal representatives is filed."

I indicated at the hearing that a fundamental problem arises in relation to this ground of objection as Mr Justice Neuberger held in *Interlego AG's Trade Mark Application*, 1998 RPC 69, that the combined effect of Rules 1 and 69(1) of the Trade Marks Rules 1994 was to revoke the 1986 Rules without qualification. I do not accept Mr Wilson's submission that that decision should be disregarded as it came after the current proceedings got under way. More significantly perhaps he suggested that there was in effect a continuation of the underlying practice. He pointed to the entry in the Registry Work Manual (Chapter 6 - 9.11.2) in relation to examination practice under the new law where a sign consists of, or incorporates, the name of a famous individual (living or dead). It seems to me that this claim raises a number of contentious issues in relation to the law and practice; the applicability of practice where a christian name rather than full name is at issue; and the extent and sustainability of the claims made by the heirs, estate or legal representatives of famous deceased persons. So far as the latter point is concerned the opponents own applications have not yet been registered so their own claims have not been fully tested. Furthermore I have already indicated that I am not persuaded that the opponents have any enforceable common law rights that can be brought to bear. In the circumstances I decline to make a formal finding in relation to this ground.

The final matter is the request for exercise of the Registrar's discretion. I do not consider there is anything in the circumstances of the case which suggests I should exercise discretion in favour of the applicants in the face of my finding under Section 17(1). I decline to do so.

As the opponents have been successful they are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of **£1300** in respect of these consolidated oppositions.

**Dated this 31 day of March 1999**

**M REYNOLDS**  
**For the Registrar**  
**the Comptroller-General**

Opponents' applications

5 In respect of the following mark:

10



MARLENE DIETRICH

15

No.	Class	Specification
1514193	03	soaps; perfumery; non-medicated toilet preparations; cosmetics; essential oils; hair and bath preparations; dentifrices; all included in Class 3.
20		
1514194	16	goods made of paper or cardboard included in Class 16; printed matter; books; magazines; photographs and stands; posters; stickers; stationery including adhesive materials and writing cases; artists' materials; paint brushes; diaries; calendars; playing cards; greeting cards; wrapping and packaging material included in Class 16; book markers; pens and pencils and cases therefor; paper towels and tissues; all included in Class 16.
25		
30	25	articles of outer clothing; t-shirts; sweatshirts; shirts; bathing suits; beach clothes; footwear; headgear; pyjamas and night attire; sports clothing; tracksuits; rainwear; sweaters; ties; scarves; belts; all included in Class 25.
35	28	toys, games and playthings; jigsaws; parts and fittings for all the aforesaid goods; all included in Class 28.
40		
1529181	14	articles made of precious metals or coated therewith; jewellery, precious stones, watches; clocks; horological and chronometric instruments; parts and fittings for all the aforesaid goods; all included in Class 14.
45		
1529182	18	articles made of leather or imitations of leather; attache cases; bags; cases; purses; wallets; handbags; travelling bags and trunks; vanity cases; umbrellas; parasols and walking sticks; parts and fittings for all the aforesaid goods; all included in Class 18.

In respect of the following mark:

**MARLENE**

5	1515894	16	goods made of paper or cardboard included in Class 16; printed matter; books; magazines; photographs and stands; posters; stickers; stationery including adhesive materials and writing cases; artists' materials; paint brushes; diaries; calendars; playing cards; greeting cards; wrapping and packaging material included in Class 16; book markers; pens and pencils and cases therefor; paper towels and tissues; all included in Class 16.
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