

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITIONS 49400 AND 49431

IN THE NAME OF

THE FRANKLIN MINT COMPANY

TO APPLICATION 2161386

FOR REGISTRATION OF A TRADE MARK

IN CLASSES 3, 14, 25, 28 AND 36

AND DIVISIONAL APPLICATION 2143993B

FOR REGISTRATION OF A TRADE MARK

IN CLASSES 9 AND 16

IN THE PROPRIETORSHIP OF

THE ESTATE OF THE LATE DIANA PRINCESS OF WALES

DECISION

1. The late Diana Princess of Wales died as a result of injuries sustained in a road accident in Paris on 31st August 1997. There was immediate and widespread support for the establishment of a charitable trust to commemorate her life and work. Her private secretary, Michael Gibbins, and her solicitor, Anthony Julius, responded by executing a declaration of trust establishing the Diana Princess of Wales Memorial Fund (“*the Fund*”) on 4th September 1997. Soon afterwards her sister, Lady Sarah McCorquodale,

became a trustee of the Fund. The setting up of the Fund attracted considerable press coverage. Its operation thereafter continued to be the subject of observation and comment in the media.

2. Also on 4th September 1997, the trustees of the Fund applied under number 2143993 to register the designations DIANA PRINCESS OF WALES and DIANA PRINCESS OF WALES MEMORIAL FUND as a series of 2 trade marks for use in relation to all goods in Classes 9 and 16

3. The application for registration in series presupposed that the designations in question resembled each other as to their material particulars and differed only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark presented for registration: see section 41(2) of the Trade Marks Act 1994. Neither designation could, on that basis, be regarded as significantly more or significantly less distinctive than the other: they were liable to be regarded as equally acceptable or equally unacceptable in terms of the requirement for distinctiveness as a condition of registration.

4. I understand that steps were taken in October 1997 to separate the trusteeship of the Fund from the administration of the Princess's Estate. Some or all of the original trustees retired and were replaced by trustees who appear to have had no duties or responsibilities in relation to the administration of the Estate. The Princess's solicitors, Messrs Mishcon de Reya, continued to act for the trustees of the Fund. Messrs Lawrence Graham were appointed to act as solicitors to the Executors of her Will. At that stage, the Executors were her mother, the Honourable Mrs Frances Shand Kydd, and her sister, Lady Sarah McCorquodale.

5. On 19th December 1997 the Vice-Chancellor, Sir Richard Scott, appointed the Bishop of London, the Right Reverend and Right Honourable Richard Chartres, to act as an additional executor of the Princess's Will and approved an arrangement modifying the terms of her Will under the Variation of Trusts Act 1958. The approved modifications included the establishment of a 'Discretionary Fund' to be held by the Executors upon certain newly declared trusts. The assets of the 'Discretionary Fund' included "*all intellectual property rights and interests whether legal equitable or otherwise in or relating to such rights whether joint or sole*" to which the Princess was or might become entitled or which might accrue to her Estate after her death. The Executors were given wide powers of management, exploitation and enforcement in relation to such rights and interests.

6. On 27th February 1998 the trustees of the Fund assigned Application 2143993 to the Executors of the Princess's Will under a deed of assignment which recorded that the Executors were entitled to beneficial ownership of the unregistered trade marks consisting of the designations DIANA PRINCESS OF WALES and DIANA PRINCESS OF WALES MEMORIAL FUND.

7. Probate of the Princess's Will was granted on 2nd March 1998. On 18th March 1998 the Executors applied under number 2161386 to register the designation DIANA PRINCESS OF WALES MEMORIAL FUND as a trade mark for use in relation to the following goods and services in Classes 3, 14, 25, 28 and 36:

Class 3

Bleaching preparations and other substances for laundry use;
cleaning, polishing, scouring and abrasive preparations;

soaps; perfumery, essential oils, cosmetics, hair lotions, dentifrices.

Class 14

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; medals and medallions.

Class 25

Clothing, footwear, headgear.

Class 28

Games and playthings, gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Class 36

Insurance and financial services, including fund raising for charitable purposes.

8. The Executors wished to be free of the constraining effect of section 41(2) of the 1994 Act (see paragraph 3 above). On 3rd June 1998 Application 2143993 was divided so as to enable the 2 marks originally put forward for registration in series to be considered for registration independently of one another.

9. Divisional Application 2143993B proceeded as an application for registration of the designation DIANA PRINCESS OF WALES MEMORIAL FUND in respect of the following revised specification of goods:

Class 9

Amusement apparatus, cameras and cases, cartoons (animated), compact discs, computer software, computers, photographic darkrooms and equipment, metal detectors, divers' equipment; protective wear, footwear, headgear and eyewear; holograms, juke boxes, musical automata (coin-operated), radios, audio and video transmitting and receiving apparatus, sound recording apparatus, sound reproduction apparatus, musical sound recordings, spectacle frames, eyeglass associated equipment, swimming equipment and

wear, safety wear, telephone apparatus, video recorders, video players, video recordings on disc, tape and film.

Class 16

Albums, atlases, babies' napkins, bookends, bookmarkers, books, calendars, confetti, embroidery designs (patterns), engravings, etchings, figurines (statuettes) of papier mache, stationery, greetings cards, lithographs, magazines (periodicals), newspapers, pamphlets, paperweights, patterns for making clothes, photographs, pictures, place mats of paper, playing cards, portraits, postage stamps, postcards, posters, printed matter, printed publications, reproductions (graphic) sealing materials and apparatus, song books, terrestrial globes, toilet paper, transfers (decalcomanias), paper towels, paper handkerchiefs, typewriters, paintings, writing and drawing materials and apparatus.

10. Divisional Application 2143993A continued as an application for registration of the designation DIANA PRINCESS OF WALES in respect of all goods in Classes 9 and 16. It was withdrawn on 31st March 1999. However, two days previously the Executors had applied under number 2193296 to register the designation DIANA PRINCESS OF WALES as a trade mark for use in relation to a wide range of goods and services in various different classes. That application was ultimately rejected in its entirety for the reasons given in a written decision issued by Mr Allan James, acting on behalf of the Registrar of Trade Marks, on 31st July 2000. His decision is reported at [2001] ETMR 254. He decided that the designation in question lacked the power to serve as an indication that the goods and services with reference to which it was intended to be used came either from the same undertaking or economically-linked undertakings. The Executors did not appeal against that decision.

11. At some point during the implementation of the arrangements noted above, the Executors granted an exclusive licence to the trustees of the Fund. The evidence of Andrew Dobson of Messrs Lawrence Graham is to the following effect:

“On the death of Diana, Princess of Wales on 31 August 1997 all intellectual property rights vested in the Princess at the time of her death devolved upon her Estate automatically by operation of English law. Under a Licence Agreement the Estate has, acting through its Executors (being the Applicants together with the Bishop of London), exclusively licensed all intellectual property rights to the Memorial Fund. The precise terms of the Licence Agreement are highly sensitive and due to intense public interest have been kept confidential. The Licence Agreement grants to the Memorial Fund (amongst other things) an enduring right to utilise the subject mark. The Memorial Fund is the exclusive licensee of the Estate.”

The terms of the licence agreement have not been disclosed and the date with effect from which it was granted has not been identified.

12. The name of the Fund was and remains protected within the scope of the controls prescribed by the Charities Act 1993. Sections 6 and 7 of that Act enable the Charity Commissioners for England and Wales (*“the Commissioners”*) to require the name of any *“institution”* of the kind defined as a *“charity”* in section 96(1) to be changed to such other name as the charity trustees may determine with the approval of the Commissioners. A trust or undertaking can be an *“institution”* and therefore a *“charity”* for these purposes: section 97(1).

13. The power to require a change of name does not apply to any charity of the restricted class identified as exempt in Schedule 2 of the 1993 Act: see sections 6(9) and

96(1). Beyond that, however, the power is exercisable under sections 6(1) and 6(2) in relation to any charity (as defined) if:

- “(a) it is a registered charity and its name (‘the registered name’) -
 - (i) is the same as, or
 - (ii) is in the opinion of the Commissioners too like,
the name, at the time when the registered name was entered in the register in respect of the charity, of any other charity (whether registered or not);
- (b) the name of the charity is in the opinion of the Commissioners likely to mislead the public as to the true nature -
 - (i) of the purposes of the charity as set out in its trusts, or
 - (ii) of the activities which the charity carries on under its trusts in pursuit of those purposes;
- (c) the name of the charity includes any word or expression for the time being specified in regulations made by the Secretary of State and the inclusion in its name of that word or expression is in the opinion of the Commissioners likely to mislead the public in any respect as to the status of the charity;
- (d) the name of the charity is in the opinion of the Commissioners likely to give the impression that the charity is connected in some way with Her Majesty’s Government or any local authority, or with any other body of persons or any individual, when it is not so connected; or
- (e) the name of the charity is in the opinion of the Commissioners offensive.”

In the context of the present proceedings, it is relevant to note that the words and expressions specified for the purposes of the objection in sub-paragraph (c) include the singular, plural and possessive forms of **PRINCESS** and **WALES**.

14. It is the duty of the trustees of a charity (as defined) which is not registered or excepted from registration, to apply for it to be entered in the register of charities kept by

the Commissioners: section 3(7)(a) of the 1993 Act. However, it does not appear to be necessary for a trust or undertaking or any other “*institution*” to be registered in order for it to be a charity within the scope of the Act: Re Murawski’s Will Trust [1971] 1 WLR 707 (Brightman J). On that basis the Commissioners’ power to require a change of name on the grounds identified in sub-paragraphs (b) to (e) of section 6(2) is not confined to cases in which the charity concerned is registered.

15. Once the Fund had adopted the name DIANA PRINCESS OF WALES MEMORIAL FUND the Commissioners could realistically have been expected to prevent another charity (as defined) from subsequently establishing itself in England and Wales under that or any other name so closely resembling it as to be likely to deceive or cause confusion. The courts in the United Kingdom could equally realistically have been expected to prevent any undertaking (charitable or not) from subsequently using any such name in a context or manner liable to result in passing off: Burge v. Haycock [2002] RPC 28 p.553 (CA); British Diabetic Association v. Diabetic Society Ltd [1996] FSR 1 (Robert Walker J.).

16. Charitable involvement in trading activities requires careful planning and control. Charities must generally refrain from undertaking trading activities which do not directly advance the charitable purposes for which they are constituted. However, the exercise of the charity trustees’ powers of investment and asset management can legitimately extend to ownership and control of a non-charitable trading company and also to controlled licensing of the charity’s name and logo for use in connection with the marketing of consumer goods or services on mutually beneficial terms. The Commissioners have published detailed guidance as to the prudent and proper exercise of such powers by

charity trustees: Charities and Fund-raising (CC 20); Charities and Trading (CC 35); Fund-raising through Partnerships with Companies (SORP 2000); Charities and Commercial Partners (RS 2). These publications can be viewed online at www.charitycommission.gov.uk. The Commissioners of the Inland Revenue have published related guidance in a document entitled Trading by Charities (IR 2001). This can be viewed online at www.inlandrevenue.gov.uk.

17. For present purposes I need to refer to the controls applied by the Charities Act 1992 in relation to fund-raising involving the use of a charitable institution's name or logo. The provisions of the 1992 Act relating to fund-raising extend beyond charities as defined in the Charities Act 1993. They apply to any "*charitable institution*" meaning "*a charity or an institution (other than a charity) which is established for charitable, benevolent or philanthropic purposes*". In this context "*charity*" means "*a charity within the meaning of the Charities Act 1993*" and "*institution includes any trust or undertaking*"

18. According to section 58 of the 1992 Act, a "*commercial participator*" in relation to a charitable institution is a person (not being a company wholly controlled by the charitable institution concerned) who engages in the course of carrying on for gain a business (not being a business which is wholly or primarily engaged in soliciting or otherwise procuring money or other property for charitable, benevolent or philanthropic purposes) in an advertising or sales campaign or other venture undertaken for promotional purposes in the course of which it is represented (expressly or impliedly, in any manner whatever) that "*charitable contributions*" are to be given to or applied for the benefit of that charitable institution. For this purpose "*charitable contributions*" means:

- (a) the whole or part of–
 - (i) the consideration given for goods or services supplied by him, or
 - (ii) any proceeds (other than such consideration) of a promotional venture undertaken by him, or
- (b) sums given by him by way of donation in connection with the sale or supply of any such goods or services (whether the amount of such sums is determined by reference to the value of any such goods or services or otherwise).

It is, therefore, to be expected that traders who are appointed to use the name or logo of a charitable institution in connection with the marketing of consumer goods or services will usually if not invariably be “*commercial participators*” in relation to the charitable institution concerned.

19. The need for the activities of commercial participators to be controlled by the charitable institutions which appoint them is confirmed by Section 59(2) of the 1992 Act. That section makes it unlawful for a person appointed to act as a commercial participator to represent that charitable contributions are to be given to or applied for the benefit of a charitable institution unless he does so in accordance with an agreement with the institution satisfying the requirements prescribed by the Charitable Institutions (Fund-Raising) Regulations 1994 (SI 1994/3024) (as amended). These Regulations require the agreement to be in writing and signed by or on behalf of the charitable institution and the commercial participator. The parties must comply with various detailed requirements as to the terms to be agreed. There is an important requirement for the agreement to contain a statement of its principal objectives and the methods to be used in pursuit of those

objectives: Regulation 3(4)(a). The court may grant an injunction to prevent a person from acting as a commercial participator otherwise than in accordance with an agreement in writing in prescribed form: section 59(3) of the 1992 Act. The injunction is obtainable on the application of the charitable institution concerned.

20. Under section 62 of the 1992 Act an injunction may be granted to prevent persons who have not been appointed to act as professional fund raisers or commercial participators in relation to a charitable institution from:

- (i) soliciting (expressly or impliedly, in any manner whatever) money or other property for the benefit of the institution; or
- (ii) representing (expressly or impliedly, in any manner whatever) that charitable contributions are to be given to or applied for the benefit of the institution;

if the court is satisfied as to one or more of the following matters:

- (a) that the person in question is using methods of fund-raising to which the institution objects;
- (b) that that person is not a fit and proper person to raise funds for the institution;
- (c) where the conduct complained of is the making of such representations as are mentioned in (ii) above, that the institution does not wish to be associated with the particular promotional or other fund-raising venture in which that person is engaged.

Again, the injunction is obtainable on the application of the charitable institution concerned.

21. Sections 59 and 62 are intended to provide charitable institutions with effective means for protecting their reputation and standing with the public. It is clear from the publications noted in paragraph 16 above that the Commissioners expect charity trustees to be vigilant in the protection of their interests in that connection. The position is summarised in Tudor on Charities 8th Edn. (1995) at pp.279, 280 in the following terms:

Use of the charity name

A charity should not lend its name to a commercial product or service which is incompatible with the objective and image of the charity. The Charity Commissioners are concerned to protect the name of a charity which is considered to be a valuable asset. In their report for 1991, they warned:

“Before allowing the use of a charity name on a commercial basis, charity trustees must first consider the needs of the charity and whether the funds could be obtained by other methods... If a charity’s name is used commercially, it must be shown that the arrangement is expedient, in the interest of the charity and in terms which are advantageous to the charity.... Any such arrangement must be precisely defined by the charity trustees in every detail and kept under review. They must ensure that there is no misuse of the charity name nor any improper exploitation of its association with a commercial organisation and that the arrangements made allow them to prevent any such misuse” (paragraph 107).

22. In the present case, it appears from the evidence given by Andrew Dobson of Messrs Lawrence Graham and Purvi Parekh of Messrs Mishcon de Reya that it was at all material times intended that the designation DIANA PRINCESS OF WALES MEMORIAL FUND would be used by the Fund with a view to “*fund raising for charitable purposes*” in particular by licensing third parties to use the designation in

connection with the marketing of goods and services of the kind specified in Application 2161386 and Divisional Application 2143993B.

23. The Fund set up a Commercial and Fund Raising Committee to consider and approve licensing proposals on behalf of the trustees. It was intended that the Committee's decisions would, in relation to proposals which merited it, be included in a report to the full board of trustees. When a proposal was approved by the Committee, it would be passed to Messrs Lawrence Graham for review by the Executors on the basis that they should have the final say in the matter. The procedure is represented diagrammatically in the flow chart in Exhibit PP2 to Miss Parekh's Statutory Declaration.

24. The aim of the licensing arrangements was to provide consumers with an assurance that the licensed goods and services were being supplied with the approval and for the financial benefit of the Fund. Some examples of promotional materials in which the designation DIANA PRINCESS OF WALES MEMORIAL FUND has been used for that purpose can be found in Exhibit ACD 1 to Mr. Dobson's Statutory Declaration.

25. Application 2161386 and Divisional Application 2143993B were opposed by the Franklin Mint Company (*"the Opponent"*). All grounds of opposition were rejected in a written decision issued by Mr. Allan James, acting on behalf of the Registrar of Trade Marks, on 25th January 2002. The Opponent was ordered to pay £2,000 as a contribution towards the Executors' costs of the Registry proceedings.

26. The Opponent appealed to an Appointed Person under section 76 of the 1994 Act contending that the applications for registration should be refused under section 3(1) of the Act for descriptiveness and lack of distinctiveness and/or under section 3(6) of the Act

for having been made (save in relation to “*fund raising for charitable purposes*” as specified in Application 2143993B) in bad faith. I now turn to consider these objections to registration in the light of the circumstances I have outlined above.

27. The applicability of any one of the absolute grounds for refusal listed in section 3 of the Act is sufficient to prevent an application from proceeding to registration: Case C-104/00P DKV Deutsche Krankenversicherung AG v. OHIM (COMPANYLINE) [2003] ETMR 20, p.241 at paragraph 29.

28. The designation in issue in the present proceedings must be assessed for distinctiveness in relation to the goods and services specified in the applications for registration: Case C-517/99 Merz & Krell GmbH & Co [2001] ETMR 105, paragraphs 29 and 30; Case C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd [2003] RPC 2, p.14 at paragraph 59.

29. Moreover, each of the grounds for refusal listed in section 3(1) of the Act is independent of the others and calls for separate consideration: Cases C-53/01 to C-55/01 Linde AG, Winward Industries Inc, Rado Uhren AG 8th April 2003, paragraph 67.

30. Section 3(1)(a) provides for refusal of registration on the ground that the sign in question is generally incapable of distinguishing the goods or services of interest to the applicant from those of other undertakings: Case C-299/99 Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd [2003] RPC 2, p. 14 at paragraphs 37, 38. The Opponent no longer alleges that either of the present applications for registration is objectionable on that ground.

31. Section 3(1)(b) provides for refusal of registration on the ground that the sign in question lacks distinctiveness. There is no obligation when determining whether a sign is free of objection under section 3(1)(b), to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness: COMPANYLINE (above), paragraph 20. The focus of the relevant inquiry is indicated in paragraphs 40, 41 and 47 of the Judgment of the ECJ in Linde AG and others (above):

“40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court’s case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

...

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

32. Section 3(1)(c) provides for refusal of registration on the ground that the sign in question is simply descriptive. The focus of the relevant inquiry is indicated in paragraphs 63 and 73 to 75 of the Judgment of the ECJ in Linde AG and others (above):

“63. As regards the first limb of the second question, it must be observed that, according to Article 3(1)(c) of the Directive, descriptive trade marks, that is to say, those which consist exclusively of signs or indications which may serve, in trade, to designate the characteristics of the goods or services for which registration is sought, are not to be registered.

...

73. According to the Court’s case-law, Article 3(1)(c) of the Directive 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 applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, to that effect, *Windsurfing Chiemsee*, paragraph 25).

74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3), any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.

75. The competent authority called upon to apply Article 3(1)(c) of the Directive to such trade marks must determine, by reference to the goods or services for which registration is sought, in the light of a concrete consideration of all the relevant aspects of the application, and in particular the public interest referred to above, whether the ground for refusing registration in that provision applies to the case at hand. ...”

The objection is plainly applicable to signs and indications which consist only of wording “*which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought*” and which may therefore be viewed as a normal way of referring to the goods or services or of representing their essential

characteristics in common parlance: Case C-383/99P Procter & Gamble v. OHIM (BABY-DRY) [2001] ECR I-6251, paragraphs 39 and 42.

33. Section 3(1)(d) provides for refusal of registration on the ground that the sign in question is customary in the current language or in the bona fide and established practices of the trade to designate goods or services of the kind for which registration is requested, whether or not it actually describes the properties or characteristics of such goods or services: Case C-517/99 Merz & Krell GmbH & Co [2001] ECR I-6959. The Opponent no longer alleges that either of the present applications for registration is objectionable on that ground.

34. In support of the objections to registration under sections 3(1)(b) and 3(1)(c) it was submitted as follows: that it was open to anyone who wished to do so to set up a fund in memory of the late Diana Princess of Wales; that there was no need for any such fund to be formally established by way of a declaration of trust or for it to be charitable or (if charitable) registered under the Charities Act 1993; that the natural and obvious way of informing people of the affinities of any such fund would be to call it by the name DIANA PRINCESS OF WALES MEMORIAL FUND; and that goods or services marketed for the benefit of a fund called the DIANA PRINCESS OF WALES MEMORIAL FUND would naturally and obviously need to be marketed under and by reference to that name. The establishment of a DIANA PRINCESS OF WALES MEMORIAL FUND in New Zealand on 3rd September 1997 was said to substantiate these submissions.

35. It was further contended that the designation DIANA PRINCESS OF WALES MEMORIAL FUND did not differ distinctively from the shorter designation DIANA PRINCESS OF WALES which had already been refused registration for comparable goods and services in the unappealed decision reported at [2001] ETMR 254.

36. The Opponent's objections under sections 3(1)(b) and 3(1)(c) must initially be assessed in relation to Divisional Application 2143992B. This has proceeded to opposition on the basis that the designation DIANA PRINCESS OF WALES MEMORIAL FUND was adopted on 4th September 1997 (the priority date of the application) for use in the course of trade in the United Kingdom in relation to goods of the kind identified in paragraph 9 above, supplied by or under licence from the trustees of the Fund. It is necessary to consider whether the average consumer of such goods would, at that date, have attributed them to the same undertaking or economically-linked undertakings if they were marketed as DIANA PRINCESS OF WALES MEMORIAL FUND goods.

37. It has frequently been re-affirmed in the case law of the ECJ that in order for a trade mark to be able to fulfil its essential role in the system of undistorted competition which the EC Treaty seeks to establish "*it 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*": see, for example, Case C-206/01 Arsenal Football Club Plc v. Matthew Reed [2003] RPC 9, p.144 at paragraph 48. It follows that "*a sign must always be perceived unambiguously and in the same way so that the sign is guaranteed as an indication of origin*": Case C-273/00 Ralf Sieckmann v. Deutsches Patent-und Markenamt 12th December 2002, paragraph 53.

38. The argument on behalf of the Opponent is directed to the proposition that the designation DIANA PRINCESS OF WALES MEMORIAL FUND could not be said to have possessed the singularity of significance required for registration at the relevant date. People who approached it from the legal and linguistic perspective suggested by the Opponent could have taken it to be equally apt to identify any one of an expandable number of funds independently established in memory of the late Diana Princess of Wales. However, the question is whether it would have been approached from that perspective by the average consumer of the goods concerned.

39. That question must be answered as of 4th September 1997 from the standpoint of a consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect. It is clear that he or she would have linked the marketing of the relevant goods under the relevant designation to the activities of a benevolent institution established in memory of the late Diana Princess of Wales. I do not think it can be said that he or she would also have been aware of the controls applied by the Charities Acts 1992 and 1993 in relation to fund-raising activities and the naming of charities. Even so, I think it is likely that consumers of the relevant class would generally have taken the name to be that of a particular institution and in varying degrees believed, if they were not informed to the contrary, that the Princess's personal representatives and advisors were 'officially' connected with the activities of the memorial fund which carried her name. In coming to that view I bear in mind that in the regulations implementing section 6(2)(c) of the Charities Act 1993 Parliament has recognised that the words **PRINCESS** and **WALES** are particularly apt to be regarded as indicative of status in charitable contexts. I also give weight to the evidence on file which

indicates that members of the public and prospective licensees expected the Princess's personal representatives and advisors to be involved in the administration of an 'official' DIANA PRINCESS OF WALES MEMORIAL FUND. People seem to have treated it as self-evident that the Fund somehow 'represented' the recently deceased Princess.

40. Such perceptions cannot fairly be disregarded on the ground that they are unanalytical. Consumers would not normally engage in the process of analysis required to arrive at the conclusion that the wording of the designation is simply descriptive. The analysis would also appear to be largely superfluous in the light of the protection afforded to the names of charities as noted in paragraphs 12 to 15 above. It appears to me that when these factors are taken into account, there was sufficient singularity of significance in the designation DIANA PRINCESS OF WALES MEMORIAL FUND for it to satisfy the requirement for distinctiveness in relation to goods of the kind specified in Divisional Application 2143993B. The fact that the shorter designation DIANA PRINCESS OF WALES was regarded as insufficiently distinctive to be registrable as a trade mark for comparable goods does not detract from that conclusion. To hold otherwise would be to ignore the greater degree of individualisation achieved by integration of the words MEMORIAL FUND. In my view the average consumer would, at the relevant date, have attributed goods of the kind specified, to the same undertaking or economically-linked undertakings, if they were marketed as DIANA PRINCESS OF WALES MEMORIAL FUND goods. I do not think that would any the less have been the position if, as the Fund and the Executors appear to have contemplated, the goods were commemorative of the Princess or some aspect of her life or work.

41. The evidence on file shows that on 3rd September 1997 the Government of New Zealand announced the establishment of a charitable fund in memory of Diana Princess of Wales. The fund was called THE DIANA PRINCESS OF WALES MEMORIAL FUND. It was described as a partnership between the Government, TV One and the Bank of New Zealand. It appears to have been wound up by the end of 1999 (if not before).

42. There was an agreement in writing dated 22nd October 1999 between the trustees of the New Zealand fund and the trustees of the Fund established in the United Kingdom (acting with the concurrence of the Executors of the Princess's Will). The agreement confirmed that the trustees of the New Zealand fund had not used or authorised anyone else to use the name DIANA PRINCESS OF WALES MEMORIAL FUND outside New Zealand and would not do so during the period prior to it being wound up. It also contained an acknowledgment that subject to any rights that the New Zealand fund might have with regard to use of its name in New Zealand, the intellectual property and other rights in the name were owned by the Executors and the trustees of the Fund established in the United Kingdom.

43. The terms of the agreement are entirely consistent with the view that the designation DIANA PRINCESS OF WALES MEMORIAL FUND could not be used concurrently by undertakings operating independently of one another in the same territory without causing people to regard the activities of each as those of the other. It thus provides support for the view that the designation could not be regarded as simply descriptive in the hands of an undertaking that could properly maintain a claim to priority in relation to the use of it in a particular territory.

44. For the reasons I have given above, I consider that the designation DIANA PRINCESS OF WALES MEMORIAL FUND was sufficiently distinctive to be free of objection under sections 3(1)(b) and 3(1)(c) at the effective date of Divisional Application 2143992B. There is no reason why the designation should not be regarded as equally free of objection under sections 3(1)(b) and 3(1)(c) at the date (18th March 1998) on which it was put forward for registration in respect of the goods and services specified in Application 2161386. I therefore reject the Opponent's objections under section 3(1) in relation to both applications.

45. The Opponent's objections under section 3(6) of the Act are based on the provisions of section 32(3) which require an application for registration of a trade mark to contain a statement truthfully declaring, with reference to the specified goods or services, ***“that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used”***. It is said that the declarations made under section 32(3) in the present case could only have been true in relation to *“fund raising for charitable purposes”* in Class 36 because use of the designation DIANA PRINCESS OF WALES MEMORIAL FUND in the only manner then intended would not have related (or been taken to relate) to any other activity on the part of the Fund, the Executors or any licensee.

46. Section 32(3) refers to use of the kind that would defeat an application for revocation under sections 46(1)(a) or (b) of the Act i.e. genuine use of the trade mark in accordance with its essential function: Case C-40/01 Ansul BV v. Ajax Brandbeveiliging BV 11th March 2003, paragraphs 35 to 43. It therefore refers to use of the trade mark or an intention to use it in relation to goods and services of the kind specified, as an

indication that they “*have originated under the control of a single undertaking which is responsible for their quality*” (see paragraph 37 above). Origin is, for this purpose, defined by reference to the point of control over the quality of the goods and services supplied under the mark: Case G9/93 IHT Internationale Heiztechnik GmbH v. Ideal-Standard GmbH [1994] ECR I-2789, paragraphs 37, 38.

47. In the IHT case the ECJ held that surrender of control, on assignment of a trade mark to an assignee otherwise unconnected with the assignor, prevented attribution of the subsequent use of the trade mark to the assignor. It is questionable how far control can be surrendered to an otherwise unconnected licensee without risk to registration of the licensed trade mark: Scandecor Development AB v. Scandecor Marketing AB [2001] ETMR 74, p.800 (HL). Fortunately, the question does not arise for consideration in the present case. The evidence on file provides no basis for a finding that the trustees of the Fund or the Executors of the Princess’s Will ever intended to enter into any licensing arrangements that would surrender control over the use of the designation DIANA PRINCESS OF WALES MEMORIAL FUND to anyone else.

48. It would be surprising if the control exercised in relation to use of the designation by prospective licensees was not intended to involve selection by a process of acceptance and rejection based on appraisal of the goods or services they proposed to market under licence. The evidence filed on behalf of the Fund and the Executors suggests that there was to be control of that kind. It also indicates that they intended to engage in licensing of the designation for the purposes of charitable fund raising with due regard for the standards of control promoted by the Charities Act 1992 and the Charitable Institutions (Fund Raising) Regulations 1994: see the pro forma letter in Exhibit PP2 to Miss

Parekh's Statutory Declaration. In the absence of evidence to the contrary I will infer that the designation was intended to be used in the marketing of licensed goods and services of a character and quality assessed as suitable by the Fund and the Executors.

49. With regard to the manner in which the designation was intended to be used, the Opponent's contentions raise issues of fact which do not appear to be capable of resolution in its favour on the basis of the evidence before me.

50. A sign can be used without performing the functions of a trade mark in relation to the means or method by which it has been brought to the attention of the public: Case T-195/00 Travelex Global and Financial Services Ltd v. Commission 10th April 2003, paragraphs 62, 63, 74 and 91 to 104 (promotional hats and scarves).

51. When assessing whether any particular use of a designation in the marketing of goods or services amounts to the use of it as a trade mark in relation to those goods or services, it is necessary to consider whether the presentation is such as to create the impression that there is a material link in the course of trade between the goods or services concerned and the undertaking whose activities the designation is apt to identify: Arsenal Football Club (above), paragraph 56. With reference to what is it being used; and is it, with reference to that, being used distinctively? Again, the relevant perspective is that of the average consumer.

52. The evidence on file contains relatively few examples of promotional material showing use of the designation DIANA PRINCESS OF WALES MEMORIAL FUND in connection with the marketing of licensed merchandise. I can see that these show use of the designation in a manner that may be said with varying degrees of conviction to relate

only to “*fund raising for charitable purposes*” in furtherance of which the licensed goods were being marketed. What I cannot see is any reason to treat these examples as exhaustive of the intentions of the Fund or the Executors with regard to the manner in which the designation would be used in relation to goods and services of the kind specified in their applications for registration.

53. The Opponent relies heavily on the evidence given by Mr. Dobson in which he repeatedly characterises the designation DIANA PRINCESS OF WALES MEMORIAL FUND as a means of enabling consumers to recognise that a proportion of the purchase price of the licensed goods and services would go to the Fund. However, I do not think this evidence will bear the weight that the Opponent wishes to place upon it. There is no necessary or inevitable inconsistency between communication of the information which Mr. Dobson identifies in his evidence and use of the designation in a manner that would leave people with the impression that it indicates that the licensed goods and services “*have been manufactured or supplied under the control of a single undertaking which is responsible for their quality*”.

54. There are, in truth, two ways in which the designation DIANA PRINCESS OF WALES MEMORIAL FUND could be used: in a manner that would be taken to indicate the existence of a purely financial connection with the undertaking thus identified; or in a manner that would be taken to indicate the existence of a producer/supplier connection with the undertaking thus identified. The Opponent is not prepared to accept that use of the second kind was ever intended. However, scepticism as to what the Fund and the Executors might or might not have intended does not, of itself, demonstrate that they never intended the designation to be used in the second of the two ways I have

mentioned. The evidence filed on behalf of the Fund and the Executors is, in this respect, short on content. I am left in the position of being unable to say on the basis of the materials before me whether the Opponent is or is not correct in its assertion that the designation was only intended to be used in connection with the marketing of goods and services in the first of the two ways I have mentioned. That being so, I must hold that the Opponent's allegation of misrepresentation in the declarations made under section 32(3) is not made out. The objections under section 3(6) therefore stand rejected in accordance with the rebuttable, but in the present case unrebutted, presumption that the declarations were duly and properly made: see Halsbury's Laws of England 4th Edn, Vol.17(1) (2002 re-issue), paragraph 579.

55. For the reasons I have given above, the appeal is dismissed. I direct the appellant to pay £950 by way of contribution to the respondent's costs of the appeal within 21 days of the date of this decision. That sum is payable in addition to the sum awarded in respect of the proceedings below.

Geoffrey Hobbs Q.C.
1st May 2003

Bruce Marsh of Messrs Wilson Gunn McCaw appeared on behalf of the respondent.

Richard Miller Q.C. instructed by Messrs Dechert appeared as counsel on behalf of the appellant.

The Registrar was not represented at the hearing of the appeal.