

TRADE MARKS ACT 1994

IN THE MATTER OF an Application to register the words Diana, Princess of Wales as a trade mark

Background

1. On 29 March 1999, the Hon.Mrs Frances Shand Kydd and the Lady Sarah McCorquodale, the executrices of the Estate of Diana, Princess of Wales, applied under the Trade Marks Act 1994 for the registration of the words DIANA, PRINCESS OF WALES as a trade mark.

2. The application covers a wide range of goods and services in classes 3, 4, 9, 12, 14, 16, 18, 20,21, 24, 25, 26, 27, 28, 30, 31, 36, 41 & 42. The specification is set out in annex A.

3. The application met with objections from the Registrar's Examiner under Section 3(1)(b) and 5(2) of the Act.

4. The applicants asked to be heard and the matter came before me on 9 March 2000 when the applicants were represented by Mr Platt-Mills QC. One of the remaining section 5 objections was waived at the hearing on production of evidence that the applicants had taken assignment of an earlier Community Trade Mark consisting of the words , 'Diana, Princess of Wales' , previously in the name of a Dutch company. The remaining section 5 objection can also be disregarded because earlier UK application number 2144487, in the name of Jitendra Premji Vekaria for the mark 'Princess Diana', has since been refused. That decision is not subject to appeal. Consequently, the earlier UK application cannot now constitute an 'earlier trade mark'. I do not, therefore, need to say anything more about the section 5 objections. The section 3 objection was maintained following the hearing and this application refused. I have since been asked to give my reasons in writing, which I now do.

The Law

5. Sections 1(1) and 3(1) of the Act are set out below:-

1(1) In this Act a trade mark means any sign which is capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

6. Section 3(1) of the Act is as follows:-

The following shall not be registered -

- a) signs which do not satisfy the requirements of Section 1(1),
- b) trade marks which are devoid of any distinctive character,
- c)
- d)

Provided that a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

7. In order to get to the real question to be answered in this case one must first clear away two red herrings. The first is that whilst she was alive Diana, Princess of Wales owned her name and therefore had an exclusive and unqualified right to the use of it for commercial purposes. No such 'personality right' exists under UK law. Laddie J. makes this clear in the following extract from his decision in the ELVIS PRESLEY trade mark case, *1997 RPC 543 at 547-548 lines 40-52 and 1-3* respectively (the Elvis case) :

“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 (Elvis Presley) Enterprises can have no greater rights.

Similarly, Elvis Presley did not own his appearance. For example, during his life he could not prevent a fan from having a tattoo put on his chest or a drawing on his car which looked like the musician simply on the basis that it was his appearance which was depicted. For the same reason under our law, Enterprises does not own the likeness of Elvis Presley. No doubt it can prevent the reproduction of the drawings and photographs of him in which it owns copyright, but it has no right to prevent the reproduction or exploitation of any of the myriad of photographs, including press photographs, and drawings in which it does not own the copyright simply by reason of the fact that they contain or depict a likeness of Elvis Presley. Nor could it complain if a fan commissioned a sculptor to create a life-size statue of the musician in a characteristic pose and then erected it in his garden. It can only complain if the reproduction or use of the likeness results in the infringement of some recognised legal right which it does own.”

8. The second red herring is that a name which is unique to a particular person must by definition have distinctive character as a trade mark. This is not necessarily so. For as Laddie J. explained in *Elvis* :-

“The distinctiveness addressed by the Act is not a quality of the mark which exists in a vacuum. It is a particular type of distinctiveness, namely the ability to distinguish the proprietor’s goods from the same or similar goods marketed by someone else. The more a proposed mark alludes to the character, quality or non-origin attributes of the goods on which it is used or proposed to be used, the lower its inherent distinctiveness.”

9. Personal names do not usually allude to non-origin attributes of the goods or services. Indeed most personal names are readily taken as denoting the trade source of the goods, eg “Laura Ashley”, “Harry Ramsden” and “Dorothy Perkins.” However, where a famous name is concerned (other than names which are famous as indicators of trade source, as in these examples) there is the possibility that the name will serve to signify not the trade source of the goods/services but merely the subject matter. The *Elvis* case is an example of this.

10. The *Elvis* case subsequently went to the Court of Appeal (1999 RPC 567) where Laddie J.'s decision was upheld. Robert Walker L.J. explained the final step in the reasoning that resulted in the refusal of the application to register the Elvis marks when he said (at page 585, lines 17-26):-

“In my judgement the judge was right to conclude that the ELVIS mark has very little inherent distinctiveness. That conclusion was reached by a number of intermediate steps, one of which was the judge’s finding that members of the public purchase Elvis Presley merchandise not because it comes from a particular source, but because it carries the name or image of Elvis Presley. Indeed the judge came close to finding (although he did not in terms find) that for the sort of goods advertised by Elvisly Yours (or by Enterprises in the United States) the commemoration of Elvis Presley is the product, and the article on which the name or image appears (whether a poster, a pennant, a mug or a piece of soap) is little more than a vehicle.”

11. Of course, the *Elvis* case was decided under the previous 1938 Act. This has now been replaced with the 1994 Act that has completely different origins coming from a European Harmonisation Directive. Nevertheless, it is clear that the ability to distinguish the goods or services of one undertaking from those of other undertakings remains the essential function of a trade mark. In *Canon v MGM 1999 ETMR 1* at para 28 on page 8, the European Court of Justice confirmed that:

“.....according to the settled case-law of the Court, the essential function of a trade mark is to guarantee the identity of the origin of the marked products to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality...”

12. The words “devoid of any distinctive character” in section 3(1)(b) of the Act must be interpreted against this background. As Jacob J. in *TREAT* (1996 RPC 281 @ 306) and Walker L.J. in *Procter and Gamble’s Application* 1999 ETMR 375 @ 382 indicated, a trade mark which cannot readily serve its essential function is devoid of any distinctive character.

13. In this connection it should be noted that the function of a trade mark is to “*guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality...*”. Accordingly, the use of a famous name for product endorsement purposes is not trade mark use unless the proprietor of the “mark” takes responsibility for the quality of the goods/services to which it is applied.

14. Mr Platt-Mills accepted that the *Elvis* case was still relevant “*at least to a degree*” because it represented the likely approach of the courts under the new law. He sought to distinguish the current application from the *Elvis* case on its facts. There is undoubtedly a wide demand for goods which commemorate the life of the late Diana, Princess of Wales. Mr Platt-Mills sought to persuade me that the evidence shows that the public want goods/services bearing the mark DIANA, PRINCESS OF WALES, not merely to commemorate the late Princess, but because they come from a particular source. This leads me to the evidence submitted on behalf of the applicants.

The Evidence

15. The applicants filed a statutory declaration dated 6 January 2000 by Andrew Charles Dobson, who is a solicitor with Lawrence Graham who act for the applicants. Mr Dobson sets out the events leading up to the application, many of which are well known. The main points are that:

1. As a member of the Royal Family the late Diana, Princess of Wales supported over 100 charities;
2. The title “Diana, Princess of Wales” was adopted for the first time in 1996 after the divorce from HRH Prince Charles (prior to this her official title was HRH, the Princess of Wales);

3. Even after her divorce, the Princess remained an official member of the Royal Family;
4. After 1996 the Princess used her name to promote her 6 favourite charities, although she also worked with 2 other charities, including her well publicised work with the Landmine Survivors Network;
5. The Princess was sensitive to ensure that commercial sponsors did not benefit from association with her name;
6. With one exception, during her lifetime, the Princess did not go out specifically to link her name with any product whether for commercial or charitable gain;
7. The exception was that, in April 1997, she allowed one of her charities (the British Lung Foundation) to name a rose after her for the benefit of the charity;
8. Following her death in August 1997 there was a great outpouring of public grief and Diana, Princess of Wales became one of the great icons of the 20th Century - this meant that her name could sell products and any link which showed that her Estate or Memorial Fund approved such products was a powerful marketing tool;
9. It is said that it was after her death that her name became associated with the source of the products bearing it, rather than merely descriptive or commemorative of her;
10. Shortly after her death a Memorial Fund was established which was subsequently granted a licence to the Estate's intellectual property rights with a view to the Fund sub-licensing the rights to raise money for charity.

16. Mr Dobson says that, following the Princess's death, hundreds of applications were received by the Fund or the Estate to use the Princess's name and/or image for a percentage of revenue or profits. Some of these were from large reputable organisations such as 21st Century Entertainment and Cerruti. Mr Dobson says that it is "*inconceivable that their belief in the Applicant's trade mark rights stemmed only from the Applicants' assertions to have such rights.*" Rather, he argues that the title DIANA, PRINCESS OF WALES has the quality and character of a trade mark and was recognised as such by traders and the public in 1997 and continuing to date.

17. Mr Dobson goes on to provide details of the authorisations given and licenced products. In April 1998 the Memorial Fund put their name with the signature of Diana, Princess of Wales upon

Flora margarine products. This amounted to a “thank you” from the Fund to Flora for sponsoring 500 Memorial Fund runners in the London Marathon. This is reflected in a copy of the packaging included in exhibit ACD1 to Mr Dobson’s declaration.

18. Mr Dobson says that the Estate approved a tribute CD sold on a world wide basis in December 1997. The Estate subsequently granted a licence to the Fund in respect of this product. A copy of the licence is set out in exhibit ACD1. The subject matter of the licence was four pending trade mark applications, three of which were for the name DIANA, PRINCESS OF WALES; the other was for fifty two images of the late Princess. The licence also covered “publicity rights”. At least three of the trade mark applications were subsequently withdrawn or refused. The album cover includes the words DIANA, PRINCESS OF WALES in plain letters (together with a picture of her) and the word TRIBUTE. This is self evidently purely descriptive use. The Memorial Fund is mentioned elsewhere on the sleeve.

19. Mr Dobson explains that, prior to entering into the licence, the Estate allowed the Fund to approve some of the huge number of proposals put to it. A list of 39 products and 72 events is provided. Most of the products are printed matter such as cards, calendars, books and reproduction prints. Most of the events appear to be of a fundraising nature. This use was not the subject of formal licences whereby the licensor took responsibility for the quality of the goods/services provided. Further, it is not possible to tell from this list exactly what was approved or why the parties concerned were seeking approval.

20. Exhibit ACD1 also includes a copy of a sub-licence between the Fund and the Royal Mail dated 3 February 1998. The subject matter of the licence includes the name “Diana, Princess of Wales.” The licence was issued in connection with a commemorative stamp and a number of related products such as specialised postmarks. Illustrations of the stamps are included within the exhibit. Although the stamps depict various pictures of the late Princess, they do not include the words DIANA, PRINCESS OF WALES. The postmarks do include these words but the extent of use on these goods is not clear. In any event the use of the name is clearly descriptive of the subject matter of these commemorative goods. There is nothing to suggest that it would be taken as indicative of the source of the goods, except to the extent that the public would associate any

postmark with the Royal Mail.

21. The Fund also issued a sub-licence to Halcyon Days which permitted use of the mark in respect of commemorative enamel boxes. The mark is said to have appeared in a press release and also on the boxes themselves. A copy of the press release is included in the exhibit ACD1. The Princess' name appears in the press release followed by the year of her birth and death. The press release also states:-

“Each box will bear the official logo of the Diana, Princess of Wales Memorial Fund and also the hallmark of her Estate.”

It appears to me that the name is being used to describe the subject of the commemorative article. It is the official logo and hallmark which connects the goods to the Fund and Estate.

22. Mr Dobson says that the Estate approved a “Beanie Baby” product in the first half of 1998. A copy of the swing ticket is included within exhibit ACD1. Again it appears to be the official signature logo and the Estate's hallmark which are used to identify the connection with the Estate rather than the name “Diana, Princess of Wales” per se.

23. The same can be said of the use of the title “Diana, Princess of Wales” in respect of Lochcarron memorial tartan. Mr Dobson says that Lochcarron entered into an agreement with the Fund in August 1998 to produce a range of tartan products. But it appears from the promotional material in exhibit ACD1 that it is the hallmark of the Estate and the official signature logo that are again relied upon to signal a connection with the Fund and the Estate.

24. There is also some evidence of a sub-licence being granted to Stuart Crystal in November 1997 for the production of a glass candle holder. The subject matter of the licence appears to have included the name “Diana, Princess of Wales” as well as “Diana, Princess of Wales Memorial Fund.” It is not clear whether one or other (or either) was used.

25. A company called Peter J Smith launched a lily for sale to the public under the title “Diana,

Princess of Wales” with the consent of the lawyers of the Fund. It appears from a copy of a letter dated 19 February 1998 within Exhibit ACD1, that this was the name given to the variety by the company and registered in its name by Plant Breeders’ Rights in the UK and elsewhere. The company wished to donate the proceeds to the Fund. I do not believe that I can draw the conclusion from this that the words “Diana, Princess of Wales” per se have been used to indicate that these goods are under the control of the Estate or the Fund.

26. There is further evidence of a £5 commemorative coin being produced by the Royal Mint but this is after the date of the application and therefore irrelevant.

27. The applicants filed a statutory declaration dated 11 January 2000 by Purvi Parekh who is a solicitor in the firm of Mishcon de Reya who represented the Princess of Wales for a period of several years and continued to act for her Estate until November 1997. Purvi Parekh dealt with enquiries about the Princess. The main points which emerge from Purvi Parekh’s evidence are that:

1. Following the death of the Princess there was an enormous demand for items associated with the Princess and/or her name or image and which could properly be represented as having that association;
2. In the main the enquiries were proposals for product endorsement by the Princess’ family or the Fund;
3. This included a request from the Managing Director of 21st Century Entertainment who wrote seeking permission to use the official logo of the Diana, Princess of Wales Memorial Fund on a screensaver product.

28. Exhibit PP1 to Purvi Parekh’s declaration consists of copies of letters from numerous organisations in the months following the Princess’ death. The common factor amongst these requests appears to have been the desire to contribute some of the proceeds of commercial activity to the Fund or charities perceived as being supported by the Princess. Some of the requests originated from other countries. Some appear to have wanted to commercially exploit particular images of the Princess or text that she had written, which may have been protected by copyright.

Others (including “Cerruti”, the other organisation mentioned by Mr Dobson) expressed a wish to use the logo of the fund.

The Survey

29. The applicants conducted a public survey in order to support their application. The survey is described in four statutory declarations by Merrill Vivienne April, Gail Pauquest, Joshua Levine and John Joseph Madden.

30. The survey was conducted by Research Support & Market. Mr Madden is a Partner in that firm and he describes the method and conduct of the survey in his declaration, which also includes a summary of the outcome. The survey was conducted in two stages. The first stage took place in February 1999 around a month before the application was made. The second stage took place in June 1999 some three months after the date of application. I don’t believe anything turns on that. The first stage of the survey was conducted amongst the staff and in the offices of five firms of accountants, bankers and solicitors based in London, Bristol, Manchester and Glasgow. The second stage was conducted at four housing estates in London. The second stage was necessary because the first stage did not produce a sufficiently representative sample of the population.

31. Interviewers were told not to reveal the purpose of the survey. Each person interviewed was handed a rectangular label upon which was printed the words DIANA, PRINCESS OF WALES. They were then asked “*If you saw this label on a product who would you expect to receive some or all of the proceeds of the sale?*” Interviewers were asked to code responses on the following list of answers:-

1. Product manufacturer;
2. Sales company;
3. Estate/Memorial Fund/Diana Charity
4. Other charity
5. Other (write in)

32. If respondents replied “Estate/Memorial Fund/Diana Charity” interviewers were instructed to identify the specific response given by circling or underlining, and to note any verbatim responses given in addition to the coded response. A supplementary question was then asked of all respondents “*Why do you say this?*”. Respondents were also asked “*Would your answer differ if you saw the label on a book or a video?*”.

33. Mr Madden states that 47% of those interviewed said, in answer to the first question, that they would expect the Memorial Fund (45%) or the Estate (2%) to receive some or all the proceeds of the sale. A further 16% of respondents who did not initially mention the Fund or Estate mentioned them when asked to explain their initial answer. From this it is said that “*63% of respondents would purchase goods marked “Diana, Princess of Wales” in the belief that the goods are authorised or sanctioned by the Memorial Fund or the Estate, or in the expectation that the Memorial Fund or Estate would or should be authorising such goods.*”

34. In response to the question “*Why do you say this?*”, (which was put to all respondents who answered the first question) the most popular answer (239 or 29% of total sample) was that the name was associated with charity. 151 (out of 828 respondents in all - 18%) said that the name was associated with the Trust/Memorial Fund. A similar number - 149 respondents - said that they thought the name was licensed/owned/copyrighted by the Fund or cited publicity/media/press as their reason for mentioning the Estate/Fund. 47 of the respondents who mentioned the Estate/Fund in their first answer explained their answer by saying that they were sceptical or suspicious about where the money goes. A further 59 explained their answer by saying that it was the right thing/fair that money goes to the Fund. A further 37 explained their answer by saying that this was the reason why the Fund was established.

35. When asked whether their answer would be different if the product were a book or a video, 72% of those that mentioned the Estate/Fund in their earlier answers said that it would make no difference.

36. The applicants filed nine statutory declarations from respondents included in the survey intended to provide a greater insight into the reasons for their answers. All nine give evidence

which appears to place them into the category of persons who would definitely expect the proceeds of the sale of products bearing the Princess' name to go to the Fund. I have been provided with no explanation of how these people were chosen so I can only guess at the extent to which they are representative of others who mentioned the Fund/Estate. Nor have I been told what further questions were put to them although I note their evidence follows a similar format suggesting that they were replying to the same questions. All those that gave evidence came from the second stage of the survey. They are not typical of those included in that stage. Only 132 (32%) of those involved in the second stage (of 403 respondents) conducted as a street survey, mentioned the Fund or Estate at all in their first answer, whereas 7 of the 9 declarants did so (the other 2 mentioned "Diana Charity").

37. The applicants' evidence also includes a statutory declaration dated 3 December 1999 by Joan Kavanagh Gwillim, who is another solicitor in the firm of Lawrence Graham. Ms Gwillim gives evidence that a Trading Standards Officer seized calendars and a photograph book relating to the late Princess of Wales in the belief that her name was a trade mark or that there may have been an offence under the Trade Marks Act 1994 or the Trade Descriptions Act 1968. The Princess' name and appearance was not a registered trade mark at this time so there could not have been an offence under the Trade Marks Act. The Trading Standards Officer concerned wrote to the Fund stating that:

"The authority believes that the presentation and lay out of the book, and the lack of any disclaimer, such as "unofficial", would indicate to a potential purchaser, that the book was produced, on behalf of or with the approval of the Estate or family of the Princess of Wales."

The products were not authorised. There is no indication that a prosecution followed.

The Prima Facie Case for Registration

38. I indicated earlier that the distinctive character of the words DIANA, PRINCESS OF WALES depended upon whether, at the date of application, those words had the ability to "guarantee that

all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality...”. An analogous point arose in a case before the Court of Appeal in *Bach Flower Remedies* 2000 RPC page 513. The court had to decide whether the public regarded “Bach Flower Remedies” as identifying the trade source of herbal remedies at the date of a trade mark registration. As in this case, there was a suggestion that some members of the public did attach a trade source significance to the words. Others regarded the words as describing a type of herbal remedy. The court adopted the ‘average consumer’ test developed by the European Court of Justice and applied to a trade mark case most recently in *Lloyd Schuhfabrik Meyer v Klijsen Handel BV* 1999 RPC 690. According to the case law of the court the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. I intend to apply the same test to the *prima facie* case for registration, that is the case based simply upon the message sent to the average consumer by the words alone, leaving aside the effect of any use of the words by the applicants as a trade mark prior to the date of the application for registration.

39. The applicants accept that (with the possible exception of a rose) there was no use of the name as a trade mark for goods whilst the Princess was alive. Indeed they say that whilst she was alive she took care to ensure that her name was not used for commercial purposes. The average consumer would be aware of this and that it would be unusual for any member of the Royal Family to use their name/title as a trade mark for commercial purposes.

40. There cannot be any doubt that the late Diana, Princess of Wales was one of the most famous people in the world. I believe that I am entitled to take notice of this and that the name and face of Diana, Princess of Wales has, since her marriage to Prince Charles in 1981, continuously featured on the covers of countless magazines, books and in TV programmes. She was probably one of the most photographed people in the world. None of this use indicated any trade connection between the source of these goods/services and the Princess. The average consumer would be aware of this and that there has long been a trade in this country in souvenirs and mementoes featuring members of the Royal Family without any significance as to the trade source of the goods. Laddie J. made specific observations about this in the *Elvis* case when he said:

“When a fan buys a poster or a cup bearing an image of his star, he is buying a likeness, not a product from a particular source. Similarly the purchaser of any one of the myriad of cheap souvenirs of the royal wedding bearing pictures of Prince Charles and Diana, Princess of Wales, wants mementoes with their likeness. He is likely to be indifferent as to the source. Of course it is possible that, as a result of the peculiarities of the way goods are marketed or advertised, an inference of association with a particular trader may be possible to draw. This may be the case when the proprietor’s products bear the word “Official”. But that does not mean that absent that word members of the public would draw any such inference.”

41. The applicants’ case is that (again with the possible exception of roses) the words DIANA, PRINCESS OF WALES became a trade mark for goods only after her death. The question about roses arises because the Princess agreed to have a rose named after her for the benefit of the British Lung Foundation. There is no evidence as to the extent of any use of the Princess’ name in this context. Without more it is impossible to say whether this was trade mark use. Even if it was it would appear to have been use for the purpose of charitable fundraising by the British Lung Foundation rather than by the Princess on her own account in respect of a trade in roses.

42. The matter must be judged as at the date of application. It is clear from the *Bach Flower Remedies* case that the distinctive character of words can be increased or reduced by the way the words have been used prior to the date of application. Against the background set out above it seems most unlikely that the average consumer would have attached any trade mark significance to the Princess’ name appearing on commemorative products at the date of the application, when it had no such significance in respect of mementos, souvenirs, printed matter etc sold when she was alive.

43. Mr Platt-Mills submitted that the change of significance came about because of the establishment of the Memorial Fund and the public’s desire to support it through the purchase of authorised goods/services. The evidence is intended to support the conclusion that, after her death, any products bearing the Princess’ title would be expected to be authorised by the Fund.

44. The applicants' principal evidence appears to be the public survey. I have a number of criticisms of this survey, some of which relate to the method of conducting the survey, others relate to the suggested interpretation of the data produced. My principal criticism relates to the first question put to respondents, "*If you saw this label on a product who would you expect to receive some or all of the proceeds of the sale?*" It appears to me that the question is inviting the respondents to guess at the answer. That is a hazard which is almost unavoidable in conducting a survey. In this case, I make only mild criticism of the question put to respondents on that basis. More importantly, the use of the words "*receive some or all the proceeds of the sale*" provides an unmistakable clue as to the desired answer. These words are sufficient, in my view, to confirm that the "correct" answer is not the product manufacturer. Rather, this combination of words appears calculated to trigger a mental association with charitable fundraising. The public are used to seeing goods offered for sale on the footing that some or all of "the proceeds" will go to charity. By contrast, it would be most unusual for goods to be offered for sale on the footing that some or all the proceeds of the sale will go to the manufacturer or sales company. That is implicit in the absence of a statement to the contrary. The clue is unlikely to be missed in circumstances where the sign simultaneously placed before respondents is the title of a person widely associated with charitable causes.

45. Consistent with these observations, 87% of respondents mentioned charity in their first response. 45% mentioned the Memorial Fund (this figure reduces to 40% when weighted to reflect the UK population). 17% of these respondents provided a second answer. Even allowing for multiple answers, only 8% mentioned the product manufacturer or the sales company. It is difficult to believe that only 8% of the public would expect the maker of a product to get even some of the proceeds of its sale. In my view, these answers are consistent with my earlier observation that the wording of the question prompted respondents to think about the charities associated with the late Princess of Wales.

46. Further, the question tests the public's reaction to the use of the words "Diana, Princess of Wales" on a rectangular label. One wonders why it was thought necessary to pose the enquiry on the footing that the words appeared on a rectangular label for a product when the mark applied for consists of the words per se, and there is no evidence that the name has been used in this

manner on any of the goods identified in the applicants' evidence. It may be a small point, but it seems to me that the public's reaction to the use of a name on a label attached to a product (a traditional carrier of information about the source of the goods) may be different to their reaction to the name used on the product itself, particularly where the name is descriptive of the product (such as the tribute CD and other commemorative articles mentioned above)

47. The survey produced a wide range of answers. Many people seemed to have understood that they were being asked whether some or all of the proceeds of sales of goods bearing the name DIANA, PRINCESS OF WALES should go to charity. Not surprisingly, a majority did. Some (it is impossible to estimate the number) almost certainly mentioned the Estate/Fund because it was the best known charitable organisation connected with the Princess at the time of the survey. Some gave explanations for their first answer (eg sceptical where the money goes) which suggest that their first response was not representative of their real belief. A minority do appear to have expected goods bearing the Princess' name to be connected with the Estate/Fund simply because of her name. In view of the way the matter was approached it is impossible to be sure of the size of this minority.

48. The applicants filed a copy of the Will of the late Diana, Princess of Wales. The Executors applied to the High Court in December 1997 for the Will to be varied. The court granted an order creating a discretionary trust over the intellectual property rights giving the Estate the flexibility to license its rights and putative rights to third parties. A copy of the Order varying the Will is included in exhibit ACD1 to Mr Dobson's evidence.

49. There was considerable media coverage of the amendment of the Will of the late Princess of Wales. This focussed on the passing of any intellectual property rights in her name, image and artistic works to her Estate. The wording of the Will cannot have created any new intellectual property rights. At the hearing, I asked Mr Platt-Mills what relevant intellectual property rights the Princess owned at the time of her death. He said that, in the UK, she might have owned a goodwill under her name in respect of charitable services. In other jurisdictions that grant publicity rights she may have enjoyed such a right. I mention this because a significant number of the respondents in the survey who said that they believed some or all of the proceeds of the sale of

products bearing the Princess' name would go to the Estate/Fund said that they believed this to be so because the Estate/Fund "owned the name" or because of things they had heard or read about in the media (which may or may not be a reference to the same belief). The media coverage seems to have overlooked the distinction between the Estate owning any intellectual property rights that may exist in the Princess' name and image, and the Estate owning the Princess' name and image. This seems to have created the impression amongst a significant number of respondents that the Princess had a general property right in the UK in her name and image which, on her death, passed to her Estate. The average consumer is deemed to be reasonably well informed and circumspect. I do not believe that it would be right to attribute views to the average consumer which are based upon the erroneous belief that the Princess enjoyed a pre-existing property right in her name and image which passed to her Estate and entitles them (without the benefit of a trade mark registration) to the exclusive use thereof in respect of any products. To the extent that the average consumer has been misled by inaccurate media coverage or the public statements of the applicants' representatives, I think it right to disregard it.

50. There is a further problem with the survey evidence. Even if the average consumer would expect a trader offering memorabilia bearing the Princess' name to make a charitable donation to the Memorial Fund, that is not necessarily the same thing as saying that the average consumer perceives the name of the Princess as serving the function of a trade mark for the goods in question. The name would only be serving the function of a trade mark if its use signifies that the Memorial Fund controls all the goods offered under the name and is responsible for their quality. The survey provides no indication that the average consumer expects the Estate or the Memorial Fund to control use of the name in a relevant sense. The principal question in the survey is therefore not only leading but irrelevant to the question of whether the name is perceived as a trade mark. It may well be that the public has views about the sort of goods that the Princess' name should be associated with, but that appears more to do with matters of good taste than the quality of the goods themselves.

51. The applicants rely upon the letter from the Trading Standards Officer who apparently seized a "Princess Diana" calendar and photograph book in the belief that, in the absence of an "official" disclaimer they were liable to be mistaken for "authorised" merchandise. This is said to be

evidence of the public's expectations. The inference to be drawn from the absence of an "official" disclaimer has arisen in at least two other recent cases before the High Court. One is the *Elvis* case mentioned above; the other was a passing off case, *Halliwell and Others v Panini and Others* (6 June 1997- unreported). The latter case concerned an application for an injunction to prevent an unauthorised trader selling "Spice Girls" sticker collections. In both cases the judge rejected arguments that the absence of the word "unofficial" was sufficient to influence the public's perception of the origin of the goods. Refusing the claimants an injunction Lightman J. said:

"I shall only say that I am far from satisfied that the absence of any disavowal of authorisation by the plaintiffs can reasonably lead members of the public to the defendants' product on the basis or in the belief that it was authorised by the plaintiffs. It is to be noted that in a number of their products the plaintiffs state their own products to be official, indicating by that as it seems to me, that that is not something which is necessarily implicit."

Of course every case turns on its own facts. I have already noted that a number of the goods the Fund has endorsed bear the official logo and hallmark of the Fund and Estate. To that extent there is some similarity with the *Panini* case. At the very least, these cases indicate that a cautious approach is appropriate and it is not safe to infer simply from the absence of a disclaimer that the public will regard merchandise as "official."

52. The remainder of the applicants' evidence merely confirms that in the aftermath of the Princess' death numerous people and organisations wished to produce memorabilia or simply conduct fundraising events with the approval of the Memorial Fund who would no doubt be identified as the beneficiary of their commercial or charitable activity and thereby increase sales/income. Many of these, including the "two large reputable organisations" cited by Mr Dobson - 21st Century Entertainment and Cerruti - actually sought permission to use the official logo of the Fund not the Princess' name per se. I refuse to draw the suggested inference that these requests are evidence that, at the relevant date, the average consumer of the goods/services listed in the application expected all products bearing the Princess' name to originate under the control of a single undertaking which was responsible for their quality.

53. The application covers a very wide range of goods, most of which are immediately recognisable as the sort of goods commonly used as memorabilia (such as badges, candles, gold and silverware and calendars). The Princess' name would be completely descriptive of some of the other goods listed (such as figurines, posters, photographs and video recordings). Others are less recognisable as commemorative articles (eg radios and pushchairs). At the hearing I invited Mr Platt-Mills to distinguish the goods in respect of which the applicants felt they had their best case for registration from those where the case was more arguable. Although he accepted that there were shades of different strength within the applicants' case for registration, he declined to draw any sharp distinctions between the various categories of goods insisting that the mark was registrable for all the goods (and services) listed.

54. This is consistent with the applicants' evidence from which it is clear that the purpose of this application is to allow the applicants to control the trade in memorabilia/commemorative articles bearing the Princess' name. I infer from this that the applicants consider that all the goods/services listed in the application have the potential for exploitation in this manner. I therefore intend to regard all the goods as being commemorative articles.

55. In the light of the use made of the Princess' name whilst she was alive - which could not have been further from a trade mark for products - I do not believe that, at the date of application, the average consumer who was reasonably well informed and circumspect, would have expected all commemorative articles bearing the Princess' name to be commercialised under the control of a single undertaking. The applicants' evidence confirms what one would in any event have suspected, that the average consumer would like some or all of the proceeds of the sale of products bearing the Princess' name to go to charity. It does not establish that the mere appearance of the Princess' name is sufficient to guarantee to the average consumer that all such commemorative products are commercialised under the control of a single undertaking which is responsible for their quality. The fact that the Estate has, in practice, seen it necessary to use other signs (ie the official logo and hallmark) to signify "official" authorisation rather suggests that the applicants themselves were not confident that the Princess' name per se was capable of guaranteeing their connection in trade with the goods. I conclude that, at the relevant date, the name lacked the necessary trade mark character for the goods listed in the application.

56. The application also covers a range of services in classes 36, 41 and 42. I shall return to the Class 36 services in a moment. The services in classes 41 and 42 cover such things as health club services, nursery schools, beauty salons, cafes, hotels, healthcare, hospitals and retirement homes. The plain intention is to prevent others from using the Princess' name in connection with any of these services without the consent of the Estate.

57. The survey made no attempt to probe the views of the public on the question of services. Whilst it is possible to understand why the applicants wish to control use of the name of the Princess in respect of these services, for the reasons I have already given, this can only be achieved under the Trade Marks Act to the extent that the name of the Princess has the capacity to function as a trade mark for these services. Leaving aside any other legal claim to the name, it seems most unlikely that the Princess' name could, at the date of application, have served to guarantee to the average consumer that the services concerned were provided under the control of the Estate. For example, there is evidence that the Estate has allowed the Birmingham Children's Hospital to re-name itself after the Princess. It is inconceivable that anyone receiving poor treatment at the hospital would hold the Estate in any way responsible for the quality of the service they received. This use of the name would not signal the necessary connection with the applicants for it to be perceived as their trade mark for these services. In my view the same can be said of the other services listed in classes 41 and 42.

58. The services in class 36 are charitable fundraising. Mr Platt-Mills suggested that the Princess built up a goodwill under her name in respect of these services whilst she was alive. It might be said that, if it proves anything, the survey evidence confirms that the Princess' name carries considerable attractive force when it comes to charitable fundraising services. Commercial goodwill is a property right which can be bought and sold. The personal goodwill that the Princess enjoyed clearly did not fall within this category. As the applicants' evidence acknowledges, the Princess lent her name to over a hundred different charities whilst she was alive. There is no evidence that any of these charities used her name to identify the source of their services. The name of any famous and well regarded person is capable of assisting charities in their fundraising activities (including the names/titles of other members of the Royal family). That does not mean that their names have trade mark significance. The result of this use would surely have been that, by the time of her death, the average consumer would not have expected all charitable fundraising

associated with the Princess' name to be under the control of a single undertaking.

59. It seems unlikely that this perception would have been completely reversed 18 months later when this application was filed. The charities which the Princess supported whilst she was alive were free to continue to state this fact. And although the survey evidence shows that the Princess' name was most commonly associated with the Fund at the date of the application, the name was also associated with a range of other charities (or just charity generally). For these reasons I have reached the conclusion that the Princess' name cannot be accepted as a trade mark, even in class 36.

The Case for Registration based on Acquired Distinctiveness as a Trade Mark

60. A trade mark which is deemed to lack the necessary inherent distinctive character can acquire a distinctive character through its use as a trade mark. The European Court of Justice laid down the legal requirements in this respect in *Windsurfing Chiemsee Produktions v Huber* 1999 ETMR 585. The relevant part of the court's decision is re-produced below:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account. The market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied.

61. I believe that the answer to this question is straightforward. There is no evidence of any use of the name DIANA, PRINCESS OF WALES as a trade mark. Much of the use shown in the

evidence falls under the heading of “authorised” use in respect of goods such as calendars, cards, books, re-production prints, a lily and fund raising events over which the applicants appear to have had no relevant control, or is merely descriptive use (such as the Tribute CD). In the case of the commemorative stamps produced by the Royal Mail, the Princess’ name is not actually used at all, and the images of her which are used clearly did not perform a trade mark function. The same can be said of the commemorative postmarks which did bear her name.

62. There is some evidence of trade mark use in respect of commemorative enamel boxes, a memorial tartan and possibly a “Beanie Baby” product, but in each case it is noticeable that it is the official Diana “signature” logo (with the words ‘Princess of Wales Memorial Fund’) and the hallmark of the Estate which are used to identify a trade connection with the Estate and Fund, rather than the words “Diana, Princess of Wales” per se. The “official” signature logo, the words DIANA, PRINCESS OF WALES MEMORIAL FUND and the hallmark of the Estate have been accepted for registration by the Registrar for a wide range of goods on the basis that these signs are capable of distinguishing “official” commemorative products from others. This is not evidence that the words DIANA, PRINCESS OF WALES per se have come to perform this function.

63. The use in respect of Flora margarine is irrelevant for two reasons. It was not use of the mark applied for and it was not trade mark use. The use was of the official logo not the words DIANA, PRINCESS OF WALES per se, and the use did not serve to indicate that the Estate or Fund had any control over the quality of the goods. The use was sanctioned simply as a “thank you” to the makers of Flora margarine for supporting some runners in the London marathon.

64. I conclude that there has been no established trade mark use of the mark DIANA, PRINCESS OF WALES in respect of any of the goods/services listed in the application. No one can therefore expect the goods/services listed in the application to originate from a particular undertaking because of the use of the trade mark. The case for registration under the proviso to section 3(1) therefore falls at the first hurdle.

65. In the light of my earlier findings this means that the application must be refused under section 37(4) of the Act because, at the date of the application, the words DIANA, PRINCESS OF

WALES were devoid of any distinctive character as a trade mark for the goods/services listed in the application and the mark is therefore excluded from registration by section 3(1)(b).

Dated this 31 Day of July 2000

Allan James

For the Registrar

The Comptroller General