

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION No. 2161562B
IN THE NAME OF CONTINENTAL SHELF 128 LIMITED**

**AND IN THE MATTER OF AN OPPOSITION THERETO
BY ELIZABETH FLORENCE EMANUEL UNDER No. 49342**

AND

**IN THE MATTER OR TRADE MARK REGISTRATION No. 1586464
IN THE NAME OF CONTINENTAL SHELF 128 LIMITED**

**AND IN THE MATTER OF AN APPLICATION FOR REVOCATION
BY ELIZABETH FLORENCE EMANUEL UNDER No. 11105**

**AND IN THE MATTER OF APPEALS TO THE APPOINTED PERSON
AGAINST DECISIONS OF MR. M. KNIGHT DATED 17 OCTOBER 2002**

DECISION

Introduction

1. This is the resumed hearing of appeals by Elizabeth Florence Emanuel from decisions dated 17 October 2002 of Mr. M. Knight, the Principal Hearing Officer acting for the Registrar of Trade Marks (BL O/424/02 and BL O/425/02).
2. The appeals arise out of two applications made by Ms. Emanuel against Continental Shelf 128 Limited (“CSL”), the first in opposition to CSL’s application for registration of the trade mark ELIZABETH EMANUEL in Classes 3, 14, 18 and 25¹, and the second to revoke CSL’s device trade mark EE ELIZABETH EMANUEL registered in Class 25². The Hearing Officer dismissed both the applications.

¹ UK Trade Mark Application No. 2161562B for the following specification of goods: Class 3 – Perfume, cosmetics, soaps, essential oils and hair lotions; Class 14 – Jewellery and watches; Class 18 – baggage; Class 25 – Clothing, footwear and headgear.

² UK Registration No. 1586464 in respect of: “Suits, articles of underclothing, lingerie, articles of athletic, sporting and gymnastic clothing; stockings, shirts, t-shirts, sweatshirts, blouses, trousers, skirts, dresses, bridal dresses, fancy dress costumes; jackets, overalls, waistcoats, pants-hose, knitted articles of clothing, scarves, dressing gowns, bath robes, sleeping garments, hats, socks, belts, caps, gloves and aprons, all for wear; jeans, neckwear, swimwear, bridal wear and footwear; all included in Class 25.

3. Ms. Emanuel appealed both decisions to an Appointed Person under section 76 of the Trade Marks Act 1994 (“TMA”). It is common ground that the appeals relate solely to the Hearing Officer’s decisions under section 3(3)(b) of the TMA in the opposition and section 46(1)(d) in the revocation. Sections 3(3)(b) and 46(1)(d) of the TMA implement articles 3(1)(g) and 12(2)(b) respectively of Council Directive 89/104/EEC (“the Directive”), which provide:

Article 3(1)(g)

“The following shall not be registered or if registered shall be liable to be declared invalid:

...

- (g) trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;”

Article 12(2)(b)

“A trade mark shall ... be liable to revocation if, after the date on which it was registered,

...

- (b) in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services;”

4. In an interim decision of 27 June 2003 (BL O/196/03), Mr. David Kitchin QC sitting as the Appointed Person refused to refer the appeals to the High Court under section 76 of the TMA at CSL’s behest. In a further interim decision dated 16 January 2004 (BL O/017/04), he decided to stay the appeal proceedings and refer questions concerning articles 3(1)(g) and 12(2)(b) of the Directive to the Court of Justice of the European Communities (“ECJ”) for a preliminary ruling pursuant to article 234 EC.
5. Advocate General Ruiz-Jarabo Colomer delivered his Opinion in Case C-259/04, *Elizabeth Florence Emanuel v. Continental Shelf 128 Ltd*, on 19 January 2006. The ECJ handed down its judgment in the case around two months later on 30 March 2006, [2006] ETMR 56.
6. The appeals come back before me with the benefit of the ECJ’s rulings, Mr. Kitchin in the meantime having been appointed to the High Court.

Background facts

7. There is no dispute as to the relevant facts, which were set out by Mr. Kitchen at paragraphs 4 – 10 of his interim decision dated 16 January 2004:

“4. At all relevant times, Elizabeth Emanuel was very well known as a designer of fashion clothes, particularly wedding wear. Her reputation increased dramatically in 1981 as a result of her involvement with the design of the wedding dress of the Princess of Wales. In 1990 she began trading under the name ELIZABETH EMANUEL from an address in Brook Street.

5. In 1996 Elizabeth Emanuel sought financial backing and entered into an agreement with a company called Hamlet International Plc under which a jointly owned company called Elizabeth Emanuel Plc (“EE Plc”) was formed. Elizabeth Emanuel assigned to EE Plc, inter alia, the business of designing and selling garments formerly run by her under the name ELIZABETH EMANUEL, all assets of the business including its goodwill and an application for a registered trade mark comprising a device and the words ELIZABETH EMANUEL. That trade mark (“the Registered Mark”) was duly registered in 1997 under No. 1586464. It was registered in respect of a range of goods in Class 25 as of 28th September 1994 and is depicted below:



6. In September 1997 Elizabeth Emanuel fell into financial difficulties, and approached a Mr Shami Ahmed. As a result EE Plc entered into a further agreement with a company called Frostprint Ltd (“Frostprint”). Under that agreement EE Plc assigned to Frostprint, inter alia, the business of EE Plc as a going concern, including its goodwill, and the Registered Mark. At the same time Frostprint changed its name to Elizabeth Emanuel International Limited (“EE International”). Elizabeth Emanuel was employed by EE International.

7. In October 1997 Elizabeth Emanuel left the employment of EE International. Following her departure there was a period of about two months during which negotiations took place with a view to her possible re-engagement. During this period the staff of EE International were told to be circumspect when responding to any enquiries concerning Elizabeth Emanuel.

8. In November 1997 EE International assigned the Registered Mark to another company called Oakridge Trading Limited (“Oakridge”). On 18th March 1998 Oakridge applied to register the mark ELIZABETH EMANUEL under application No. 2161562. The application initially consisted of a series of four marks. Following examination it was divided. Three of the marks were transferred to application No. 2161562A which was subsequently withdrawn. The application in issue in these proceedings (“the Application”) was for the trade mark ELIZABETH EMANUEL in block capital letters and it proceeded to publication under No. 2161562B. Registration was sought in respect of a range of goods in Classes 3, 14, 18 and 25.

9. On the 7th January 1999, a Mr. Anthony Drew filed a notice of opposition to the Application and on 9th September 1999 he applied to revoke the Registered Mark.

10. The application for revocation and the opposition were heard by the Hearing Officer on the 18th April 2002, at a combined hearing. By the time of the hearing the Application and the Registered Mark stood in the name of Continental Shelf 128 Limited (“CSL”) and the name of the opponent and applicant for revocation had been changed from Anthony Drew to Elizabeth Emanuel. Nothing turned on these matters before the Hearing Officer.”

The Hearing Officer’s decision

8. In decisions dated 17 October 2002, the Hearing Officer dismissed the opposition and the application for revocation on grounds that, whilst the public had indeed been deceived and confused, such deception and confusion was lawful and the inevitable consequence of the sale of a business and goodwill previously conducted under the name of the original owner. Ms. Emanuel’s cases under sections 3(3)(b)/46(1)(d) of the TMA (arts. 3(1)(g)/12(2)(b) Directive) were not made out. Ms. Emanuel was ordered to pay CSL a total sum of £2,600 towards CSL’s costs in the opposition and revocation proceedings³.

Interim findings on appeal

9. Mr. Kitchin expressed himself dissatisfied with the Hearing Officer’s findings in relation to three factual matters (at para. 30):

“First, the Hearing Officer does not appear to have made any clear finding as to the extent of confusion and deception resulting from the use of the mark ELIZABETH EMANUEL by Oakridge in March 1998 and thereafter. In this regard he simply found that “not all” the relevant public had become aware of the rift although a “not insignificant” number of people had become aware of it. Secondly, the Hearing Officer has made no specific finding as to the nature of the

³ The costs included consideration of sections 3(6) and 5(4)(a) TMA in the opposition.

deception and confusion which was occurring. He found that there was ample evidence that the public believed that Elizabeth Emanuel was still involved with the business after she had left, but he has not specifically addressed the contention that to a significant portion of the relevant public the mark ELIZABETH EMANUEL denoted garments actually designed and created by Elizabeth Emanuel and further, that this deception and confusion was likely to influence the purchasing behaviour of those persons. Thirdly, the Hearing Officer has made no clear finding as to the duration of the deception and confusion, although it may be inferred from his finding that the confusion was of the kind which inevitably occurs in the transitional period following the sale of a business that he thought it would diminish relatively quickly.”

10. Following a review of all the evidence before the Hearing Officer, Mr. Kitchin concluded:
 - (a) As of 18 March 1998, a significant portion of the relevant public took the use of the mark ELIZABETH EMANUEL in relation to garments to indicate that Elizabeth Emanuel was personally involved in their design and creation.
 - (b) Such a belief was likely to influence the purchasing behaviour of those persons.
 - (c) The confusion inevitably must have diminished over time but the evidence established that it continued well into the year 2000.
 - (d) The Hearing Officer rightly rejected the contention that EE International and Oakridge actively told customers or potential customers that Elizabeth Emanuel was still involved with the business after her departure.

11. For reasons that will become apparent later in this decision, it assists to record Mr. Kitchin’s observations on the evidence of certain witnesses on behalf of Ms. Emanuel:

“26. Mary Blair, Christina Brandon and Shirley Hilary were all trade witnesses. They attended the Harrogate Bridal Fair to buy garments for their respective businesses. In paragraph 26 of his decision ... the Hearing Officer concluded that each of these ladies was confused into believing that Elizabeth Emanuel was still involved with the business. I agree with his conclusion. But I think the evidence goes further. Each of them placed orders for garments in the mistaken belief that they had been designed by Elizabeth Emanuel herself. They each reached this conclusion on the basis of the reputation attaching to Elizabeth Emanuel, the use of her name in relation to the stand and on promotional materials on display and in the light of discussions with the representatives on the stand.

...

28. Elisabeth King, Shirley Darby and David Boughton gave evidence as to the position in the spring and summer of 2000. Miss King and Miss Darby each bought dresses bearing the label ELIZABETH EMANUEL. They bought the garments in the belief that Elizabeth Emanuel had been personally involved in some way in the design and manufacture of those garments. Mr. Boughton is a design assistant who made telephone enquiries of the John Lewis store in Oxford Street and asked a shop assistant about the “Elizabeth Emanuel” dresses stocked by the store. It seems clear from the report of the telephone conversation that the shop assistant at the store believed that the dresses had been designed by Elizabeth Emanuel personally. This evidence was reviewed by the Hearing Officer and it seems from paragraphs 26 and 33 of his decision that he too believed that they evidenced actual confusion.”

12. Given his findings set out at paragraph 10 above, Mr. Kitchin believed that the application of the relevant provisions was not *acte clair*. On the one hand, the public interest requires that trade marks must not be liable to mislead the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, it being argued for Ms. Emanuel that registration must be refused where the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived is shown (Case C-87/97 *Consortio per la tutela del formaggio Gorgonzola* [1999] ECR I-1301, paras. 41 and 42). On the other hand, there is also a clear public interest in allowing the sale and assignment of businesses and goodwill together with the trade marks with which they are associated. That public interest applies regardless of the size of a business.

Questions referred to the ECJ

13. The questions referred to the ECJ for a preliminary ruling were as follows:

“1. Is a trade mark of such a nature as to deceive the public and prohibited from registration under Article 3(1)(g) [Directive] in the following circumstances:

- (a) the goodwill associated with the trade mark has been assigned together with the business of making the goods to which the mark relates;
- (b) prior to the assignment the trade mark indicated to a significant portion of the relevant public that a particular person was involved in the design or creation of the goods in relation to which it was used;
- (c) after the assignment an application was made by the assignee to register the trade mark; and

(d) at the time of the application a significant portion of the relevant public wrongly believed that use of the trade mark indicated that the particular person was still involved in the design or creation of the goods in relation to which the mark was used, and this belief was likely to affect the purchasing behaviour of that part of the public?

2. If the answer to question 1 is not unreservedly yes, what other matters must be taken into consideration in assessing whether a trade mark is of such a nature as to deceive the public and prohibited from registration under Article 3(1)(g) [Directive] and, in particular, is it relevant that the risk of deception is likely to diminish over time?

3. Is a trade mark liable to mislead the public in consequence of the use made of it by the proprietor or with his consent and so liable to revocation under Article 12(2)(b) [Directive] in the following circumstances:

(a) the registered trade mark and the goodwill associated with it have been assigned together with the business of making the goods to which the mark relates;

(b) prior to the assignment the trade mark indicated to a significant proportion of the relevant public that a particular person was involved in the design or creation of the goods in relation to which it is used;

(c) after the assignment an application was made to revoke the registered trade mark; and

(d) at the time of the application a significant portion of the relevant public wrongly believed that use of the trade mark indicated that the particular person was still involved with the design or creation of the goods in relation to which the mark was used, and this belief was likely to affect the purchasing behaviour of part of the public?

4. If the answer to question 3 is not unreservedly yes, what other matters must be taken into consideration in assessing whether a registered trade mark is liable to mislead the public in consequence of the use made of it by the proprietor or with his consent and so liable to revocation under Article 12(2)(b) and, in particular, is it relevant that the risk of deception is likely to diminish over time?"

14. The decisions of Mr. Mike Knight, dated 17 October 2002, and of the Appointed Person, dated 16 January 2004, were annexed to the reference to the ECJ along with the questions.

The ECJ's answers

15. On 30 March 2006, the ECJ provided the following answers:

“The first two questions

26. By its first two questions, the Appointed Person essentially seeks to ascertain the circumstances in which a trade mark may be refused registration on the ground that it is of such a nature as to deceive the public, within the meaning of Article 3(1)(g) of Directive 89/104, where the goodwill associated with that trade mark has been assigned together with the business making the goods to which the mark relates and that trade mark, which corresponds to the name of the designer and first manufacturer of those goods, was previously registered in a different graphic form.

...

43. Article 2 of Directive 89/104 contains a list, described as a list of examples in the seventh recital in the preamble to that directive, of signs which may constitute a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings, that is to say to fulfil the trade mark's function as an indicator of origin. That list expressly includes personal names (*Nichols*, paragraph 22).

44. As the Commission pointed out, for the trade mark to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish and maintain, 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, in particular, *Arsenal Football Club*, paragraph 48).

45. A trade mark such as ‘ELIZABETH EMANUEL’ may have that function of distinguishing the goods manufactured by an undertaking, particularly where that trade mark has been assigned to that undertaking and the undertaking manufactures the same type of goods as those which initially bore the trade mark in question.

46. However, in the case of a trade mark corresponding to the name of a person, the public interest ground which justifies the prohibition laid down by Article 3(1)(g) of Directive 89/104 to register a trade mark which is liable to deceive the public, namely consumer protection, must raise the question of the risk of confusion which such a trade mark may engender in the mind of the average consumer, especially where the person to whose name the mark corresponds originally personified the goods bearing the mark.

47. Nevertheless, the circumstances for refusing registration referred to in Article 3(1)(g) of Directive 89/104 presuppose the existence of

actual deceit or a sufficiently serious risk that the consumer will be deceived (Case C-87/97 *Consorzio per la tutela del formaggio Gorgonzola* [1999] ECR I-1301).

48. In the present case, even if the average consumer might be influenced in his act of purchasing a garment bearing the trade mark 'ELIZABETH EMANUEL' by imagining that the appellant in the main proceedings was involved in the design of that garment, the characteristics and the qualities of that garment remain guaranteed by the undertaking which owns the trade mark.

49. Consequently, the name Elizabeth Emanuel cannot be regarded in itself as being of such a nature as to deceive the public as to the nature, quality or geographical origin of the product it designates.

50. On the other hand, it would be for the national court to determine whether or not, in the presentation of the trade mark 'ELIZABETH EMANUEL' there is an intention on the part of the undertaking which lodged the application to register that mark to make the consumer believe that Ms Emanuel is still the designer of the goods bearing the mark or that she is involved in their design. In that case there would be conduct which might be held to be fraudulent but which could not be analysed as deception for the purposes of Article 3 of Directive 89/104 and which, for that reason, would not affect the trade mark itself and, consequently, its prospects of being registered.

51. Consequently the answer to the first two questions must be that a trade mark corresponding to the name of the designer and first manufacturer of the goods bearing that mark may not, by reason of that particular feature alone, be refused registration on the ground that it would deceive the public, within the meaning of Article 3(1)(g) of Directive 89/104, in particular where the goodwill associated with that trade mark, previously registered in a different graphic form, has been assigned together with the business making the goods to which the mark relates.

The last two questions

52. By its last two questions, the Appointed Person essentially seeks to ascertain the circumstances in which a trade mark is liable to revocation on the ground that that mark would mislead the public, within the meaning of Article 12(2)(b) of Directive 89/104, where the goodwill associated with that mark has been assigned together with the business making the goods to which the mark relates and that trade mark corresponds to the name of the designer and first manufacturer of those goods.

53. Since the conditions for revocation laid down by Article 12(2)(b) of Directive 89/104 are the same as those for the refusal of registration under Article 3(1)(g) of that directive, analysis of which has formed

the subject of the reply to the first two questions, the reply to the last two questions must be that a trade mark corresponding to the name of the designer and first manufacturer of the goods bearing that mark is not, by reason of that particular feature alone, liable to revocation on the ground that the mark would mislead the public, within the meaning of Article 12(2)(b) of Directive 89/104, in particular where the goodwill associated with that mark has been assigned together with the business making the goods to which the mark relates.”

The resumed appeal

16. At the resumed appeal hearing, Mr. Jonathan Hill of Counsel, instructed by Messrs Wragge & Co. LLP, appeared on behalf of Ms. Emanuel. Mr. Richard Hacon of Counsel, instructed by Messrs McGrigors, appeared on behalf of CSL. Mr. Hill argues, in short, that the ECJ’s failure to answer the questions in the exact form in which they were put leads to uncertainty regarding the outcome of the appeals. Mr. Hill describes the reasoning of the ECJ as elliptical. By contrast, Mr. Hacon says that the answers provided by the ECJ are short and clear. On the facts found by Mr. Kitchin neither Ms. Emanuel’s ground for opposition under article 3(1)(g) nor her ground for revocation under article 12(2)(b) is well founded. During the resumed appeal hearing it was suggested that I might need to make a further reference to the ECJ. I have not found such a course of action necessary.
17. As I understand them, Mr. Hill’s arguments on behalf of Ms. Emanuel are as follows:
 - (a) In its decision of 30 March 2006, the ECJ set a stringent test for determining whether a trade mark, which corresponds to the name of the designer and first manufacturer of goods bearing the mark, contravenes article 3(1)(g)/article 12(2)(b) of the Directive. The test is actual deceit or a sufficiently serious risk that the consumer will be deceived. In the present case, the ECJ believed that something less had been shown. Neither Mr. Knight at first instance nor Mr. Kitchin on appeal addressed the issue of whether deceit (as opposed to confusion) had been shown on the evidence. The Appointed Person was invited to revisit the evidence to decide the question afresh. In Ms. Emanuel’s submission, the evidence established that consumers were positively deceived through use of ELIZABETH EMANUEL particularly at the Harrogate Bridal Fair. Accordingly the opposition and the application for revocation should succeed.
 - (b) The ECJ’s decision of 30 March 2006 proceeds on the basis that the consumer would perceive ELIZABETH EMANUEL as a trade mark. Instead the evidence showed that many consumers did not take the words “Elizabeth Emanuel” when used in relation to bridal wear and outer clothing as a guarantee of origin, rather as a description of the designer and head of quality control at the business. Again the mark was deceptive and Ms. Emanuel’s objections justified.

As a follow on from (b) above, Mr. Hill argued in his skeleton that the ECJ omitted to consider that Ms. Emanuel was not only the designer and first manufacturer of the goods in question but also head of quality control up until the time of her departure from EE International. Customers perceived the use of ELIZABETH EMANUEL in relation to garments to indicate additionally the latter as well as the former and were therefore deceived as to quality. Mr. Hill did not pursue this further argument at the resumed appeal hearing.

18. In support of his first argument, Mr. Hill relies on paragraph 47 of the ECJ's judgment:

“Nevertheless, the circumstances for refusing registration referred to in Article 3(1)(g) of Directive 89/104 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (Case C-87/97 *Conorzio per la tutela del fromaggio Gorgonzola* [1999] ECR I-1301, paragraph 41).”

19. It became clear at the hearing that Mr. Hill was advocating that the ECJ had set out a general test at paragraph 47 namely, whenever actual deceit or a sufficiently serious risk that the consumer will be deceived can be shown then article 3(1)(g)/article 12(2)(b) is engaged. That submission, inter alia, obscures the distinction between the absolute and relative grounds for refusal of registration, which is a feature of the Directive and Regulation 40/94/EC on the Community trade mark. Although the ECJ does not expressly deal with this distinction, I believe that it is implicit in the Court's judgment; see, in particular, the reference to the UK Government's observations at paragraph 34 and paragraphs 45 – 46 and 48 – 50. Moreover, Advocate General Ruiz-Jarabo Colomer noted the distinction in his Opinion to the Court on 19 January 2006 (paragraph 57):

“From the wording of that provision [art. 3(1)(g) Directive] it can be inferred that, in the same way as in the other paragraphs of Article 3, reference is being made to the intrinsic characteristics of the trade mark, as the United Kingdom states in its observations. The sign must, therefore, confuse the public by virtue of its qualities, containing incorrect information, which may prove deceptive from an objective point of view; in other words, in every imaginable case its use must give rise to such deception. Thus, a reference, as a component of the product designated by the trade mark, to a material not used in its composition would be information directly deriving from the trade mark which would cause confusion amongst customers.”

Mr. Hill says that the ECJ did not agree with the Opinion of AG Colomer. But I am unable to find any indication of such supposition in the ECJ's judgment.

20. As Mr. Hacon remarked the ECJ's findings must be read together. There is a danger in taking general statements like the one Mr. Hill relies on out of context (*O2 Holdings Limited v. Hutchison 3G Limited* [2006] EWHC 534 (Ch), Lewison J. at para. 145). Adopting that approach (and not intending to substitute my own wording for that of the ECJ):

- (a) First, the ECJ confirms its earlier ruling in Case C-404/02 *Nichols* [2004] ECR I-8499 that personal names can constitute trade marks within the meaning of article 2 of the Directive; paragraph 43.
- (b) Second, the ECJ states the function of a trade mark to act as a guarantee that all products bearing it have been manufactured or supplied under the control of a single undertaking, which is responsible for their quality (Case C-206/01 *Arsenal Football Club* [2002] ECR I-10273); paragraph 44.
- (c) Third, the ECJ makes clear that ELIZABETH EMANUEL can have that function particularly when it has been assigned and the assignee manufactures the same type of goods as those which initially bore the mark; paragraph 45.
- (d) Fourth, the ECJ observes that sight must not be lost of the public interest ground behind article 3(1)(g) namely, consumer protection. A trade mark comprising a personal name, raises the question of the risk of confusion which such a mark may engender in the mind of the average consumer especially where the person to whose name the mark corresponds originally personified the goods bearing the mark; paragraph 46.
- (e) Fifth, the ECJ reminds itself by reference to *Gorgonzola* that “deceive” in article 3(1)(g) means actual deceit or a sufficiently serious risk that the consumer will be deceived; paragraph 47.
- (f) Sixth, the ECJ holds that even if the consumer buys an ELIZABETH EMANUEL garment in the mistaken belief that Ms. Emanuel was involved in the design of that garment, the characteristics and qualities of the garment remain guaranteed by the undertaking, which owns the trade mark, i.e., the function of the mark is undisturbed. Accordingly, the designation Elizabeth Emanuel is not *per se* deceptive as to the nature, quality or geographical origin of the goods in respect of which it is used; paragraphs 48 and 49.
- (g) Seventh, the ECJ raises the issue of fraudulent conduct, which the national tribunal might find to exist where the applicant for registration in its presentation of ELIZABETH EMANUEL (i.e., sales strategy) intends to make the public believe that Ms. Emanuel is still the designer of the goods bearing the mark or that she is involved in their design. Again the mark *per se* is unaffected. Registration is not precluded under article 3(1)(g) because there is no relevant deceit; paragraph 50
- (h) Eighth, the ECJ clarifies that it makes no difference to the Court’s findings that the mark was previously registered in a different graphic form; paragraph 51.

- (i) Ninth, the ECJ applies the same reasoning to article 12(2)(b) of the Directive. A registered trade mark is not liable to revocation on the ground that it would mislead the public within the meaning of article 12(2)(b) by reason of the fact that: (a) the mark corresponds to the name of the designer and first manufacturer of the goods bearing the mark; and (b) the goodwill associated with the mark is assigned together with the business making the goods to which the mark relates; paragraphs 52 and 53.
21. Mr. Hill fastens on the ECJ's employment of the word "imagining" at paragraph 48. He submits that the ECJ had in mind something less than actual deceit or a sufficiently serious risk that the consumer would be deceived when ruling that a mark like ELIZABETH EMANUEL did not fall foul of article 3(1)(g) of the Directive particularly following assignment. Likewise, Mr. Hill says that Mr. Kitchin addressed himself to mere confusion rather than deception in arriving at his interim findings. I am unable to accept Mr. Hill's submissions, which, inter alia, fly in the face of the wording of the provisions under consideration. Mr. Kitchin's interim findings, his statement of the competing public interest considerations and the terminology of his questions to the ECJ all make clear that the reference for a preliminary ruling was predicated on deception, i.e., that a significant portion of the relevant public bought ELIZABETH EMANUEL garments in the false belief that Ms. Emanuel was still involved in their design and/or creation (see, the recent discussion in *Phones-4U Ltd v. Phone-4u.co.uk Internet Ltd* [2006] EWCA Civ 244, Jacob L.J., at paras. 16 – 19). Moreover, it is equally clear that the ECJ's judgment proceeded on the same basis; see, for example, paragraphs 10, 13, 27 and 28, 48 and 50.
22. Mr. Hill's second argument is that the ECJ's decision is inapplicable. That is because the ECJ assumes that "Elizabeth Emanuel" is a trade mark whereas, in Mr. Hill's submission, a significant portion of relevant consumers, especially in relation to bridal wear and outer garments, will take it merely as a reference to the designer and/or head of quality control. In other words, "Elizabeth Emanuel" is purely descriptive. Mr. Hacon responded that no objection to the registration of ELIZABETH EMANUEL had been raised under section 3(1)(c) of the TMA (art. 3(1)(c) Directive).
23. It is well recognised that a trade mark can convey a descriptive or promotional message as well as being indicative of origin (*Case C-64/02, OHIM v. Erpo Möbelwerk GmbH (DAS PRINZIP DER BEQUEMLICHKEIT)* [2005] ETMR 731). Mr. Hill was unable to point me to any example in the evidence of a customer perceiving "Elizabeth Emanuel" in relation to garments solely as a descriptor and not also as an indication of origin. In fact, I fail to see how Mr. Hill's second argument assists him further. If he is arguing that the descriptive perception of ELIZABETH EMANUEL is no longer true and therefore deceptive, he is back to his main submission.
24. In my judgment, the application of the ECJ's decision in these appeals is not in doubt. Even on the fresh findings of fact made by Mr. Kitchin in his interim decision of 16 January 2004, Ms. Emanuel's cases: (a) under section 3(3)(b) of

the TMA (art. 3(1)(g) Directive) against Application No. 2161562B; and (b) against Registration No. 1586464 under section 46(1)(d) of the TMA (art. 12(2)(b) Directive), both fail. There has been no objection based on fraudulent conduct. Indeed, Mr. Kitchin confirmed the Hearing Officer's decision that there was no sales strategy on the part of either EE International or Oakridge to actively tell customers or potential customers that Ms. Emanuel was still involved with the business after her departure. But, in any event, the findings under sections 3(3)(b) and 46(1)(d) (arts. 3(1)(g) and 12(2)(b)) would have remained unchanged (para. 50 ECJ's decision).

Conclusion

25. In the result the appeals have not succeeded. The Hearing Officer ordered Ms. Emanuel to pay CSL the sum of £2,600 in respect of the costs of the opposition and the application for revocation. I direct that Ms. Emanuel additionally pay to CSL the sum of £900 towards the costs of these appeals to be paid on the same terms as ordered by Mr. Knight, which additional sum includes a reduction of £500 in respect of Ms. Emanuel's costs of successfully defending the application to transfer the appeals to the High Court. CSL is also entitled to costs in relation to the reference to the ECJ. I further direct that I will entertain written submissions as to the costs of the ECJ reference provided they are received within 28 days of the date of this decision, assuming that the parties are unable to settle the matter by agreement between them.

Professor Ruth Annand, 3 November 2006

Mr. Jonathan Hill of Counsel, instructed by Messrs. Wragge & Co. LLP, appeared on behalf of Elizabeth Florence Emanuel

Mr. Richard Hacon of counsel, instructed by Messrs. McGrigors, appeared on behalf of Continental Shelf 128 Limited