

TRADE MARKS ACT 1994

**IN THE MATTER OF Applications under Nos 2161386
2143993B by the Estate of the Late Diana, Princess of Wales
to register a trade mark in Classes 3, 9, 14, 16, 25, 28 & 36**

**AND IN THE MATTER OF Application No 2161371 by the
Estate of the Late Diana, Princess of Wales to register a trade
mark in Classes 3, 4, 12, 18, 20, 21, 24, 25, 26, 27, 28, 30,
39, 41 & 42**

**AND IN THE MATTER Oppositions thereto by the Franklin
Mint Company under Nos 49400, 49431 & 50424.**

Decision

1. On the 4 September 1997, the Hon. Mrs Frances Shand Kydd, the Lady Sarah McCorquodale and the Reverend and Right Hon. Richard John Carew Chartness, the Executors of the Will of Diana, Princess of Wales applied to register the trade mark DIANA, PRINCESS OF WALES MEMORIAL FUND in Class 9 & 16.
2. On 18 March 1998, the first two of the above named applicants applied as the Executrices of the Estate of Diana, Princess of Wales, to register the same trade mark in Classes 3, 14, 25, 28 and 36.
3. On the same day, these applicants made a further application to register the trade mark shown below in Classes 3, 4, 12, 14, 18, 20, 21, 24, 25, 26, 27, 28, 29, 30, 32, 33, 34, 35, 38, 39, 41 and 42.

The image shows the word 'Diana' written in a large, elegant, cursive script. The letters are dark and fluid, with a prominent 'D' and a long, sweeping tail on the 'a'.

4. A full list of the goods and services covered by the three applications is set out at Annex 'A'.
5. Each of the applications is opposed by the Franklin Mint Company of the USA.

6. In summary, there are 6 grounds of opposition:-

- (i) the marks are not capable of distinguishing the goods or services of one undertaking from those of other undertakings (Sections 1(1) and 3(1)(a) of the Trade Marks Act 1994);
- (ii) The marks are devoid of any distinctive character (Section 3(1)(b) of the Act);
- (iii) The marks consist exclusively of signs or indications which may serve, in trade, to designate the kinds of goods or services provided and/or other characteristics of goods or services (Section 3(1)(c) of the Act);
- (iv) The mark consists exclusively of signs or indications which have become customary in the bona fide and established practices of the trade, particularly (but not limited to) the trade in collectible items (Section 3(1)(d) of the Act);
- (v) The marks are contrary to public policy in that their registration would restrict the legitimate right of the public to refer to their own goods and services (Section 3(3) of the Act).
- (vi) The applications are made in bad faith in that the applicants have no intention to use the marks for the purposes of distinguish the goods or services of one trader from those of another. Rather the applicants seek registration of the marks so that they can exercise control over charitable giving.

7. There is a further grounds of opposition under Section 3(4) of the Act but the opponent accept that it adds nothing to its case. I need not say any more about it.

8. The applicants deny the grounds of opposition.

9. Both sides seek an award of costs.

10. The oppositions to the applications to register the mark DIANA, PRINCESS OF WALES MEMORIAL FUND in various classes were subsequently consolidated. Hereinafter I will refer to this mark as the Memorial Fund mark.

11. It is common ground that the other mark consists of the signature of the late Diana, Princess of Wales. Hereinafter, I will refer to it as the Signature Mark.

12. The opposition to the registration of the Signature Mark was not consolidated with the other two oppositions. Nevertheless, the cases were heard together on 19 October 2001 when the applicants were represented by Mr B Marsh of Wilson, Gunn, M'Caw, Trade Mark Attorneys, and the opponent was represented by Mr R Miller Q.C. instructed by Messrs

Dechert.

13. Both sides filed a substantial volume of evidence. The applicants' evidence in both sets of proceedings is very similar. The opponent's evidence is also similar.

14. A complete index of the evidence is at Annex B.

15. Much of the opponent's evidence is directed at establishing that there was a significant trade in DIANA, PRINCESS OF WALES souvenirs whilst the late Princess of Wales was alive, and a trade in memorabilia in the immediate aftermath of her death. The principal evidence about this is to be found in the statutory declaration of Lisa A Merlo, a legal assistant at the Franklin Mint, who provides details of the opponent's sales of merchandise "relating to" the late Princess in the UK between 1981-1990.

16. The opponent claims to have sold over 2 million such items, mainly earrings, rings and plates, prior to the untimely death of the Princess in August 1997. The evidence about these sales is somewhat vague and it is not clear that all these items carried the Princess's name and/or title. There is no suggestion that any of them carried the Memorial Fund name or the Signature Mark.

17. Exhibit LAM 7 to Ms Merlo's declaration consists of a copy of a page from the web site of a company called Worldnet-On-Line. It shows that another company offered a glass commemorative keep sake under the image and signature of the late Princess in January 1998. However, the product is priced in dollars and there is nothing to suggest it was offered for sale in the UK.

18. The opponent also commissioned a commercial investigation to establish the scope of the trade in Diana, Princess of Wales souvenirs and memorabilia since 1981. The report of the investigator, a Mr Tim Dabin, concludes that:-

"Our findings suggest that there has been little in the way of Royal family items available during the time period we are interested in other than when items were manufactured specifically for Royal family occasions ie The Queen's Silver Jubilee 1977 and Prince Charles and Diana's wedding in 1981.

It is still not known how much Diana memorabilia was available between her marriage to Prince Charles in 1981 and her death in 1997. From speaking to the many traders during the course of our enquiries it would appear that there was not a great deal. Since her death it is obvious that Diana memorabilia has become a massive industry."

19. The opponent also filed evidence relating to a dispute between the parties in the USA about the use there of the name and/or image of the Late Princess of Wales. I find this of little

relevance. The evidence also includes the results of searches of the UK and CTM trade mark registers, which I find of no relevance to the objections raised.

20. The remainder of the opponent's evidence consists mainly of information about earlier dealings between the parties and legal arguments, which I will return to later as necessary.

21. The applicant's evidence is contained in the statutory declarations of Andrew Charles Dobson and Joan Kavanagh Gwillim, both of whom are solicitors for the firm of Lawrence Graham. They give substantially the same evidence in the two oppositions proceedings. The main points are:-

- (a) The signature mark is the signature of the late Princess of Wales;
- (b) The Memorial Fund mark is the name of the fund established on 4 September 1997 to receive donations to charity in the immediate aftermath of the Princess's death on 31 August 1997;
- (c) The purposes of the applications is firstly to ensure that charity benefits from the Princess's memory, and secondly, to ensure that consumers are not misled into purchasing products bearing one of the subject marks which have not been authorised by the Memorial Fund;
- (d) The Memorial Fund is the exclusive licensee of the Estate;
- (e) The marks at issue are different to the other marks applied for by the applicants (in particular the name and title "Diana, Princess of Wales");
- (f) The marks have been used since 4 September 1997 in relation to various products to signify that part of the proceeds of the sale goes to the Memorial Fund (there is little detail about this claim in respect of a trade in goods prior to the relevant dates in these proceedings);
- (g) The specifications of goods and services filed reflect those goods/services where licensing opportunities are considered most likely, and a number of licences have already been granted.

22. Having made the point that the Signature mark and the Memorial Fund mark are different to the title DIANA, PRINCESS OF WALES per se, the applicants nevertheless include an outline of the results of surveys commissioned in the UK and USA into the public's recognition of the title DIANA, PRINCESS OF WALES and expectations arising from the use of that title in relation to goods. I find this irrelevant. So too is the evidence of the applicants attempts to "police" use of that title in relation to goods.

23. Included in the exhibit to Messrs Dobson and Gwillim's declarations is a copy of an earlier declaration by Purvi Parekh, who is a solicitor at Mishcon de Reya. Purvi Parekh gives information about the establishment of the Memorial Fund and the operation of the Fund in the year or so immediately following the death of the late Princess of Wales. I will return to this later.

Section 3(1)

24. Sections 1(1) and 3(1) of the Act are as follows:-

"1.-(1) In this Act a "trade mark" means any sign 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.

3.-(1) 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) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:*

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."

25. The opponent's objection under Section 3(1)(a) of the Act is presented in Mr Miller's skeleton argument like this:-

"It is submitted that it is clear in the light of the applicants' evidence that they are not entitled to registration of any of the marks in this case. As mentioned above, the intended use of the marks is to "allow consumers to recognise instantly that part or

all of the proceeds of sale from products bearing one or more of these marks are to be received by the Memorial Fund” (Dobson/Gwillim, paragraph 14). This use has nothing to do with trade marks. The raison d’etre of a trade mark is that it guarantees that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (see the cases cited in the Diana, Princess of Wales case). A sign, which is used to indicate that the actual source of the product (ie the licensee) is making a donation of part of all of the proceeds of sale to the Memorial Fund, is not a trade mark at all and such a sign is not capable of distinguishing - in the trade mark sense - the goods or services of one undertaking from those of another.”

26. I believe that this objection is misconceived. It relates to the applicants’ intentions rather than to the inherent trade mark potential of the signs at issue. The same point resurfaces in connection with the opponent’s “bad faith” objection. I will return to it under that heading. The point provides no basis for an objection under Section 3(1)(a) of the Act. No other basis has been put forward for this objection. It therefore fails.

27. There is no evidence of use in trade in the UK (other than by the applicants or with their consent) of any sign consisting exclusively of the Memorial Fund mark or the Signature mark. The objection under Section 3(1)(d) must therefore fail.

28. I next consider the objection under Section 3(1)(c). Mr Miller summarised the objection like this:-

“As to Section 3(1)(c) of the Act, it is clear from the evidence that all the proposed use of the marks will be upon goods and services which will somehow indicate that the goods and services are about Diana, Princess of Wales.”

29. This point echoes one I made myself in refusing another application by the Estate of the late Princess of Wales to register DIANA, PRINCESS OF WALES as a trade mark for a similarly wide range of goods and services. The case is reported at [2001] ETMR 254. There was no appeal from that decision. Mr Miller submitted that, in these circumstances, it should be regarded as settled that the name and title of the late Princess of Wales is not inherently distinctive per se. I did not understand Mr Marsh to dissent from that point. Rather, his submissions focussed on the distinction between the Princess’s name and title and the marks at issue. In any event, the evidence of the use of the name ‘Diana, Princess of Wales’ by the parties and others, both before and after her death, confirms that these words are a natural way to describe souvenirs and commemorative products relating to the late Princess of Wales.

30. Since my decision the European Court of Justice (ECJ) has in its decision in the Baby-Dry case (case C-383-99) given further guidance on the purpose and correct interpretation of Article 7(1) of Regulation No 40/94, which corresponds with Article 3(1) of Trade Mark Directive 104/89, and is identical to Section 3(1) of the Act, which implements the Directive in

the UK.

31. The ECJ dealt with the purpose of Article 7(1) in the following paragraphs of its judgement:-

“35. Under Article 7(1) of Regulation No 40/94, trade marks are not to be registered if they are devoid of distinctive character (subparagraph (b)) or if they consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or of rendering of the service, or other characteristics of the goods or service (subparagraph (c)).

36. Under Article 12 of Regulation No 40/94, the rights conferred by the trade mark do not entitle the proprietor to prohibit a third party from using, in the course of trade, indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or the time of rendering the service, or other characteristics of the goods or service, provided he uses them in accordance with honest practices in industrial or commercial matters.

37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks of signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.

38. That interpretation is the only interpretation which is also compatible with Article 4 of Regulation No 4, which provides that a community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”

32. It appears from this that the purpose of the Article 7(1) of the Regulation (and hence Section 3(1) of the Act) is to prevent the registration of marks which “*could not fulfill the function of a trade mark*” because they are no different from the usual way of designating goods or services. This may be contrasted with an earlier statement in paragraph 25 of the Court’s judgement in Windsurfing Chiemsee C-108/97 and C-109/97 [1999] ETMR 585, wherein the Court concluded that the purpose of the equivalent provision in the Directive was to ensure that descriptive signs or indications “*may be freely used by all*” .

33. The correct question in a case such as this would therefore appear to be whether the signs

at issue are capable of fulfilling the function of identifying the undertaking that markets the goods/ services for which registration of the marks is sought. If the marks are capable of designating a trade source because they are perceptibly different to the usual ways of designating the goods or their characteristics in trade, they should not be refused merely because they contain or are similar to other signs which are usual ways of designating the goods or services or their characteristics.

34. I believe that this approach is consistent with the guidance in the following paragraphs from Baby-Dry:-

“39. The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those 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. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics. (Emphasis added)

40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

35. Although the first sentence of paragraph 39 is directed specifically at Article 7(1)(c) of the Regulation (Section 3(1)(c) of the Act), it seems likely in the light of the Court’s earlier analysis of the purpose of Article 7(1) as a whole, that they had Article 7(1)(b) in mind when they added the words I have underlined. There are plainly marks which are excluded from registration by Section 3(1)(b) even though they are free from objection under Section 3(1)(c). However, where the objection to the mark is that it is descriptive of the goods/services, the above guidance is, in my view, helpful in determining whether the adaption of a description is sufficient to avoid an objection under Section 3(1)(b) and (c).

36. Paragraph 40 is specifically directed at word combinations and therefore is only really of any assistance in this case in relation to the registrability of the Memorial Fund mark.

37. With this guidance in mind, I turn to the marks at issue.

Diana, Princess of Wales Memorial Fund

38. Mr Miller submitted that the Memorial Fund mark was too similar to DIANA, PRINCESS OF WALES and sent a similar message about the subject matter of the goods at issue, which he contended should in each case be regarded as commemorative products. That clearly cannot apply to the application to register the mark for financial services, including charitable fundraising in Class 36.

39. The applicants' evidence makes no bones about their intention to use the proposed registrations to ensure that the public can be certain that the purchase of goods bearing the marks at issue will result in a contribution to the Memorial Fund. I believe it is therefore proper to regard all the goods covered by the Memorial Fund applications as being for commemorative purposes.

40. However, I do not believe that Mr Miller is correct in submitting that the average consumer would receive the same message from 'Diana, Princess of Wales' or even 'Diana, Princess of Wales Memorial product(s)' as he or she would from DIANA, PRINCESS OF WALES MEMORIAL FUND. The first two statements merely convey information about the character and/or intended purpose of the goods. By contrast, the Memorial Fund mark identifies an undertaking responsible for collecting charitable donations in the Princess's name. It therefore designates a trade connection rather than characteristics of the goods.

41. I therefore reject Mr Miller's submission that the Memorial Fund mark is no different to signs or indications that may serve, in normal usage, to designate the goods at issue or their essential characteristics.

42. Mr Miller presented a second line of attack at the hearing. He submitted that anyone should be free to establish a memorial fund in the name of the late Princess, and that as a result, the Memorial Fund mark was, prima facie, devoid of any distinctive character for all the goods and services covered by the Memorial Fund applications.

43. This argument did not appear in the opponent's pleadings or evidence, or even in Mr Miller's skeleton. It appears to have been something of an afterthought. I have already found that the name of the Memorial Fund is not a natural designation of the goods listed in the applications. The only really arguable point that arises under Section 3(1)(c) of the Act is, in my view, in relation to charitable fundraising services.

44. Mr Marsh pointed out that the Memorial Fund was established on the day of the first application to register the name of the Fund as a trade mark. Further, despite the opponent's investigative evidence (which included the results of searches of the Internet), the only other Diana, Princess of Wales Memorial Fund shown to have existed was based in New Zealand. The applicants' evidence includes a copy of an agreement between the UK Memorial Fund and the Fund of that name wherein the New Zealand Fund agrees that it has not used the Memorial

Fund name and that it should be wound up by the end of 1999.

45. The ECJ's guidance in Baby-Dry refers to the equivalent of Section 3(1)(c) as being directed at excluding from registration those signs that "*may serve in normal usage (as a designation of goods or services) from a consumer's point of view....*" It is implicit from the words "may serve" that an element of futurity is to be considered. In other words one should not only consider whether the sign in question is already in normal usage for descriptive purposes, but whether it naturally lends itself to such usage in future.

46. I do not believe that, from a consumer's point of view, Diana, Princess of Wales Memorial Fund is a natural usage to designate characteristics of charitable fundraising services. Rather the mark suggests itself as the name of an undertaking responsible for charitable fundraising services. It is source specific. I do not therefore believe that the Memorial Fund mark is open to objection under section 3(1)(c) because any descriptiveness present is not such as prevent it fulfilling the function of a trade mark for the services in question.

47. The mark could still be open to objection under section 3(1)(b) on the alternative ground that the name is just too commonplace. In this connection I note that memorial funds are generally set up in the immediate aftermath of a death. Despite the fact that over four years have passed since the death of the late Princess of Wales, there is no evidence of the existence of a multiplicity of memorial funds dedicated to the late Princess. The only other one appears to have been in New Zealand, and this did not use the Memorial Fund name.

48. The Memorial Fund mark was not commonplace in September 1997, nor is there any reason to believe that it was likely to become commonplace. The Memorial Fund mark is not therefore devoid of any distinctive character for charitable fund raising services or the goods listed in the applications.

49. For the reasons given above the objections under section 3(1)(b) and (c) fail.

The Signature Mark

50. Mr Miller submitted that the word 'Diana' is synonymous with 'Diana, Princess of Wales', and that the signature mark is insufficiently different to the word DIANA per se to imbue the sign with any distinctive character.

51. In the Elvis Presley Trade Mark case [1997] RPC 543 and [1999] RPC 567 (Court of Appeal), the signature form of the name 'Elvis A Presley' was criticised by the judge at first instance, Laddie J., and by one of the appeal court judges, Morritt L.J., as being too like the name in question to be distinctive. Robert Walker L.J. felt that the signature mark was distinctive, but upheld objections to the mark on other grounds. The third member of the Court of Appeal, Simon Brown L.J., offered no view on the point.

52. Mr Miller submitted that the signature mark at issue was no more distinctive than in the Elvis Presley case and ought to be refused for similar reasons. He acknowledged that the Elvis Presley case was decided under the previous 1938 Act, but claimed that this assisted his case because there was a presumption that a signature was distinctive under the 1938 Act (as a result of the wording of Section 9(1)(b) of the Act), whereas the new law lacks any such express provision.

53. The English courts approach to distinctiveness under the 1938 Act was based upon a line of authority that can be traced back to the case of W and G Du Cros (1913) RPC 660 at 672 and the “classic test of distinctiveness” as stated therein by Lord Parker. In a well known passage he said that:-

“The applicant’s chance of success in this respect must, I think, largely depend on whether other traders are likely, in the ordinary course of their business and without any improper notice, to desire the use of the same mark, or some other mark nearly resembling it, upon or in connection with their own goods. It is apparent from the history of trade marks in this country that both the legislature and the courts have always shown a natural disinclination to allow any person to obtain by registration under the Trade Marks Act a monopoly in what others may legitimately desire to use.”

54. The courts reluctance to register the ‘Elvis A Presley’ signature mark would undoubtedly have been influenced by a perception that in so doing the court would be ordering the registration of a mark that “nearly resembled” another mark, namely, the name ‘Elvis Presley’, which another trader had shown it had a legitimate interest in using in the course of its trade in relevant goods.

55. However, as Robert Walker L.J. stated in Procter and Gamble’s Trade Mark Application [1999] ETMR 375 (or 383):

“Lord Parker’s observations about distinctiveness must since the 1994 Act be treated with considerable caution, especially so far as they refer to what is capable in law of distinguishing one product from another.”

56. The correct approach is therefore to follow the guidance of the ECJ in Baby-Dry. This requires me to determine whether the mark is “*presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.*”

57. In this connection, Mr Miller drew my attention to copies of various promotions in Exhibit LAM 1 to Ms Merlo’s declaration as evidence that memorabilia relating to the late Princess of Wales is commonly designated by the name DIANA alone. There is some evidence which supports this submission, although most of material in question includes

further indications, sometimes in smaller print, identifying the particular DIANA in question.

58. One can see why this will usually be necessary because, unlike 'Elvis', 'Diana' is not an unusual name, and there are other famous persons called 'Diana' eg Diana Ross, Diana Rigg, Diana Dors. It would therefore be normal to include some further indication of the subject of memorabilia relating to the late Princess of Wales than simply 'Diana', although I accept that this may not always be the case.

59. More importantly, the mark in question is not just the name 'Diana' but consists of the signature of the late Princess of Wales. Although it is true that the new law contains no express provisions relating to signatures, I think it likely that the reason that they were presumed to be distinctive under the old law is because signatures have long been regarded as a unique sign of authenticity. Although the consumer does not expect all merchandise bearing the late princess's name to be authorised by her Estate, and notwithstanding the one instance of such use in the USA by a third party in evidence (see paragraph 17 above), I doubt whether consumers would regard it as a "*normal usage*" for undertakings to use the signature of the late Princess of Wales simply to designate the subject matter of commemorative goods or services.

60. Mr Miller questioned whether the signature in question was readily distinguishable from the word 'Diana' in the sort of cursive copperplate script in which it is sometimes used on memorabilia. My attention was drawn to an example on page 11 of Exhibit JL 1 to Janice Long's declaration.

61. The word 'Diana' in this particular example actually appears as part of the title 'Princess Diana'. The extent to which the signature resembles the word 'Diana' in a cursive copperplate form of script is a matter of first impression. My own impression was that the two signs are perceptibly different. I believe that the average consumer would see the Signature mark as more than just the word 'Diana' in a form of script. It looks like it has been written by hand, and has features (particularly the way the letters 'D' and 'I' have been written and joined) which are characteristic of a signature. A one word signature may be unusual but it is common practice amongst members of the Royal Family and, viewed in the context of a trade in memorabilia relating to the late Princess of Wales, I believe that it would be recognised as the signature of the late Princess of Wales. I therefore find that the signature mark is presented in a form which visually distinguishes the mark from the usual means of designating commemorative goods or services of the kind in question.

62. Mr Miller pointed out that the signature form of the mark is not distinguishable to the ear from the word 'Diana' per se. Accordingly, if 'Diana' alone is a normal way of designating memorabilia relating to the late Princess of Wales, the presentation in signature form fails to distinguish the sign in oral use.

63. Section 103(2) of the Act may appear to provide some support for this submission because

it provides that non-visual use of a trade mark shall constitute use of a mark for the purposes of the Act. However, this provision is “home grown” whereas Section 3(1) comes from the Directive. The one cannot therefore be used to interpret the scope of the other.

64. Mr Miller drew my attention to the case of Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [1999] ETMR 690. The ECJ indicated that a mere aural similarity between two signs may be sufficient to create a likelihood of confusion. However, that case concerned two signs being used to identify competing sources of goods, whereas the opponent’s contention is that DIANA per se is incapable of designating trade source at all. If that is so it plainly has a bearing on the likelihood of (source) confusion. This must be why the ECJ indicated that in assessing the likelihood of confusion account must be taken of the distinctive character of the earlier mark, “*including the fact that it does or does not contain an element descriptive of the goods*”.

65. The question of whether a signature mark is distinctive to the ear is, in my view, an artificial one. Such signs are, by their very nature, visual in character. The same point could be taken against any mark consisting of non-distinctive words combined with a distinctive device or words presented in a distinctive form. In my view these are exactly the sort of marks the ECJ had in mind when it stated that marks composed of purely descriptive signs should not be refused if they are presented or configured in a way which distinguishes them from the usual ways of designating goods or services.

66. For these reasons, I do not find that the aural similarity between the Signature mark and the word ‘Diana’ is material. The mark is distinctive to the eye and that is sufficient to warrant protection.

67. There is no stronger objection to the mark in respect of the services listed in Classes 35, 38, 39, 41 and 42.

68. I find that the objections under Sections 3(1)(b) and (c) to the Signature mark, also fail.

Case for Registration Based upon Acquired Distinctiveness

69. In the light of my findings so far, it is not strictly necessary for me to consider the case for registration on the basis of distinctiveness acquired through use. And in the case of the signature mark there is little or no evidence of use before the relevant date in March 1998. Further, although Mr Dobson and Ms Gwillim raise the point in their evidence, Mr March did not pursue it at the hearing. I will therefore limit myself to the following observations.

70. Attached to Mr Dobson’s declaration (at pages 258 to 263 of Exhibit ACD 1) is a copy of a statutory declaration by Purvi Parekh, who is a solicitor at Mishcon de Reya, who represented the Estate of Diana, Princess of Wales until November 1997. Purvi Parekh states that:-

- 1) After the death of the Princess there was enormous public interest; it is said that the declarant dealt with 100 telephone calls and 50-100 letters daily ;
- 2) The setting up of the Memorial Fund received considerable press coverage; the Managing Director of 21st Century Entertainment wrote on 10 September 1997 seeking permission to use the official logo of the Diana, Princess of Wales Memorial Fund after reading an article about it in the Times;
- 3) Most of the enquiries were for product approval and/or offers to donate to the Memorial Fund;

71. Examples of around 25 such letters from UK firms that are addressed to, or mention, the Memorial Fund by name are included in Exhibit PP 9 to the declaration (which can be found at pages 265-359 in Exhibit ACD 1 to Mr Dobson's declaration). There are also examples of similar letters from firms in other countries. As a result of these and other enquiries, 1000 approval/licensing files were opened up.

72. Mr Dobson also introduces (at pages 229 to 257 in ACD 1) a copy of an expert witness report prepared for the proceedings in the USA, which concludes that, as a result of press coverage, the establishment of an official Diana, Princess of Wales Memorial Fund was well known in the USA by March 1988. The inference being that it was scarcely likely to be less well known in the UK.

73. Mr Dobson gives evidence that the Estate of the late Princess has exclusively licensed all its intellectual property rights to the Memorial Fund.

74. I believe that the evidence presents a prima facie case that the Memorial Fund mark was factually distinctive of the charitable fundraising services of one undertaking by the date of the relevant application in March 1998. Consequently, if I had come to a different conclusion on the inherent distinctiveness of the Memorial Fund mark for such services, I believe that the applicants would have had a case for registration of the Memorial Fund mark under the proviso to Section 3(1).

Section 3(3)(a) Objection - Contrary to Public Policy

75. Section 3(3)(a) of the Act is as follows:-

“3.-(3) A trade mark shall not be registered if it is -

(a) contrary to public policy or to accepted principles of morality”

76. Mr Miller put the opponent's case like this in this skeleton:-

“As to Section 3(3) of the Act, it is plainly a very strong thing to given on undertaking any form of monopoly in the use of the name of a recently deceased member of the Royal Family - particularly one as popular as Diana, Princess of Wales. It is only natural that ordinary members of the public, being loyal subjects of the Crown, may wish to show their allegiance or affection for their Sovereign and/or for the Royal Family in generally by having the name or likeness of one or more members of the Royal Family upon memorabilia which they can then display at home or in public or simply keep for their personal enjoyment in private. This is not something which should be frowned upon or sneered at. On the contrary it is to be supported and encouraged and it is therefore contrary to public policy that a trade mark should be granted which may have the effect of hindering or preventing members of the public who wish to show their allegiance or affection of the Royal Family in the manner indicated. Indeed it is not merely the case the these trade marks if granted may have that effect, it is the expressed intention of the applicants that the marks will have that effect.”

77. In Philips v Remington [1998] RPC 283 at 309, Jacob J considered the meaning of Section 3(3)(a), which like Section 3(1) comes from Directive 104/89. He invoked the concept of “ordre publique” and rejected the view that the provision could be used to prevent the trade mark system being used to obtain an indefinite extension of the monopoly conferred by a patent, design or copyright.

78. The opponent’s objection is that the applications will be used to obtain a monopoly in the trade in commemorative goods/services relating to the late Princess of Wales, which is contrary to public policy. This is really a re-run of the anti-monopoly objection raised under section 3(1) of the Act. Section 11 of the Act addresses the safeguards necessary to protect fair use of signs for descriptive purposes. I believe that the objection under section 3(3)(a) is misconceived. In any event, it is based upon the premise that registration of the Memorial Fund and Signature marks will have the effect of preventing the use of the name or likeness of the late Princess on memorabilia about her. For the reasons already stated, that is, I believe, a false premise. This objection also fails.

Section 3(6) - Bad Faith

79. Sections 32(3) and 3(6) of the Act are as follows:-

“32.-(3) The application shall state 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.

3.-(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

80. Section 3(6) comes from the Directive. Section 32(3) is another “home grown” provision. The application forms in question all bear the statement of use or intended use of the marks as required by Section 32(3).

81. The opponent’s case is that the applicants’ intention was at all times to use the marks for the purpose of indicating that the user had made a contribution to the Memorial Fund. The opponent says that this is not trade mark use and that the applications are therefore an (albeit well intentioned) abuse of the system, and that the applications should therefore be refused because they have been made in bad faith.

82. There is no dispute that there is an intention to use the marks in question. The question is whether the proposed use is trade mark use and what is the consequence if it is not. In South Cone Incorporated v Bessant, Greensmith and Stringer, 16 May 2001, which as far as I am aware is unreported, Pumfrey J. was prepared to assume that the use referred to in the Section 32(3) is trade mark use. I respectfully agree with that.

83. In my earlier decision, I found that the use authorised by the applicants of the name Diana, Princess of Wales, was not trade mark use because, inter alia, the applicants’ evidence did not show that they had taken steps to control the quality of the goods/services offered under the sign.

84. Since that decision the case of Scandecor Developments AB v Scandecor Marketing AB and Another [2001] IP+T 668-763 (at 676) has come before the House of Lords. Lord Nicholls of Birkenhead, who gave the leading speech, stated in paragraphs 36-41, that:-

- 1) The purpose of a trade mark is to denote the goods or services of a business source;
- 2) The business source is the person who is for the time being entitled to use the mark;
- 3) Customers rely upon the self interest of the brand owner and licensee for their assurance of quality;
- 4) Customers are not to be taken to rely on the protection supposedly afforded by a legal requirement that the proprietor must always retain and exercise control over the licensee’s activities.

85. In the light of this finding I do not believe that the absence of pro-active controls over the quality of prospective licensees’ goods and services must, of itself, mean that the proposed use is not trade mark use. Nevertheless, the proposed use must in some sense indicate that the goods or services are those of an undertaking. The basis of Mr Miller’s case is that the use that the applicants propose is not to indicate the source of the goods/services but merely that

the source will donate some of the proceeds of the sale to the Memorial Fund.

86. On one view it may be questioned whether the use the applicants' propose in relation to goods is anything more than an adjunct to charitable fundraising services. However, one can raise funds for charity without engaging in any trade in goods. Where one seeks to do it by selling goods there may also be a trade in goods.

87. It is true that most (but not all) the applicants' evidence of their existing use of the Memorial Fund and Signature marks in relation to goods shows use of the marks alongside the names or marks of other businesses. However, even if this is representative of the applicants' future intentions, dual branding is not uncommon these days and such use does not necessarily mean that the respective marks are not being used to identify the businesses sources behind the goods. There is no rule that there can be only one business behind a particular product.

88. The applicants say that the marks are to be used to distinguish products authorised by the fund from those that are not. In that sense they contend that the mark is used to distinguish a business source of the products. In the light of Scandecor I I take the view that the nature of the use proposed by the applicants is, at worst, equivocal.

89. In South Cone , Pumfrey J. decided that unless the proposed use was clearly not of a trade mark character, an application to protect it could not be regarded as reprehensible. Before me Mr Miller accepted that the applicants in this case had not acted disreputably. He submitted that his "abuse of process" point could succeed in the absence of any disreputable behaviour because the matter should be judged objectively.

90. I reject that submission. I am sure it is right that an element of objectivity should be applied because otherwise applicants would have to be judged by their own moral standards. Nevertheless, there is a difference between saying that reprehensible behaviour should be judged by the standard of a reasonable person and that persons can be deemed to have acted in bad faith because a legal analysis of their intentions reveals doubts about whether the nature of the use they had in mind when making trade mark applications, qualifies as trade mark use under the law.

91. Unless the use the applicants propose is plainly not trade mark use the bad faith point must fail. The answer is not clear cut. The applicants have not acted reprehensibly in making these applications. The 'bad faith' objection must therefore fail.

Costs

92. The oppositions have failed. The applicants are entitled to a contribution towards their costs. I order the opponent to pay the applicant **£1000** in respect of each set of proceedings, making **£2000** in total.

93. In making this order I have borne in mind that similar (but not identical) evidence has been filed and that the cases were heard together. Nevertheless, the Signature mark case presented some different issues and this and the cost of handling separate sets of proceedings should be reflected in the costs awarded.

94. Mr Marsh asked for an additional award of costs because the Registrar originally indicated that the case could be settled off the papers yet the opponent insisted on a hearing. I have awarded the applicants the usual contribution to the cost of the hearing but no more. Parties have a right to be heard and should not be penalised for exercising it.

95. The sum stated above should be paid to the applicants within seven days of the end of the period allowed for appeal.

Dated this 25 Day of January 2002

Allan James
For the Registrar

Annex A: Order a copy

Annex B: Order a copy