

Case No: CH 1996 E No 1337

**IN THE SUPREME COURT OF JUDICATURE  
COURT OF APPEAL (CIVIL DIVISION)  
ON APPEAL FROM CHANCERY DIVISION  
THE HON. MR JUSTICE LADDIE**

Royal Courts of Justice Strand, London, WC2A 2LL

Date: 12.3.99

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Before:

**LORD JUSTICE SIMON BROWN  
LORD JUSTICE MORRITT  
and  
LORD JUSTICE ROBERT WALKER**

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**ELVIS PRESLEY ENTERPRISES INC**

**Appellant**

**-and -**

**SID SHAW ELVISLY YOURS**

**Respondent**

**Mr P. Prescott QC** (instructed by Eversheds for the Appellant)

**Mr R. Meade** (instructed by Cameron McKenna & Co for the Respondents)

Judgement: Approved by the court for handing down (subject to editorial corrections)

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## **Lord Justice Robert Walker**

### **I The litigation**

This is an appeal from an order of Laddie J made on 18 March 1997 in a trade mark case. On 26 January 1989 Elvis Presley Enterprises Inc (Enterprises) of Memphis, Tennessee made three applications to register trade marks under the Trade Marks Act 1938 (the 1938 Act). The numbers of the applications and the marks applied for were as follows :

1371624 signature 'Elvis A. Presley'  
1371627 ELVIS  
1371637 ELVIS PRESLEY

The first of these has been referred to as the signature mark. All three applications were for the same specification of goods, that is

"Toilet preparations, perfumes, eau de cologne; preparations for the hair and teeth; soaps, bath and shower preparations; deodorants, antiperspirants and cosmetics; all included in Class 3."

The applications survived their initial examination in the Patent Office and were advertised in the official journal on different dates between March and May 1991. On 27 December 1991 notices of opposition to all three applications were put in by Mr Sid Shaw, who trades as 'Elvisly Yours' and is registered proprietor of that trade mark for a wide range of goods in Class 3. The notices stated six grounds of opposition, including lack of distinctiveness and conflict with Mr Shaw's own mark. Mr Shaw's opposition led to a hearing before the Registrar, in the person of Mr M.J. Tuck as hearing officer. In a written decision dated 31 January 1996 Mr Tuck found that the grounds of opposition were not made out, and did not think it appropriate to exercise the Registrar's discretion to refuse registration. Mr Shaw appealed to the High Court, where Laddie J allowed his appeal, and Enterprises in turn appeals to this court.

### **II The legislation**

Before entering into the Judge's reasoning and the grounds of appeal it is necessary to identify the relevant statutory provisions. Any application to register a trade mark made since 31 October 1994 is determined under the Trade Marks Act 1994 (the 1994 Act). It is not a consolidating Act but was enacted to give effect to the Trade Marks Directive of the Council of what was then the European Economic Community (1989/104/ EEC). The 1994 Act must be construed in accordance with its community origins and aims and it is clear that it has made some important changes in the old law. The 1938 Act has in principle been repealed, but that is subject to the very important exception that under the

transitional provisions in Schedule 3 to the 1994 Act, the 1938 Act continues to apply to pending applications for registration. So Enterprises' applications have to be determined under the 1938 Act but if they result in registration the marks will then be subject to the provisions of the 1994 Act. One consequence of that is that as the new register has no division into Part A and Part B, the different tests laid down in the 1938 Act for registration in Part A and Part B respectively no longer have any useful purpose. For this diminishing class of pre- 1994 Act applications there are in effect two different entrance examinations for admission to the same institution. Before the 1994 Act the statutory law as to registration of trade marks had developed slowly but steadily since 1875, with the Trade Marks Act 1905 (the 1905 Act), as amended, being consolidated by the 1938 Act. Section 68 ( 1) of the 1968 Act contains some definitions which provide the best starting-point:

"mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof "trade mark" means [ with an irrelevant exception] a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user of that mark, whether with or without any indication of the identity of that person. ..

Apart from these definitions the crucial sections of the 1938 Act (replacing very similar provisions in the 1905 Act) are sections 9, 10, 11 and 12 and they must be set out in full (as amended by the Trade Marks (Amendment) Act 1984) : "Distinctiveness requisite for registration in Part A

9. ( 1) In order for a trade mark ( other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), ( c ) and ( d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

(2). For the purposes of this section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which-

- (a) the trade mark is inherently adapted to distinguish as aforesaid and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid. Capability of distinguishing requisite for registration in Part B

10. (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which-

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

#### **Prohibition of registration of deceptive, etc., matter**

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

#### **Prohibition of registration of identical and resembling trade marks.**

12. (I) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of-

- (a) the same goods,
- (b) the same description of goods, or
- (c) services or a description of services which are associated with those goods or goods of that description.

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the Court or the Registrar may permit the registration by more than one proprietor in respect of -

- (a) the same goods,
- (b) the same description of goods or
- (c) goods and services or descriptions of goods and services which are associated with each other, of marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or Registrar, as the case may be, may think

it right to impose,

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

(a) the same goods,

(b) the same description of goods, or

(c) goods and services or descriptions of goods and services which are associated with each other,

the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or on an appeal (which may be brought either to the Board of Trade or to the Court at the option of the appellant) by the Board or the Court, as the case may be," Near resemblance is defined in s. 68(2B) in terms of "so near as to be likely to deceive or cause confusion,"

Section 14 of the 1938 Act provides that a disclaimer by the proprietor may be required, as a condition of registration, where part of a mark is not separately registered or where a trade mark contained matter of a non-distinctive character, Section 17(2) confers on the Registrar a discretion of undefined scope to refuse an application or to accept it conditionally or unconditionally, and by s. 52 the same discretion is on appeal exercisable by the court.

Section 40 enables the Board of Trade to make rules for regulating practice under the 1938 Act. The rules in force immediately before the coming into force of the 1994 Act ( and so part of the old law for the purposes of its transitional provisions ) were the Trade Marks and Service Marks Rules 1986 (SI 1986/1319). Rule 18 of those rules was in the following terms,

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

The hearing officer referred to Rule 18 and indicated that it had been complied with in the case of Enterprises' applications. Without at this stage going far into the case law on the 1938 Act and its predecessors, I think it may be useful to mention one authority as to how far the elusive quality of distinctiveness is, in one way or another, a requisite of each of the five paragraphs of s. 9(1). Fanfold's application ((1928) 45 RPC 199 Tomlin J, ( 1928) 45 RPC 325 CA) was concerned with whether a stylised (but not heavily stylised) representation of 'Fanfold Ltd' was distinctive for the purposes of s. 9 of the 1905 Act (which was very similar but not identical to s. 9 of the 1938 Act: it designated paragraphs (a) to (e) as (1) to (5) respectively). The Registrar rejected the application (which was for paper forms, files and stationery) and his decision was upheld both by Tomlin J and by the Court of Appeal. Most of the argument turned on what is now s. 9(I)(a) but the section as a whole was also considered. Tomlin J said at page 203,

"It is to be observed, that paragraph (2)[now(b)] deals with signatures, and I think it may be rightly said that a signature is distinctive of the individual who signs. Paragraph (3)[now (c)] deals with an invented word or words, and invented words are certainly distinctive."

He also found the requirement implicit in paragraphs (1) and (4) (now (a) and (d)). The Court of Appeal reached the same conclusion. Lord Hanworth MR said at pp. 331- 2,

"In my judgement Tomlin J came to a right conclusion upon the meaning of section 9. I think it does require that there should be distinctiveness. Paragraphs ( 1 ), (2), (3) and ( 4) do not expressly refer to distinctiveness. Paragraph (5) says: ' Any other distinctive mark.' The use of the word 'other' seems to be of importance. .... That word 'distinctive' does not find its place in paragraph (1); but I do .not think it is lost from the whole section, for I think that section 9 must be read bearing in my mind the reference which applies to the whole of the section and incorporates the definition of 'distinctiveness' and also the conjunctive effect of 'any other distinctive mark' which is to be found in paragraph (5)."

Lawrence LJ said at page 333,

"It is clear that every mark in order to constitute a registrable trade mark must be capable of distinguishing the goods of a trader, but it appears to me unnecessary to consider the question whether a mark in order to come under paragraph ( 1) must be distinctive apart from the special or particular manner in which it is represented, because the legislature has assumed that, if represented in a special or particular manner it would be distinctive; this I think appears clearly from the opening words of paragraph (5)."

The principle to be extracted from this case is that distinctiveness is always required, but that in a case which is shown to fall squarely within what is now paragraph (a), (b) or ( c) of s. 9(1), the requirement of distinctiveness will - at any rate in the normal case - be satisfied without the need to show more. I shall come back to distinctiveness, and the other points of legal controversy, after considering the facts.

### **III**

#### **The facts and factual issues**

Most of the material facts are not in dispute. The following summary is gratefully taken from the judgement of Laddie J, to which reference may be made for more detail. There are some disputed issues of fact as to the scale and nature of the trading activities carried on in this country at various times by Mr Shaw or by or in connection with Enterprises, but none of these issues seems likely to be determinative of the matter. Mr Peter Prescott QC ( appearing in this court, as he did before the Judge, but not before the Registrar, for Enterprises) has conceded that his case on use under s. 9(3)(b) is not going to get him home if he cannot make out his case on inherent distinctiveness. There is also, surprisingly, a disputed issue of fact as to the authenticity of the signature mark which it is necessary to resolve.

Elvis Presley was born in Tupelo, Mississippi in 1935 and died in Memphis, Tennessee in 1977. He gained great fame and riches as a rock and roll singer and starred in many films. His fame has endured since his death and there are still devoted fans of his in many parts of the world. His house in Memphis, called Graceland, is still a place of pilgrimage for his fans, and there they can buy a wide range of souvenirs. Enterprises is based at Memphis and it runs Graceland. It carries on merchandising activities previously carried on by or on behalf of Elvis Presley. Mr Shaw does not dispute that Enterprises should be regarded as the successor to Elvis Presley's merchandising business. Mr Jack Soden (who is the chief executive officer of Enterprises, with which he has been associated since 1982) has made a statutory declaration referring to trade marks which Enterprises has for many years used in the United States. The statutory declaration also refers to some trading activities under those marks carried on in the United Kingdom during the 1980's. But the evidence is very short on detail and Mr Prescott has conceded (as already mentioned) that it is not going to get him home under s. 9(3)(b). Mr Sid Shaw has had a varied career. A newspaper article which he has exhibited describes him as

"a former kibbutznik, teacher, consulate official and advertising executive, Essex-University-educated Shaw is first and foremost the consummate salesman."

For the last 20 years of his career his activities have centred on Elvis Presley. He trades through a company named Elvisly Yours Limited but Mr Shaw personally is the registered proprietor of the trade mark ELVISLY YOURS which (in a cursive script with an elaborate E and Y) is registered for a wide specification of goods in class 3, but limited (as the applications by Enterprises are not limited) to goods relating to Elvis Presley. Mr Shaw's application for his trade mark was made on 17 November 1987. Mr Shaw's company makes wholesale and retail supplies of a range of goods, all somehow related to Elvis Presley, to customers in this country and overseas. It also publishes a magazine, Elvisly Yours, for Elvis Presley fans. The company did at one time supply goods for sale at Graceland itself, but Mr Shaw and Enterprises no longer enjoy an amicable relationship. There has been litigation between them in the United States resulting in an injunction against Mr Shaw and his company.

Mr Shaw himself has made statutory declarations as to the scope and scale of his trading activities, under the Elvisly Yours trade mark, in this country. The hearing officer recorded the evidence in Mr Shaw's statutory declarations and concluded that he had to accept it and give it such weight as it deserved (he put it that way because an application was made to him for cross-examination of Mr Shaw, who was appearing in person, but it was not pressed when it became apparent that Mr Soden was not available for cross-examination). The Judge found the evidence of use by Enterprises in the United Kingdom to be incapable of assisting it. He did not find it necessary to go into the issues of fact as to trading by Mr Shaw. Before this court Mr Prescott made some fairly telling criticisms of Mr Shaw's evidence as to his trading activities. Nevertheless I am satisfied that Mr Shaw and his company have traded under the Elvisly Yours mark on a significant scale since 1980 at latest, and in toiletries (including soap, on which Mr Prescott concentrated) since 1986.

No evidence of deception or of actual confusion was adduced by either side. So far as the evidence goes, there is no reason not to accept the Judge's observation

"that although Mr Shaw has sold millions of pounds worth of memorabilia bearing the name of Elvis or Elvis Presley over the last 18 or so years, it has not been suggested that anyone has ever thought they emanated from Enterprises".

On the contrary, occasional references in the Elvisly Yours magazine to disputes between Mr Shaw and Enterprises suggest that Elvis Presley fans in this country who read the magazine would be well aware of the true state of affairs. The Court gave leave to Enterprises to adduce further evidence as to the names of well-known persons or fictional characters which have been registered as trade marks in recent years. But the court has not derived any real assistance from that evidence in deciding the issues on this appeal. There remains the curious issue of the authenticity of the signature. The signature mark 'Elvis A Presley' is in a cursive and rather irregular (but nevertheless legible) script. It does not appear to have any close resemblance to any of the different signatures which appear on the range of products shown in the exhibits. Indeed, none of the signatures on products appears to be in the form 'Elvis A Presley'.

We were told on instructions that Enterprises already has a signature mark (in the same form as that in application no.1371624) registered for goods of different specifications, and that when those earlier applications were made an affidavit dated 13 August 1984 as to the authenticity of the signature mark was sworn by a Mr Hanks (an American accountant and one of Elvis Presley's executors) and lodged with the Registrar. When application no.1371624 was made there was correspondence between the Registrar and the trade mark agents acting for Enterprises, and the outcome was that the Registrar did not call for a new affidavit. The notice of opposition by Mr Shaw did not expressly take any point on authenticity, but the counter statement on behalf of Enterprises stated in paragraph 2,

"The mark is the signature of the late Elvis A.Presley and fully satisfies the distinctiveness and other requirements of the Act. "

It appears that before the hearing officer Mr Shaw merely pointed out that the signature mark was significantly different from what appeared on the exhibited merchandise. Before the Judge the matter was taken rather further and Mr Prescott applied for leave to adduce as further evidence the affidavit of Mr Hanks. The Judge refused leave in a short extemporary judgement. No transcript of it is available, but counsel agree that the Judge's reasons were that the affidavit was not open to public inspection, that it had not been referred to before the hearing officer, and that it would therefore be unfair to Mr Shaw to let it in on appeal. The Judge made no finding as to the authenticity of the signature. Enterprises did not seek to appeal against the Judge's ruling on evidence, either at once or after judgement (since the decision against all the marks was based on different and wider grounds) but Mr Shaw has now raised that issue in his respondent's notice. Mr Prescott renewed his application to this court to let in the affidavit but we declined to do so.

We must therefore put out of our minds the existence of Mr Hanks' affidavit. The passage in the statutory declaration of Mr Soden on which Mr Prescott relies ("items which were sold and continue to be sold under the trademarks Elvis Presley signature and the Elvis A.Presley signature, the subject of the present application") seems to me of almost negligible probative value. Mr Prescott also relies on the general presumption that things have been done validly and properly, rather than the reverse, and the inherent improbability that for no discernible reason Enterprises would seek to register a forgery rather than a genuine signature. Had the authenticity of the signature been an issue from the outset, and had Mr Shaw been in a position to put forward any sort of positive case against authenticity ( apart from pointing to the variation between different signatures) I would have felt bound to conclude that Enterprises had not discharged the burden of proof which lies on it. But in all the circumstances of this case I would hold that Enterprises can, albeit by a narrow margin, succeed on the issue of authenticity by reliance on the presumption, the probabilities and the confirmation, tenuous though it is, provided by Mr Soden.

I must also refer to a difference in terminology which was indicative of a difference of principle between the parties. Both sides put in evidence of the type of goods which have been sold, or are currently sold, by Enterprises and Mr Shaw's company respectively. Mr Soden exhibited a publication called 'Elvis Collectibles' which is described as "an identification and value guide to hundreds of pieces of memorabilia for the most promoted celebrity of them all." He also e-exhibited pictures of some of the goods sold through an outlet (now closed) which Enterprises had in England. Mr Shaw has exhibited several copies of the magazine 'Elvisly Yours', which contain numerous advertisements for his company's goods. The 'Elvisly Yours' products cover what is, in terms of specifications for trade mark purposes, quite a wide range: magazines, calendars, framed and unframed pictures, mugs, T -shirts, soap, cheap jewellery, pennants, rosettes, and so on. Some of these items are described in the magazines as 'memorabilia' or 'collectibles'. Goods of the same type appear in Mr Soden's exhibits and he says of them,

"These products are, in some instances, souvenirs or memorabilia of Elvis Presley, and in other instances, commercial consumer items."

Mr Soden then referred (in terms which I have already quoted) to trade marks. He sought to identify the trade marks with commercial consumer items, and particularly with items such as soap or cologne which diminish and disappear with use.

The Judge seems to have been disinclined to accept any sharp distinction between 'memorabilia' and commercial consumer goods. The judgement refers to "the wide range of products sold as Elvis Presley memorabilia" and contains several other references to memorabilia, mementoes and souvenirs. I think the Judge was right not to accept any sharp distinction. The consumer is a label which economists use to distinguish the eventual end-purchaser from the producer, but it is not essential that consumer goods should be useful, or that they should have a predictably short life. I think the Judge was right to conclude that all these products, including the soap and the cologne, were being marketed primarily on the strength of their bearing the name or image of Elvis Presley.

The Judge did not go so far as to say that the real product was Elvis Presley himself, but that thought seems to have been not far below the surface of the Judge's reasoning on distinctiveness.

#### **IV Distinctiveness**

In relation to all three applications the Judge allowed the appeals on grounds related to distinctiveness or capability of distinguishing under ss 9 and 10 of the 1938 Act. He dealt only briefly with ss. 11 and 12 but indicated that Enterprises would fail under those sections also. In his judgement the Judge said,

"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."

In *Re Joseph Grosfield and associated cases* [1910] 1 Ch 130, 145 (1909) 26 RPC 837, 857 *Fletcher Moulton LJ* said that it was a fallacy to assume any "natural and innate antagonism between distinctive and descriptive as applied to words." Nevertheless the authorities show that one of the most common reasons for failure on the ground of lack of distinctiveness is if a mark is descriptive of the goods on which it is to be used. Lord Simonds LC said in *Copper Works application* (1953) 71 RPC 150,153,

"Paradoxically perhaps, the more apt a word to describe the goods of a manufacturer, the less apt it is to distinguish them: for a word that is apt to describe the goods of A, is likely to be apt to describe the similar goods of B."

One familiar example is 'Shredded Wheat' (see *Canadian Shredded Wheat v Kellagg* (1938) 55 RPC 125; *Shredded Wheat v Kellagg* (1940) 57 RPC 137). Another example, much discussed before the Judge and in this court, is the *Tarzan trade mark case* [1970] RPC 450. The essential facts are well summarised in the headnote,

"Tarzan, a well-known fictitious character with exceptional physical attributes, was created by an American writer of adventure stories and was later portrayed in films. The applicants, an American company who were exclusively entitled to produce films, records and merchandise centred on the character Tarzan, applied to register the word TARZAN in class 9 in respect of films and magnetic tape recordings and in class 28 in respect of games, toys, playthings, and gymnastics and sporting articles. The Registrar refused to register the mark on the grounds that TARZAN was not an invented word, that it had a direct reference to the character and quality of goods and that it was not distinctive. An appeal to the High Court was dismissed and the applicants appealed further to the Court of Appeal."

This court dismissed the appeal. So far as the applicants relied on s. 9 (1)(c) , they failed because 'Tarzan ' could no longer be regarded as an invented word. It had passed into the language. In reaching that conclusion the court followed Halt's trade mark ( 1896) 13 RPC 118 in which Lindley LJ said of Trilby' (at page 121)

"It may have been once an invented word ...but it long ago became too well-known to fall under that head."

That point does not arise in this case: it is common ground that Elvis is not an invented word but is ( or was until Elvis Presley achieved world-wide fame) a fairly unusual first or given name. However the grounds on which the Tarzan application was rejected under s. 9(1)(d) are in point. In relation to films (in class 9) the word Tarzan was held not to be registrable because it referred directly to the subject-matter of the film ( and would have been deceptive had it not done so: see the observations of Salmon LJ at pp 454 and 456, Edmund Davies LJ at pp. 458- 9, and Cross LJ at page 460). The decision in relation to games, toys, etc. (in class 28) seems less clear and indeed Edmund-Davies LJ (at page 459) described it as not so straightforward. It seems to have turned (see at pp. 457 and 459) on the applicants' own evidence that the merchandise was "centred on" the character of Tarzan. Mr Soden's evidence, by contrast, seeks to distinguish between the memorabilia (which are clearly centred on the personality of Elvis Presley) and what Mr Soden calls 'commercial consumer Items .

Descriptiveness of the goods in question is not the only way in which a proposed trade mark may fail in terms of distinctiveness. It may fail simply because it is too commonplace, such as a surname ( with or without an added first name) of fairly frequent occurrence. The court's approach 80 years ago appears from *Re Burford's application* [1919] 2 Ch 28, (1919) 36 RPC 139, in which the dissenting judgement of Scrutton LJ is particularly illuminating. Since then the practice of the Patent Office has developed and there are now quite elaborate rules, set out in the Registry Work Manual, which act as a guide to examiners but do not have the force of law. The official practice of referring to telephone directories (as a guide to the frequency of surnames) continues but that of objecting to women's first names for cosmetics (mentioned by the Judge) has, it seems, been abandoned (see an article by Debrett Lyons in [1997] 10 EIPR 613, 615). The Work Manual is an impressive demonstration that a measure of uniformity can be introduced into the assessment of distinctiveness (which at first sight might seem to be a very subjective matter). However in case of objections being made and rights of appeal being exercised the hearing officer and the court must make up their own minds ( although with the view of the hearing officer, who will usually have great experience in these matters, being given a good deal of weight: see for instance Lord Wright in *Re J & p Coats* , application (1936) 53 RPC 355,375).

The two main obstacles to distinctiveness -being too descriptive and being too commonplace -come together in the very well-known statement in the speech of Lord Parker in *Registrar of Trade Marks v W& G Du Cros* [1913] AC 624,634 -5

"In my opinion, in order to determine whether a mark is distinctive it must be considered quite apart from the effects of registration. The question, therefore, is whether the mark itself, if used as a trade mark, is likely to become actually distinctive of the goods of the person so using it. The applicant for registration in effect says, "I intend to use this mark as a trade mark, i.e., for the purpose of distinguishing my goods from the goods of other persons," and the Registrar or the Court has to determine before the mark be admitted to registration whether it is of such a kind that the applicant, quite apart from the effects of registration, is likely or unlikely to attain the object he has in view. The applicant's chance of success in this respect must, I think, largely depend upon whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some 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 Acts a monopoly in what others may legitimately desire to use."

This passage is a convenient summary of a complex point but it is important ( and will be even more important in cases under the 1994 Act) not to attempt to construe it as if it were an Act of Parliament. In particular, the reference to what other traders might legitimately wish to use does to some extent beg the question. The law of trade marks is inevitably technical and what is or is not legitimate cannot always be determined simply a matter of instinct or conscience. That is particularly the case where trade mark law overlaps with the practice of character merchandising.

## V

### **Character merchandising**

Both sides referred in their written and oral submissions to character merchandising. We were referred to several recent cases (both in this country and in Australia) and to articles in academic publications and in the trade press. Character merchandising has been big business for at least 30 years. As long ago as 1977 the Whitford Committee considered, but did not regard as feasible, the introduction of a new ' character right , which would fill a perceived gap between the law of copyright and that of passing off.

The traditional attitude of the English court to claims of that sort appears clearly from the judgement of Wynn-Parry J in *McCulloch v May* [1947] 2 AER 845, 851, the case in which 'Uncle Mac' of BBC's Children's Hour sued the distributors of 'Uncle Mac's Puffed Wheat,'

"On the postulate that the plaintiff is not engaged in any degree in producing or marketing puffed wheat, how can the defendant, in using the fancy name used by the plaintiff, be said to be passing off the goods or the business of the plaintiff ? I am utterly unable to see any element of passing off in this case. If it were anything, it were libel, as to which I say nothing. Passing off, in my judgement, it certainly is not. If I were to accede to the plaintiff's claim I should, as I see it, not merely be extending quite

unjustifiably the scope of the action of passing off, but I should be establishing an entirely new remedy, and that I am quite unprepared to do"

The reference to libel was of course an echo of *Tolley v Fry* [1931] A.C. 333, but Mr Tolley's defamation action was founded on the fact that he was an amateur golfer, not a professional. Nearly 20 years later Walton J granted an interlocutory injunction to restrain passing-off in *Tavener Rutledge v Trexapalm* [1975] FSR 479, the *Kojakpops/Kojak Lollies* case. In that case it was the plaintiff which had the goodwill in its brand of lollipops, but the defendant which had a licence ultimately derived from Universal City Studios, California, the owners of rights to the television series 'Kojak'. Walton J took the view (at pp. 483 -4) that there was no common field of activity, that is no intersection between the production of films and the production of lollipops. He referred (at page 485) to the business of character merchandising as being well established and to the defendant's argument that its licence was a defence since members of the public would assume that the plaintiff's *Kojakpops* had been licensed by the owner of the rights in the television series. Walton J rejected that argument as not established by the evidence. He said (at page 485),

"I think that it is a good long way off, if it ever does arise, but there may come a time when the system of character merchandising will have become so well known to the man in the street that immediately he sees '*Kojakpops*' he will say to himself: 'They must have a licence from the person who owns the rights in the television series.'"

But even that, Walton J said, would be insufficient, as the defendant would also have to show that the general public would assume that the licensor had a system of quality control, so that the use of the celebrity name would be a guarantee of quality. In the following year in *Lyngstad v Anabas Products* [1997] FSR 62 Oliver J refused an interlocutory injunction to the pop group *Abba* who were complaining of unlicensed sales of transfers and badges depicting the group. He referred to the decision of the High Court of New South Wales in *Henderson v Radio Corp* [1969] RPC 218, in which the decision in *McCulloch v May* was heavily criticised. Oliver J (at page 67) thought that might be

"to some extent based on a misconception of what Wynn-Parry J was saying in *McCulloch v May*. The expression "common field of activity" is not, I think, a term of art, but merely a convenient shorthand term for indicating what the High Court of Australia itself recognised, that is to say, the need for a real possibility of confusion, which is the basis of the action."

In the case before him Oliver J was not satisfied on the evidence that there was a real possibility of confusion. He said at pp. 67 -8,

"I do not think that anyone reading the advertisements of which complaint is made or indeed receiving the goods described in them could reasonably imagine that all the pop stars named in the advertisements were giving their approval to the goods offered or that

the defendants were doing anything more than catering to a popular demand among teenagers for effigies of their idols."

Character merchandising was considered by the House of Lords for the first time in *Re American Greetings Corporation's application* [1984] 1 WLR 189, the 'Holly Hobbie' case. That was a trade mark case (unlike the authorities mentioned above) and it was concerned with "trafficking" under s. 28(6) of the 1938 Act (a point not taken at any stage in the present case). There is a striking difference between the speeches of Lord Bridge (who concurred in the result with undisguised reluctance) and Lord Brightman (with whom the rest of the House agreed). Lord Bridge said at page 192,

"It will be bad enough, in my view, that the whole field of character merchandising will now be wide open to piracy. The protection, if any, of the original inventor of the character will lie in the uncertain remedy of a passing off action. This situation seems likely to generate a mass of difficult and expensive litigation which cannot be in the public interest. In short, though I can find no escape from section 28(6) of the Act of 1938, I do not hesitate to express my opinion that it has become a complete anachronism and that the sooner it is repealed the better."

Lord Brightman's view, although not positively hostile to character merchandising, was notably less tender (at page 197),

"For my part, I am quite prepared to accept that character merchandising, in the sense of the exploitation of the reputation of famous marks by making them available to a wide variety of products, has become a widespread trading practice on both sides of the Atlantic. It may well be that it is perfectly harmless and in most cases probably deceives nobody. These considerations do not, however, help to decide what Parliament intended by trafficking in trade marks or justify placing a gloss on the meaning to be attributed to that expression."

Those cases (and some later cases in Australia) were the background to the *Teenage Mutant Ninja Turtles* case, *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145, a decision of Sir Nicolas Browne-Wilkinson V-C. The Vice-Chancellor granted an interlocutory injunction to restrain the defendants from licensing the use of drawings of turtle characters which copied the concept of the *Ninja Turtles* cartoon characters rather than being exact or nearly exact copies. The defendants had no licence from the plaintiffs, who owned the copyright in the *Ninja Turtles* cartoon. The plaintiffs alleged copyright infringement as well as passing-off. The Vice-Chancellor held (at page 154) that there was an arguable case of copyright infringement. He also held, after a fairly full examination of the authorities, that there was an arguable case in passing off. It is important to note that those two conclusions were closely linked. After referring to the *Abba* case the Vice-Chancellor said at page 158,

"I do not find anything in that case inconsistent with the Australian cases. Again, it was concerned with licensing rights in a name as opposed to licensing rights in what is undoubtedly copyright material. It may be that different factors apply in such a case,

though those cases may, given the change in trading habits, require reconsideration on a future occasion if the evidence before the court is different. In my judgement the three English cases [Wambles v Wamble Skips [ 1977] RPC 99, Kojak and Abba] do not touch on a case such as the present where the plaintiff clearly has copyright in the drawings and is in business on a large scale in this country in licensing the use of the copyright in those drawings. I can see no reason why, in those circumstances, the defendants should be allowed to misrepresent his goods in that way."

Laddie J described the Vice-Chancellor's judgement as an extemporary judgement on an interlocutory application, which it was, but the hearing lasted three days and the judgement is, in my respectful view, very clear and convincing. It does not give a green light to extravagant claims based on any unauthorised use of a celebrity's name, but makes clear ( especially in the passage which I have just quoted) the relatively limited scope of the principle on which it proceeds.

However this appeal is not an appropriate occasion on which to attempt to define precisely how far the law of passing off has developed in response to the growth of character merchandising, still less to express views as to how much further it should develop or in what direction. This appeal is concerned solely with trade mark law and although I have (out of deference to the interesting submissions made to us) gone through some of the principal authorities concerned with character merchandising which were cited to us, they are relevant to the appeal only so far as they affect either (i) distinctiveness and distinguishing under ss. 9 and 10 of the 1938 Act or (ii) deceptiveness or confusion under ss. 11 and 12. I did not find it easy to see exactly how the character merchandising cases were said to fit into counsel's arguments on ss. 9 -12, and I may have overlooked some of the refinements of the arguments. But Mr Prescott relied on the cases principally in order (i) to suggest that the Tarzan decision must be restricted to its special facts (a fictitious character whose name had once been an invented word) and is no longer (if it ever was) of wide significance and (ii) to suggest that the Judge misapplied Lord Parker's test in *W & G du Cros*, because other traders could not legitimately wish to use the names Elvis and Elvis Presley. Therefore, Mr Prescott said, the Judge was wrong to conclude that the ELVIS and ELVIS PRESLEY marks have very little inherent distinctiveness.

In his written and oral submissions Mr Prescott enlarged on these basic points. He argued that the law has now evolved to the stage where there is a general rule that a trader may not make unauthorised use of the name of a celebrity in order to sell his own goods. He expressed the rule primarily in terms of a living celebrity, but argued that the death of Elvis Presley does not matter in view of his abiding fame and Enterprises' unchallenged status as his successor. Mr Prescott allowed some exceptions to the rule ( comparable, although he did not put it like that, to the doctrine of 'fair dealing' in the law of copyright infringement) such as the publication (without copyright infringement) of portrait photographs or biographical material. He mentioned the Abba case as an example falling within the exceptions. But (in the words of Mr Prescott's written submissions)

"those instances -the 'product' is really text or other information about the celebrity -are remote from the present case. We are concerned with consumable commercial items like soap, toothpaste and perfume, the general case."

In the general case, Mr Prescott submitted, to use the name of a living celebrity for the purpose of selling a consumable commercial item implies authority, and therefore endorsement, by that person. He said that as a matter of everyday experience, reputable traders do not use the name of a living person in connection with their merchandise without obtaining authority. That had been a matter of judicial notice for 70 years, he said, with a reference to *Tolley v Fry*. (But, as I have already noted, it was an essential part of Mr Tolley's case that he was an amateur in days when the distinction between amateur and professional sportsmen was still very important. That brings out one of many paradoxical features of this case, that some celebrities wish to prevent 'appropriation of personality' as a means of defending their privacy; others wish to prevent unauthorised appropriation so as to secure a monopoly of commercial exploitation of their names, images and fame. The British Code of Advertising Practice evidently manages to cover both extremes: see Frazer, *Appropriation of Personality -A New Tort ?* (1983) 99 LQR 281,282.)

Mr Prescott also relied on an assertion of the same general role in his submissions on ss. 11 and 12. *Enterprises* was, he said, the undisputed successor to the rights which Elvis Presley had: how could there be any deception or confusion in *Enterprises* using for its trading purposes names which are so readily recognised as referring to the world-famous singer whose rights now belong to *Enterprises* ?

Mr Meade challenged almost all these submissions. He described it as a bold contention that in any case of use of a well-known name (whether the name was that of an individual celebrity, living or dead, or a fictional character) there was universal or general public assumption that use of the name must have been franchised. (In some cases there will be a further twist as to whether the celebrity is real or fictional, or a mixture of the two: *Kojak* was played by one well-known actor but *James Bond* by at least three; Mr Paul Hogan was well-known for commercials on Australian television before he played *Crocodile Dundee*. But it is unnecessary to pursue that here.) Mr Meade said that any such assumption must be proved by evidence appropriate to the particular case, and could not be established by citation of what had been said in other cases on different facts (and he referred to Lord Oliver's observation in the *Jif Lemon* case, *Reckitt & Colman Products v Borden* [1990] RPC 341, 406, that in this branch of the law reference to other cases is not of any real assistance except analogically).

Mr Meade submitted that the Judge was right to conclude that the ELVIS and ELVIS PRESLEY marks have very little inherent distinctiveness, especially when applied to goods which are sold as memorabilia of Elvis Presley, or when applied to goods as decoration. He described Elvis Presley as having become an important part of popular culture whose name and image other traders might legitimately wish to make use of. To the paradox which Mr Prescott put in the forefront of his submissions -

"Can it be the law that the more famous a man becomes, the harder it will be for him to register his name as a trade mark in respect of goods in which he intends to trade ?"

-Mr Meade would give an affirmative answer, subject to the important qualification that the answer applied to goods sold (in the Judge's words) as "memorabilia and mementoes" of Elvis Presley and in circumstances where the average purchaser "is buying a likeness, not a product from a particular source." As to Mr Prescott's submissions on ss. 11 and 12, Mr Meade said that Enterprises could not ( any more than the defendant in the Kojak passing-off case could) rely on a title derived from the owners of other intellectual property rights which were not being infringed. Enterprises had, Mr Meade said, failed to educate the British public that Elvis and Elvis Presley were being used by Enterprises and its licensees in a trade mark sense.

## VI

### **The judgement of Laddie J**

The views of the Registrar (in the person of the hearing officer) are entitled to respect. But so also are the views of Laddie J, a judge of great experience (at the bar and on the bench) in intellectual property matters. I intend no disrespect to the hearing officer if I concentrate on the judgement immediately under appeal.

I have already referred to many important passages in the judgement but it may be helpful to outline its general shape and identify the crucial parts of the Judge's reasoning and conclusions. The judgement begins with the uncontroversial facts and some observations about names not generally being subjects of ownership, whether by way of copyright or otherwise. The Judge referred to the replacement of the 1938 Act by the 1994 Act and to the disappearance of the distinction between Part A and Part B registrations. Then he discussed and reached conclusions on the three marks in turn, although naturally enough he devoted most space to the first mark which he considered, the ELVIS mark ( applied for under s. 9). He then dealt much more briefly with the ELVIS PRESLEY mark (applied for under s. 10). Finally he dealt with the signature mark (applied for under s. 9).

He concluded that none of the marks merited registration because all were lacking in sufficient inherent distinctiveness to succeed without evidence of factual distinctiveness (which, as Mr Prescott concedes, was not there). The Judge did not discuss ss 11 and 12 in relation to the ELVIS and ELVIS PRESLEY marks beyond the brief comment that he would have difficulty seeing how Mr Shaw's extensive use of his registered mark could fail to give rise to an objection. He did consider ss. 11 and 12 in relation to the signature mark and concluded that its similarity to Mr Shaw's mark would be likely to give rise to deception or confusion and so constituted a further obstacle to registration. 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 goods of the sort advertised by Elvisly Yours (or by Enterprises in the United States) the commemoration of the late Elvis Presley is the product, and the article on which his name or image appears (whether a poster, a pennant, a mug or a piece of soap) is little more than a vehicle. I consider that the Judge was right to treat all these goods as memorabilia or mementoes, and not to treat some as being in a different class of consumable commercial goods. (On any view, of course, these categories cut across the statutory classes of goods. ) Given that conclusion, and given that the Tarzan decision was binding on him (as it is on this court) the Judge's final conclusion as to very low inherent distinctiveness followed almost inevitably, and factual distinctiveness is no longer asserted. I feel more doubt about the Judge's clear but not fully reasoned view that the ELVIS mark would also have failed under ss 11 and 12. The hearing officer said that Mr Shaw's Elvisly Yours mark

"is in my view a clever invention a sort of mock valediction. I have no evidence before me as to how the public would view these marks, but my own reaction to them is that the opponents' mark draws special attention to itself and this would serve to reduce any possibility of confusion."

I am inclined to agree with that view, and it derives some support from the point (made by Mr Meade himself, for another purpose) that there is no positive evidence of any actual confusion during the period of 20 years when both sides have been trading. However as I think the Judge was right about distinctiveness it is not necessary to express a final view on the alternative ground of objection. The Judge then dealt with the ELVIS PRESLEY mark quite briefly, and largely by reference to the explanation of s. 10 of the 1938 Act and Part B registrations in Kerly, Law of Trade Marks and Trade Names, 12th ed. paragraphs 8 -74 to 8 -76. The most relevant point is in paragraph 8-74,

"[The 1938 Act] faced the Registry and the courts with the need to define registrability for new and newish marks. Here a sort of rule of thumb is available: to ask whether the mark is one a rival trader would want to use in referring to his goods [ with a reference to A/ways [ 1986] RPC 93] and if so, whether it has gone too far towards distinctiveness for an honest rival to do so ?"

The ELVIS PRESLEY mark differed from the ELVIS mark by the addition of a not particularly common surname. Had it been almost any other surname (I except Costello) it would have made the mark more distinctive in the trade mark sense. But in this case it simply confirmed the descriptive character of the mark. In those circumstances I think the Judge was bound to come to the same conclusion about the ELVIS PRESLEY mark, despite that application being for Part B registration. The Judge might also have exercised some element of discretion under s. 17 so as not to grant registration under the less demanding test in s. 10 when the effect (under the transitional regime of the 1994 Act) would have been precisely the same as if the mark had passed the more demanding test in s. 9. But there is no indication that that contributed to the Judge's decision and I need say no more about it.

Finally the Judge considered the signature mark (without, as I have noted, reaching any conclusion as to its authenticity). He set out and discussed the structure of s. 9(1) of the 1938 Act and said,

"Although the Registry and the court must start from the premise that signatures are prima facie distinctive, they are not inevitably so. .. Someone. ..may adopt a signature which consists of his surname spelt out in precise capitals or in a perfect script which is indistinguishable from, say, Times Roman font. Such writings, though signatures, would be indistinguishable from the printed form of the name and, it seems to me, would not be distinctive."

The presumption mentioned at the beginning of that passage is in line with what Tomlin J said, and this court seems to have approved, in *Fanfold*. But the example given by the Judge is a very extreme case -so extreme that the court might simply decline to treat the mark as a signature at all. The 'Elvis A Presley' signature mark is miles away from that and I consider that the Judge was wrong, especially in the light of *Fanfold*, to conclude that the signature mark was not distinctive under s. 9(1)(b). However I agree with the Judge's alternative ground of decision under ss. 11 and 12. Mr Shaw's registered Elvisly Yours mark is in a cursive script with a Greek E which (while more regular and more florid) bears at least some resemblance to the Greek E at the beginning of the Elvis A Presley signature. The test as explained in *Pianotist's application* (1906) 23 RPC 774 and *Smith Hayden's application* (1946) 63 RPC 97 is whether, if the two rival marks are used in a fair and normal manner, the court is satisfied that there is no reasonable likelihood of deception or confusion being caused to a substantial number of members of the public. For this purpose the public is to be regarded as ordinary persons, neither specially careful nor specially careless, who would be in the market as possible purchaser of the goods in question. The burden of proof is on the applicant for the later registration.

The hearing officer considered all three marks together in relation to ss. 11 and 12 in turn, and concluded that there was no valid objection to any of them as regards deception or confusion. I have already indicated that I am inclined to agree with this view in relation to the word marks ELVIS and ELVIS PRESLEY. But the signature mark appears to me to call for separate consideration, because its impact is more visual and it and Mr Shaw's mark share a cursive script. It is very much a matter of impression, on which lengthy reasons are inappropriate. I prefer the Judge's view on this point.

I would therefore dismiss the appeal in respect of all three applications.

### **Lord Justice Morritt**

Elvis Presley, the exceptionally well known rock and roll singer, died in 1977 aged 42. Both during his lifetime and after his death a trade in souvenirs, memorabilia and consumer items associated with his name and memory was carried on in the United States and elsewhere under the name or mark of ELVIS or ELVIS PRESLEY by the appellant Elvis Presley Enterprises Inc. ("EPEI") from 1956 to 1977 and from 1982 to the present and by the estate of Elvis Presley from 1977 to 1982. On 17th November 1987 the

respondent Sid David Shaw applied, pursuant to Trade Marks Act 1938, to register in the United Kingdom the mark ELVISLY YOURS in respect of toiletries (class 3 goods) "all relating to the late Elvis Presley". On 25th January 1989 EPEI made comparable applications in respect of toiletries included in class 3 but not limited to those relating to the late Elvis Presley for the registration of three separate marks, namely a manuscript reproduction of ELVIS A PRESLEY ("the Signature Mark"), the name in plain block capitals EL VIS and the names in plain block capitals ELVIS PRESLEY.

On 6th December 1990 the mark ELVISLY YOURS was duly registered in the name of Mr Shaw. In June and December 1991 Mr Shaw gave notice of his opposition to the applications of EPEI. On 31st January 1996 the Registrar dismissed Mr Shaw's opposition. Mr Shaw appealed to the High Court pursuant to s.18(6) Trade Marks Act 1938. By his order made on 18th March 1997 Laddie J allowed Mr Shaw's appeal and directed the Registrar to refuse EPEI's applications. This is the appeal of EPEI from the order of Laddie J. The circumstances relevant to this appeal have been fully described by Robert Walker LJ. I gratefully adopt his account of them. The issues for our determination fall into two broad categories, namely distinctiveness and the likelihood of confusion. Such issues arise in respect of three marks which, though similar to each other, are not the same. It is therefore necessary to give separate consideration to each mark in respect of each issue.

### **Distinctiveness**

A "trade mark", as defined by s.68(1) the Trade Marks Act 1938, is "...a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, ..." Thus it is an essential feature of a trade mark that it should indicate a connection in the course of trade between the goods in respect of which it is registered and the person having the right to use the mark. A trade mark must indicate the source of the goods not their type or quality. A mark, in order to indicate the source of goods, must be distinctive. The requirements for distinctiveness are set out in ss. 9 and 10 Trade Marks Act 1938. The relevant provisions are:

"9. (1) In order for a trade mark ( other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions of the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its

distinctiveness.

(2) For the purposes of this section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which - (a) the trade mark is inherently adapted to distinguish as aforesaid; and (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

10. (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid."

Each of these provisions is encrusted with the authority of decided cases. Most of the cases are illustrative of the application of the statutory provisions and do not require specific consideration. But it is necessary to refer to a few of them for the propositions they establish or the light they throw on the statutory provisions. It is clear from the decision of this court in *Re Fanfold* (1928) 45 RPC 325 that in the case of an application for registration in Part A a mark which comes within any of sub-paragraphs (a) to (d) of s. 9 (1) must be distinctive

"so that there may be an indication that the goods on which the mark is put are the goods of the proprietor, and the distinction must be one which is adapted to distinguish those goods of the proprietor for the purpose of enabling the definition of a trade mark to be fulfilled."

Thus a mark which satisfies the provisions of any of subparagraphs (a) to (d) may, no doubt, be treated as *prima facie* distinctive, but if its registration is opposed such satisfaction may not be sufficient. The classic exposition of the requisite distinctiveness is contained in the speech of Lord Parker in *The Registrar of Trade Marks v W & a Du Cros Ltd* [1913] AC 624. The applicants sought to register two marks "W & a" in ordinary block letters and the other consisting of the same letters and hieroglyph but in a running hand with a distorted tail to the "a". The applicants sought to register them in connection with their taxi business. The House of Lords held that they were not distinctive and, therefore, not registrable. In the course of his speech (p.634) Lord Parker said:

"In my opinion, in order to determine whether a mark is distinctive it must be considered quite apart from the effects of registration. The question, therefore, is whether the mark itself, if used as a trade mark, is likely to become actually distinctive of the goods of the person so using it. The applicant for registration in effect says, "I intend to use this mark as a trade mark, i.e., for the purpose of distinguishing my goods from the goods of other persons", and the Registrar or the Court has to determine before the mark be admitted to registration whether it is of such a kind that the applicant, quite apart from the effects of registration, is likely or unlikely to attain the object he has in view. The applicant's chance of success in this respect must, I think, largely depend upon whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some 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 Acts a monopoly in what others may legitimately desire to use. For example, names (unless represented in some special manner) and descriptive words have never been recognised as appropriate for use as trade marks. It is true that they became registrable for the first time under the Act of 1905, but only if distinctive, and they cannot be deemed distinctive without an order of the Board of Trade or the Court. This restriction does not apply to marks consisting of a letter or combination of letters, but before such a mark be accepted the Registrar of the Court has to be satisfied that it is adapted to distinguish the goods of the applicants from those of others. It need not necessarily be so adapted, and whether it is or is not so adapted appears to depend largely on whether other traders are or are not likely to desire in the ordinary course of their business to make use in connection with their goods of the particular letter or letters constituting the mark."

In *Yorkshire Copper Works Ltd's Application* (1953) 71 RPC 150 Lord Simonds LC pointed out (p. 154) that

"...paradoxically perhaps, the more apt a word is to describe the goods of a manufacturer, the less apt it is to distinguish them: for a word that is apt to describe the goods of A, is likely to be apt to describe the similar goods of B ."

In the same case (p.155) Lord Asquith of Bishopstone observed that

"Distinctiveness is defined in subsection (2) as meaning some quality in the trade mark (if I may paraphrase) which earmarks the goods so marked as distinct from those of other producers of such goods. It is not enough that it should earmark the goods as complying with a particular description, or as originating from a particular geographical area, or having claims to a particular excellence."

In his written argument counsel for EPEI helpfully analysed the many reported cases in which a mark has been found not to be distinctive into five classes, namely, geographical names, laudatory or descriptive words, simple initials, depictions of the goods themselves and/or common surnames and indicia from a limited stock available to the trade. Such categories are not, of course, closed. The question in each case must remain whether the

mark satisfies the statutory provisions to which I have referred as illuminated by the judicial pronouncements which I have mentioned.

### **The Signature Mark**

I consider first the Signature Mark. EPEI contend that it comes within subparagraph (b) of s. 9(1) as the signature of Elvis Presley, the predecessor in the business of EPEI. Mr Shaw did not dispute that Elvis Presley was such a predecessor; but he did dispute that the mark for which registration was sought was the signature of Elvis Presley. He put forward no affirmative case that it was not but contended that EPEI, on whom the onus lay, had not proved the authenticity of the signature. I approach such a contention with some scepticism. Why should EPEI want to register a signature which was not that of Elvis Presley? If Mr Shaw has no affirmative case to advance is his point any more than the last ditch defence of one who in truth has none? But the conduct of the application by EPEI is little short of remarkable. I must describe it in order to explain my conclusion. The application, no.1371624, was submitted on the normal form on 26th January 1989 for registration of the signature mark in Part A.

The application was advertised in the Trade Mark Journal on 6th March 1991. On 18th June 1991 Mr Shaw gave notice of his opposition contending, amongst other things, that the mark was not distinctive. In their counterstatement filed on 1st November 1991 EPEI alleged that

"The mark is the signature of Elvis A. Presley and fully satisfies the distinctiveness and other requirements of the Act,"

At the hearing before the Registrar no evidence of authenticity was adduced by EPEI. Mr Shaw, who appeared in person, was understood by the Registrar to be pointing out only that the signature was not like any of those appearing in the copious exhibits. On appeal to the High Court one of Mr Shaw's grounds of appeal was that there was no evidence before the Registrar that the signature comprising the mark was that of Elvis Presley. At the hearing before Laddie J EPEI sought leave to adduce in evidence an affidavit sworn on 13th August 1984 by a public accountant and executor of Elvis Presley which, it was claimed, would establish the authenticity of the signature. The application was refused by Laddie J but he did not in his judgement reach any clear conclusion on the issue of authenticity. By his respondent's notice served on 4th June 1997 Mr Shaw indicated that he would, if necessary, contend that the application in respect of the signature mark should be rejected on the ground that there was no evidence that the signature was that of Elvis Presley. Though an application for leave to adduce further evidence was made by EPEI on 18th January 1999 it did not encompass the affidavit of the public accountant. It was in those circumstances that, after some pressure from the court, counsel of EPEI applied to amend his application so as to seek leave to adduce the affidavit he sought to rely on. We refused that application on the ground that it was too late. Counsel indicated that in those circumstances he would rely on the evidence already before the court and on the presumption of regularity expressed in the maxim *omnia praesumuntur rite esse acta*. The first piece of evidence he seeks to rely on is the statutory declaration of Mr Jack

Soden made on 21st November 1994. He stated that he had been connected with EPEI since 1982 and is now its chief executive officer and in paragraph 3 continued:

"The Applicant has, since 1982, carried on a substantial business, based at its home location in Memphis, Tennessee, USA, which has at all times included a wide range of products, including the goods for which registration is sought by the present Applications and by other Applications. Prior to 1982, as early as 1956-57, Elvis Presley himself, doing business as Elvis Presley Enterprises, Inc., and from 1977 to 1982, the Estate of Elvis Presley, sold and licensed others to sell on his and its behalf, such goods bearing the trademark ELVIS, ELVIS PRESLEY and the signatures Elvis Presley and Elvis A. Presley. These products are, in some instances, souvenirs or memorabilia of Elvis Presley, and in some other instances, commercial consumer items which were sold and continue to be sold under the trademarks Elvis Presley signature and the Elvis A. Presley signature, the subject of the present Application, as well as ELVIS and ELVIS PRESLEY."

Mr Soden then exhibited a large number of documents not one of which indicated the use of the Signature Mark.

In addition counsel for EPEI relied on the fact, of which he informed us on instructions, without objection from counsel for Mr Shaw, that the Signature Mark had been previously accepted for registration in respect of goods in classes 21 (household goods), 25 (clothing) and 26 (lace and embroidery).

For my part I do not accept that the authenticity of the signature has been established on the balance of probability. I do not think that the evidence of Mr Soden is of any value in that respect. He did not join EPEI until five years after the death of Elvis Presley. He does not depose to any familiarity with his signature and, most significantly, none of the many documents exhibited by him and which bear a signature shows a signature in the form for which registration of the mark is sought. The difference lies not merely in the variations in the script, which may occur with all signatures, but in the fact that there is no evidence of any signature with the initial "A" interposed between the Christian name and surname.

With regard to the registration in respect of classes 21, 25 and 26 no certified copy of the registration has been produced. Accordingly s.1(8) Trade Marks Act 1938 does not apply. No doubt the fact of such entry may be proved by other means. But in the face of the clear contention that there was insufficient evidence counsel's statement on instructions is not, in my view, sufficient because in the absence of admission by counsel for the other side it is not evidence at all. I did not then and do not now regard the courtesy shown by counsel for Mr Shaw towards his opponent and the court as amounting to such an admission and the effective abandonment of his client's case in this respect.

Thus EPEI relies on the presumption of regularity alone. In my view that is not enough. The onus was on EPEI to prove the affirmative case it put forward in its counter-statement. It has produced no evidence at all in support of it. Before us, unlike the position before Laddie J, counsel for EPEI accepted that if he failed to establish the

authenticity of the signature then his appeal in respect of the Signature Mark must fail for there is no evidence of its use sufficient to satisfy the requirements of s. 9 (1)(e). In those circumstances I would dismiss the appeal in respect of the Signature Mark. If, contrary to my view, the signature mark is authentic then the issue of distinctiveness arises. Prima facie an authentic signature is distinctive of the individual who signed. per Tomlin J in Re Fanfold's Application (1928) 45 RPC 199, 203. But it does not, I think, follow that the signature is on that account distinctive of the goods as denoting the necessary connection between the goods and the proprietor of the mark. In my view, there is no distinction to be drawn in this respect between the signature mark and the marks ELVIS or ELVIS PRESLEY.

### ELVIS

EPEI claims that this mark comes within s.9(1)(d) as being (a) a word, (b) having no direct reference to the character..of the goods and (c) not being a surname. It is not disputed that (a) and (c) are satisfied. Counsel for Mr Shaw submits that (b) is not. In my view it is necessary in applying (b) to keep in mind that part of the definition of trade mark which requires that the mark is capable of indicating the connection in the course of trade between the goods and EPEI. The argument on this issue ranged far and wide and has been dealt with in detail by Robert Walker LJ. I can state my conclusions more shortly.

In "TARZAN" Trade Mark [ 1970] RPC 450 the Court of Appeal considered an application to register the mark TARZAN in respect, not only of films and tapes, but also of games, toys, playthings and gymnastics and sporting articles. One of the contentions of the applicant was that the mark came within s.9(1)(d). That contention was rejected on the ground that Tarzan necessarily referred to the character of the goods. As Salmon LJ put it a TARZAN film can only be a reference to the subject matter or character of the film. Only Edmund-Davies LJ referred expressly to the application in respect of the games etc. In that connection he said

Here again, the affidavit of Mr .Weintraub has a bearing, referring as it does to "merchandise centred on the fictional character "Tarzan". In the light of this, I consider that the learned judge was probably entitled to conclude, as he did, that the articles covered by the class 28 application were "all presumably intended to portray or relate to the character Tarzan in one way or another." That being so, it was open to him to proceed to hold that " the word TARZAN has a very distinct reference to the character and quality of the goods in classes 9 and 28 in which it is now sought to be registered".

I agree with counsel for Mr Shaw that that case is indistinguishable from this. It is true that the goods in respect of which registration is sought, for instance soap, are consumer items. To market those goods under the mark ELVIS would obviously seek to turn to account the name and memory of Elvis Presley; but it would seek to do so as descriptive of a popular hero not as distinctive of the connection between the soap and EPEI as the proprietor of the mark. The soap would be sold as Elvis soap. The character of the soap would be Elvis soap. To my mind it is clear that the mark could not come within s. 9( 1 )(

d) for it would be a direct reference to the character of the soap. In this connection counsel for EPEI submitted that Laddie J was wrong to have rejected the practice of the Registrar not to register Christian names if appropriate to a female but to do so if appropriate to a male. For my part I see no reason to come to any concluded view on this point. But I consider that there is force in the reasons why the judge rejected the distinction. In his oral argument counsel for EPEI observed that the judge had not dealt with the submission that ELVIS came within s.9(1)(d) but considered only s.9(1)(e). He contended that as there had been no evidence to satisfy the provisions of the latter paragraph the judge must have decided that the mark came within the former. I have concluded that the mark does not come within sub-paragraph (d). The consequence, as apparently accepted by counsel for EPEI, must be that the mark does not come within ( e ) either and the appeal should be dismissed with regard to this mark also.

### ELVIS PRESLEY

As this mark included a surname the normal practice of the Registrar, which is not challenged, was to give the applicant the choice, if the other conditions were satisfied, of registration in Part A with a disclaimer of any exclusive right to use the surname or registration in Part B. EPEI chose registration in Part B. Thus the question of registrability fell to be determined in accordance with s.10 rather than s.9. The issue is whether this mark is "capable of distinguishing the goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such no such connection subsists...". In deciding that issue one must have regard to both inherent and factual capability to distinguish. Some degree of both inherent and factual capability must be shown. Yorkshire Copper Works Application (1953) 71 RPC 150.

For EPEI it was submitted that, subject to the effect of the fame of Elvis Presley, the answer was in the affirmative. In a sustained criticism of the judge's conclusion counsel for EPEI submitted that the fame of Elvis Presley in fact confirmed the conclusion because of the effect of what has now come to be known as "character merchandising". That activity is one in which a notable public figure lends his name to a particular product or range of products so as, apparently, to endorse that product. The consequence relied on is that the consumer comes to regard goods bearing that name as having the approbation of or licence from his or her "idol". EPEI relied on a number of reported cases so as to suggest that over the last 20 years the court has come to conclude, without the need for affirmative evidence on the point, that such endorsement does distinguish the goods he or she endorses from those he or she does not. Robert Walker LJ has considered those cases in detail and it is unnecessary for me to repeat the exercise.

I do not accept that submission. First, the judge concluded that there was no evidence of use by EPEI of ELVIS PRESLEY in the United Kingdom. There is no appeal from that conclusion. Second, Mr Shaw has sold in the United Kingdom quantities of his products by reference to Elvis, which, the public would generally appreciate, was a reference to Elvis Presley. For example his brand of soap was called Elvis Soap because it. was impregnated with an "image [of Elvis which] remains right to the end". It is not suggested

that Mr Shaw has ever claimed any connection with EPEI. Third, the fame of Elvis Presley was as a singer. He was not a producer of soap. There is no reason why he or any organisation of his should be concerned with toiletries so as to give rise to some perceived connection between his name and the product. In these circumstances I do not accept without evidence to that effect that the mark ELVIS PRESLEY would connote to anyone a connection between EPEI and Elvis soap so as to distinguish their soap from that of Mr Shaw's soap.

Counsel for EPEI forcefully contended that such a conclusion would leave the door wide open to unscrupulous traders seeking to cash in on the reputations of others. This is true if, but only if, the mark has become so much a part of the language as to be descriptive of the goods rather than distinctive of their source. But in that event I can see no objection to any trader being entitled to use the description. In the field of memorabilia, which I consider includes consumer items bearing the name or likeness of a famous figure, it must be for that person to ensure by whatever means may be open to him or her that the public associate his or her name with the source of the goods. In the absence of evidence of such association in my view the court should be very slow to infer it.

For all these reasons I consider that the judge was right to reject each of the three marks on the ground of lack of distinctiveness. In those circumstances the question of confusion does not arise. But in view of the full argument we heard and the possibility that this case may go further I should deal, briefly, with the question of confusion.

#### Likelihood of confusion

The relevant provisions are contained in sections 11 and 12 of the Trade Marks Act 1938. So far as material they provide Prohibition of registration of deceptive, etc., matter

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

#### **Prohibition of registration of identical and resembling trade marks**

12. (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of -

(a) the same goods,  
(b) the same description of goods, or  
(c) services or a description of services which are associated with those goods or goods of that description.

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the Court or the Registrar

may permit the registration by more than one proprietor in respect of -

- (a) the same goods,
- (b) the same description of goods or
- (c) goods and services or description of goods and services which are associated with each other, of marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or Registrar, as the case may be, may think it right to impose.

Section 68 provides:

(2B) References in this Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

The question under s.11 is whether if the signature mark or the marks ELVIS or ELVIS PRESLEY were registered their respective use would be likely to cause deception or confusion. In approaching this question I have to assume that such marks are distinctive in a trade mark sense. But in that event I do not understand how the use of such marks could fail to cause confusion given, for example, Mr Shaw's trade in Elvis soap. cf Tavemer Rutledge Ltd v Trexapalm Ltd [1975] FSR 479. In the case of s.12 it is necessary to compare mark for mark, that is to say ELVISLY YOURS with the signature mark and with ELVIS and ELVIS PRESLEY. It is also necessary to consider notional fair use by each protagonist. Although the goods in respect of which ELVISLY YOURS is registered are limited to those "relating to the late Elvis Presley" that more limited class of goods is included in the wider class for which EPEI seeks registration. Thus all four marks relate to the same goods.

Do the marks for which EPEI seeks registration so resemble ELVISLY YOURS as to be likely to deceive or cause confusion? Again if it is to be assumed that the marks for which EPEI contends are distinctive in a trade mark sense the answer is in the affirmative. Finally counsel for EPEI contended that if 5.12 were otherwise applicable then concurrent use should be permitted pursuant to 5.12(2). I have difficulty in seeing how that subsection can be applied if there is a likelihood of deception or confusion so as to satisfy 5.11. In my view that is sufficient to exclude 5.12(2).

### Conclusion

For all these reasons I would dismiss this appeal.

### **Lord Justice Simon Brown**

I agree with Lord Justice Robert Walker's judgement on all points (and also with Lord Justice Morritt's judgement save only insofar as he would find in the respondent's favour on the issue of the authenticity of the signature) and wish to add a few thoughts of my own only because of the obvious importance and interest of the case. My Lords' judgements so comprehensively set out the relevant facts, law and argument that my own can be very short. It is directed only to the proposed marks 'Elvis' and 'Elvis Presley', not

to the signature and only to the issue of distinctiveness. Laddie J found against Enterprises on the names Elvis and Elvis Presley essentially on the footing that they lack any sufficient inherent distinctiveness in the trade mark sense. The whole point of a trade mark is to distinguish the proprietor's goods from similar goods marketed by competitors. These names, the Judge concluded, distinctive though undoubtedly they are by their universal association with the late great celebrity, would as registered trade marks serve to distinguish not the producers but rather the product: they would describe the essential nature of the goods being traded (Elvis Presley memorabilia in the widest sense) but say nothing as to their trade origins.

Mr Peter Prescott QC for Enterprises expresses forensic outrage at such a conclusion. It cannot be right, he submits, that the more famous the celebrity, the more difficult it becomes to register his name as a trade mark. Rather, he argues, the general public will nowadays assume that the commercial exploitation of his name has the endorsement (i.e. the licence and approval) of the celebrity himself (or, after his death, of those lawfully succeeding to his rights). That is true equally of real people as of invented characters. What was said by Sir Nicolas Browne-Wilkinson VC in Mirage Studios v Counter Feat Clothing [1991] FSR 145 about Teenage Mutant Ninja Turtles, he submits, applies also to the character Elvis Presley. If objection be taken that registration would confer upon the appellants "a monopoly in what other traders may legitimately desire to use" - see Lord Parker's classic statement of the law in Registrar of Trade Marks v W & O du Cros Limited [1913] AC 624, 635 - Mr Prescott's answer is that any desire in other traders to exploit the name Elvis Presley is not legitimate but illegitimate: it would be intrinsically wrong for other traders to benefit from the prestige given to the name by the celebrity himself.

It is one thing to exclude from registration geographical names (like "Glastonbury" and "Yorkshire"), simple initials (like "W & O"), descriptive words (like "Electrix"), laudatory words (like "Perfection"), and commonplace descriptive indicia (like "pale green" for pharmaceutical tablets or "Joy" for perfumes); quite another to forbid the registration of a celebrity's own name lest others may wish themselves to benefit from its acquired significance and attraction. There are thus two central strands to the appellant's argument: one that the public's awareness of merchandising practices means that they will always assume that products of famous personalities or fictitious characters come from a particular "genuine" source, namely the person himself or his estate or someone granted the relevant rights (and in the case of fictitious characters the creator or his successors); the other that it would be wrong to deny registration of a celebrity's name by reference to Lord Parker's test in the W & O case - that the rights should "largely depend on whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark. ..in connection with their own goods" - because, although other traders doubtless want to use Elvis Presley's name(s) to market their own goods, their motive for doing so would be improper: it would be to exploit a commercial value in the name that properly belongs only to the character and his successors. This, it will readily be perceived, is a very wide argument indeed.

It applies virtually irrespective of the nature of the products to be marketed (exceptions being made only for non-consumable souvenirs and biographical material), irrespective of when registration is applied for (unless only it is sought for truly historical characters), irrespective of whether it is sought by the personality himself or by his legal successors, and irrespective of what if any trading in the relevant products has previously been effected either by whoever seeks registration or by competing traders. If, of course, it is sound, then it will greatly enhance the role played by trade mark registration in the promotion and protection of character merchandising. But its difficulty is that both its limbs depend ultimately upon the general proposition that character merchandising is already established and accepted in the public mind as properly the exclusive preserve of the character himself, and that, to my mind, represents an altogether too simplistic view of the effect of the many authorities in this field and discounts utterly the well-established principle that all these cases ultimately must turn upon their own facts.

Pre-eminent amongst the facts here are, first, that there is no connection whatsoever between the class of products in question (toiletries) and the things for which Elvis Presley was and remains famous (this is as far as could be from a case, such as was instanced in the course of argument, of a third party seeking, for example, to market Geoffrey Boycott cricket bats); second, that such marketing of this class of products as has taken place in the UK since Elvis Presley's death has been effected not by Enterprises but rather by the respondent himself (who, moreover, so far from claiming any endorsement for his products from Enterprises has on the contrary made plain his differences with them); and third, that the Elvis Presley legend is such as would inevitably attract a wide demand for memorabilia, little of which (at any rate (a) in the United Kingdom, and (b) following his death) would the general public suppose to be officially licensed and approved.

On analysis, as it seems to me, all the English cases upon which Enterprises seeks to rely (Mirage Studios not least) can be seen to have turned essentially upon the need to protect copyright or to prevent passing off (or libel). None creates the broad right for which in effect Mr Prescott contends here, a free standing general right to character exploitation enjoyable exclusively by the celebrity. As Robert Walker LJ has explained, just such a right, a new "character right" to fill a perceived gap between the law of copyright (there being no copyright in a name) and the law of passing off was considered and rejected by the Whitford Committee in 1977. Thirty years earlier, indeed, when it was contended for as a corollary of passing off law, it had been rejected in *McCulloch v May* [1947] 2 AER 845. I would continue to reject it. In addressing the critical issue of distinctiveness there should be no a priori assumption that only a celebrity or his successors may ever market (or licence the marketing of) his own character. Monopolies should not be so readily created.

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