The text below is the full text of the Judgment given at the High Court of Justice in London on 18 March 1997 in favour of Mr Sid Shaw (for Elvisly Yours) against Elvis Presley Enterprises Inc.

It is a long document, but for ease of navigation we have broken it down into the Judge's own sub-sections as listed below:

Mr Justice Laddie (The Judge)

Dramatis Personae (The main characters)

Elvis Presley
Elvis Presley Enterprises Inc
Mr Sid Shaw (Elvisly Yours)

The 'Elvis' Application

Evidence of Use
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The 'Elvis Presley' Application

The signature mark

Mr. Justice Laddie:

On 26 January 1989 **Elvis Presley Enterprises Inc**. ("Enterprises") of Elvis Presley Boulevard, Memphis, Tennessee in the United States of America applied to register three trade marks under the provisions of the Trade Marks Act, 1938. The first, numbered 1371624, is for a manuscript version of the name "ELVIS A PRESLEY". This mark was referred to before me as the "signature mark". The second mark, numbered 1371627, is for the word "ELVIS" *simpliciter* and the third, number B1371627, is for the words "ELVIS PRESLEY" *simpliciter*. All three marks are sought to be registered for the following specification of goods;

> "Toilet preparations, perfumes, eau de colognes; preparations for the hair and teeth; soaps, bath and shower preparations; deodorants, anti-perspirants and cosmetics; all included in Class 3."

On 16 June 1991 all three were opposed by **Mr. Sid David Shaw**. Amongst the grounds of objection raised by Mr. Shaw were those of lack of distinctiveness under ss. 9 and 10 of the 1938 Act and deceptiveness under s. 11 and under s. 12 as a result of an alleged conflict with a trade mark registration of his own. He represented himself before the Registry. On 31 January 1996, Mr. Tuck acting for the Registrar, dismissed the opposition. Mr. Shaw now appeals from that decision. Before me Mr. Shaw was represented by Mr. Meade and Enterprises was represented by Mr. Peter Prescott QC.

Dramatis Personae

Elvis Presley

Mr. Presley was born in Tupelo, Mississippi, USA in 1935. He was a rock and roll singer who first came to public attention in the early 1950's. He soon became internationally famous and he so remained up to his death in 1977. Such was his popularity that he was made the star in a series of generally light hearted feature films. If his abilities as an actor did not match his abilities as a rock and roll singer, nevertheless the films contributed to the enormous

fame which he had acquired by the time of his death. Since then, his home, a sizeable white painted mansion in Memphis called "Graceland", has become something of a shrine and is visited by large numbers of fans together with other inquisitive members of the public. At Graceland large numbers of souvenirs and memorabilia referring to or depicting Elvis Presley are on sale. There is no doubt that the name, "Elvis Presley", continues to conjure up in the mind of a very large part of the population in this country the image of the now-deceased rock and roll performer. I take judicial notice of the fact that over the years there have been numerous programmes on television and radio and articles in newspapers and magazines which centred on or made reference to Elvis Presley. He must be counted amongst the most well known popular musicians this century.

Enterprises

As mentioned above, Enterprises is a company incorporated in the USA. Although there is no direct evidence on the issue before me, it appears that Enterprises in some way carries on and has expanded on the merchandising activities which had been carried on by or on behalf of Elvis Presley before his death. Mr. Shaw has not disputed that Enterprises should be considered as successors in title of Elvis Presley's merchandising activities. In response to Mr. Shaw's evidence filed in support of his opposition, Enterprises served a single brief statutory declaration by Mr. Jack Soden, its Chief Executive Officer. Mr. Soden has been connected with Enterprises since 1982.

Mr. Sid Shaw

Mr. Shaw has traded under the name "ELVISLY YOURS" since the late 1970's. In 1982 he formed a trading company called Elvisly Yours Limited. Mr. Shaw is the proprietor of the registered trade mark "ELVISLY YOURS" also in Class 3 for a wide specification of goods, including toiletries, soaps, perfumes, cosmetics and shampoos. The validity of that registration has not been challenged in these proceedings. Mr. Shaw has traded in a wide range of products which bear the whole or parts of Elvis Presley's name or likeness. He has sold his products not only in the United Kingdom but also abroad. Mr. Shaw asserts, and it is not denied, that Elvisly Yours was the exclusive supplier of Elvis Presley souvenirs to Graceland in August 1982. It appears that Enterprises and Mr. Shaw have been in litigation in the USA which effectively resulted in Mr. Shaw being injuncted from carrying on trade in Elvis Presley memorabilia in that country.

Although the arguments before me have ranged over a considerable area, at their heart are two crucial issues; (a) can anyone claim the exclusive right under the 1938 Act to use the names Elvis and Elvis Presley or the signature as a trade mark for a range of common retail products and, if so, (b) who?

Before considering what rights might be acquired under the Trade Marks Act, 1938, it is useful to have a basic concept in mind. As Mr. Prescott put it in his skeleton argument, Enterprises is a company which has "as its principal object the exploitation of the name and likeness" of the late Elvis Presley. That it engages in such exploitation and benefits financially from Elvis Presley's continued fame is not in dispute. But, ignoring for the moment the effect of any registration of trade marks which it may secure, it does not own in any meaningful sense the words "Elvis" or "Elvis Presley". There is nothing akin to a copyright in a name. This has been part of our common law for a long time. In *Du Boulay v. Du Boulay* (1869) LR 2 PC 430 the Privy Council said;

> "... in this country we do not recognise the absolute right of a person to a particular name to the extent of entitling him to prevent the assumption of that name by a stranger. ... the mere assumption of a name, which is the patronymic of a family, by a Stranger who had never before been called by that name, whatever cause of annoyance it may be to the family, is a grievance for which our Law affords no redress."

Even if Elvis Presley was still alive, he would not be entitled to stop a fan from naming his son, his dog or goldfish, his car or his house "Elvis" or "Elvis Presley" simply by reason of the fact that it was the name given to him at birth by his parents. To stop the use of the whole or part of his name by another he would need to show that as a result of such use, the other person is invading some legally recognised right. This also is reflected in many cases in the law of passing off. In a well known and frequently cited passage in *Burberrys v. JC Cording & Co Ltd* (1909) 26 RPC 693, Parker J. said;

> "On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of

> any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but property in the trade or goodwill which will be injured by its use".

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

With that introduction, I can turn to the three applications in suit. The 1938 Act was repealed by the Trade Marks Act, 1994. However, as a result of the provisions of Schedule 3 of the latter Act, these applications must be decided under the regime imposed by the former Act. This does not mean that the 1994 Act is irrelevant. Once registered the marks will take effect under and the scope of infringement will be determined in accordance with the 1994 Act, save for a somewhat limited provision relating to continuing infringement. Under the 1938 Act, the Trade Marks Register was split into two parts, A and B. To achieve Part A registration the applicant had to show that it met the requirements of s. 9 of the 1938 Act. Part B registration was achieved by meeting the requirements of s. 10 of the Act. It was somewhat easier to achieve Part B registration but the rights given by it under the 1938 Act were less powerful than a Part A registration. The distinction between Part A and B registrations has now been abolished. All marks registered under the 1938 Act are treated in the same way under the 1994 Act. Nevertheless the applications before me were launched under the old regime. The "ELVIS" and signature marks were pursued for registration in Part A whereas the "ELVIS PRESLEY" mark was put forward for consideration in Part B. Since somewhat different considerations apply to each of the applications, it will be convenient to look at them one by one.

The "ELVIS" application

As noted above, this is an application for the name "ELVIS" *simpliciter*. It is sought to be registered under s. 9 of the Act. This means that Enterprises must demonstrate that it is a distinctive mark as required by s. 9(1)(e). The meaning of distinctive is dealt with by s. 9(2) and (3) as follows;

> "(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."

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. At one extreme this means that common laudatory epithets will have virtually no inherent distinctiveness. They do not inherently serve the function of distinguishing the proprietor's goods form the same goods marketed by someone else. As Mr. Prescott pointed out, in *Smith Kline & French Laboratories Ltd's Trade Mark Applications* [1976] RPC 511 at 538 Lord Diplock said that the words "inherently adapted" in s. 9(3) were intended to give statutory effect to the views of Lord Parker in *W & G Du Cros Ltd's Application* (1913) 30 RPC 660 that registration 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, or some mark nearly resembling it, upon or in connection with their own goods."

Those words have particular impact when it is borne in mind that the other traders' own goods can be goods having the same character, quality or non-origin attributes as those of the proprietor.

In the Registry, Mr. Tuck's reasons for rejecting the opposition to the application to register "ELVIS" for Class 3 goods were expressed as follows;

> "From my own knowledge, I am aware that this was the Christian or first name of a very famous individual; ... Whilst I can see, therefore, that the Registrar would take objection to any application for its registration under Section 11 (as deceptive if used without authority) or in his discretion under Section 17(2) (for the same reason), I cannot see that there is a prima facie objection to it under Section 9. The use of feminine proper names is generally regarded as non-distinctive in Class 3, but no such objection is taken to masculine proper names used on that class of goods."

In saying this, it appears that Mr. Tuck was following internal Trade Mark Registry guidelines or practice. Perhaps such a practice was a useful rule of thumb in the days when toilet preparations, perfumes, eau de colognes, preparations for the hair and teeth, soaps, bath and shower preparations, deodorants, anti-perspirants, cosmetics and the like were thought to be exclusively directed at female customers. Whatever the position may have been in the past, such products are now frequently sold to and targeted at men. If there was a Registry approach that *prima facie* feminine proper names should not be registered as trade marks for cosmetics and toiletries, it now should cover masculine proper names also. But in any event, even if there are such guidelines which are useful in assisting Registry officials to adopt at least a consistent starting point for the examination of registrations, in the end whether a mark is acceptable or not for registration must depend upon the particular mark in issue, the goods for which registration is sought and the nature of the trade into which they will be sold.

Mr. Meade said that the Registrar came to the wrong conclusion as to the registrability of the "ELVIS" mark. He said that there was low inherent distinctiveness. "Elvis" is merely a given name. It may be that in England it is not the most common name but it is well known, no doubt in large part because of the fame of Elvis Presley. He says that the fact that the musician's name is well known does not make the mark more inherently distinctive but less so. He says that Enterprises can not get over their problems by relying on use or other special circumstances. He says that the evidence of use is virtually non-existent and there are no other special circumstances.

Mr. Prescott asked me to approach this application in an entirely different way by considering what the position would be if Elvis Presley was still alive and had made this application himself. He says that there is no doubt that he would be entitled to a registered trade mark for his own name. In fact he went further back and suggested that I consider what the position would have been had these applications been made not now but before Elvis Presley had burst onto the entertainment firmament. Before he was famous, the word "Elvis" would have been virtually unknown in England. Had he applied then he would have got the mark on the register. Mr. Prescott suggested that the position can be no different if Elvis Presley had applied later once he was famous or if his estate or its successors apply after he has died.

I reject that seductive argument. What is in issue is whether, at the date of application, the mark satisfies the registration requirements of the 1938 Act. It is no help, and may be positively misleading, to consider what the position would have been in other very different circumstances. The point can be illustrated by reference to *TARZAN Trade Mark* [1970] RPC 450. In that case the applicant, Edgar Rice Burroughs Inc. of Tarzana, California, had been granted certain exclusive rights by the estate of Edgar Rice Burroughs, the author of the Tarzan stories, "to produce

films, records and merchandise for distribution throughout the world, including the United Kingdom, centred on the fictional character 'Tarzan'". It applied to register "TARZAN" in Part A of the Register in respect of films for exhibition and magnetic tape recordings. The application was unsuccessful in the Registry, in the High Court and in the Court of Appeal. One of the applicant's arguments was that the mark was an invented word and therefore prima facie entitled to registration under the provisions of s. 9(1)(c) of the Act. By November 1965, the date of the application for registration, the word "Tarzan" had passed into the language and had become a household word. There was no doubt that originally the word had been invented by Mr. Burroughs. In the Court of Appeal, Salmon LJ said:

> "It is not fatal to the application that the word had been invented many years before the application was made. For example, if a word was invented, say, in 1925, and had not passed into the language, it would still remain an invented word in 1965. The trouble facing Mr. Burrell is that it seems quite plain that the word TARZAN had by 1965 passed into the language. In *Holt's Trade Mark* (1896) 13 RPC 118 there was an application to register the word TRILBY as a trade mark in relation to certain goods, and the question arose as to whether it was an invented word. Lindley L.J. said at page 121: "It may have been once an invented word within clause (d)" - section 68 of the Act of 1883 - "but it long ago became too well-known to fall under that head". Smith L.J. at page 124, said: It is not a word coined for the first time by the owner of the trade mark, it having been used by Du Maurier in his book in 1893, and it was, therefore, not an invented work in 1895, when the appellants registered their trade mark."
>
> For my part, as I have already indicated, it was not necessary to show that the applicant had invented the word himself in order for it to be an invented word within the meaning of the statute, but I should have thought that the word TARZAN in 1965, to quote the words of Lindley L.J. "long ago became too well-known" to fall under the head of an invented word. It certainly, in my judgment, was at least as well-known in 1965 as the word TRILBY was in 1895, which apparently was only bout two years after Du Maurier had invented it."

The whole thrust of this passage is that registrability of a mark must be assessed as of the date of application. No doubt had Edgar Rice Burroughs had the foresight, or employed a lawyer with the foresight, to realise the merchandising potential of his Tarzan character at the time he created it and before it was launched before the public, he could have obtained a registration of that word for films and a wide range of other products. Whether such a registration could have been removed from the register as a result of it becoming non-distinctive at a later date is another matter. At the time of the registration the word would have been an inherently distinctive invented word (and, incidentally, not descriptive). But that was not what happened in fact. Those interested in exploiting the Tarzan character waited until it was well known by the public before they sought the benefits of registered trade mark rights. By that time it was no longer an invented word (and was descriptive). It follows that whether a mark is registrable under the 1938 Act has to be decided on the facts and in the market conditions prevailing at the date of application.

So I approach this appeal on the basis that, at the date of application, Elvis Presley had been dead for more than 10 years but that his fame continued to exist on a large scale. There were at the date of application, and still are, many people in this country who wish to acquire recordings of his songs and films and a wide variety of domestic articles bearing his likeness and/or his name. It is not in dispute that there is a large market in Elvis Presley memorabilia. It has kept Mr Shaw in business for more than 18 years. This judgment does not deal with what Elvis Presley could have obtained by way of trade mark registration if he had applied for such rights during his life. In particular it should not be assumed that I accept Mr Prescott's assertion that there is "no doubt" that Elvis Presley would be entitled to registration of his own name. That is a proposition which is beset with difficulties but which does not arise for resolution on this appeal.

It seems to me that Mr Meade was right when he said that the word ELVIS had very low inherent distinctiveness. Not only is this a well known given name, it also will be taken by many members of the public to refer back to Elvis Presley. This accords with the view expressed by Mr Tuck;

> "To me, therefore, the name Elvis means Elvis Presley."

The classification of goods for which Enterprises seeks registration covers a wide range of small value products which can carry the image of Elvis Presley. In *Tarzan* Salmon LJ said;

> "I asked Mr Burrell during the course of his argument if he could think of a more direct reference to the character or a film dealing with some exploits of Tarzan than the description that it was a "Tarzan" film. This

> was a question which Mr Burrell, despite his wide experience and ingenuity, was quite unable to answer. Indeed, it seems plain that such a film could not better be described or referred to than as a "Tarzan" film."

Then, turning to the question of whether the mark was inherently adapted to distinguish within the meaning of s.9 of the Act, he referred to the decision of the House of Lords in *Yorkshire Copper Works Limited's Application* (1954) 71 RPC 150 and continued;

> "In the present case, there is nothing at all in the word TARZAN which would suggest to the public or to the trade that a film or magnetic tape recording had anything to do with the applicant or with anyone else. The word TARZAN when used in connection with a film suggests - and suggests only - that the film has something to do with the well-known fictional person, Tarzan, a man of great strength and agility .....
>
> ... TARZAN has nothing standing on its own feet, upon which it would be possible to find that it is inherently apt to distinguish the applicants' films or magnetic recordings as being the applicants' or anyone else's goods."

Similarly Cross LJ said;

> "Turning now to section 9(1)(e), since it is so strongly descriptive, the word TARZAN can hardly be said to be to any appreciable extent 'inherently adapted to distinguish the applicants' goods from the goods of any other trader', for, as Lord Simmonds said in the *Yorkshire Copper* case, "the more apt a word is to describe the goods of a manufacturer the less apt it is to distinguish them from the goods of others; for a word that is apt to describe the goods of A is likely to be apt to describe the similar goods of B."

These passages emphasise that the more a mark has come to describe the goods to which it is to be applied or to indicate some quality of those goods, the less it is inherently adapted to carry out the trade mark function of distinguishing the trade origin of the proprietor's goods from the origin of similar goods from other sources. This is consistent with Mr. Meade's argument that the more famous Elvis Presley is, the less inherently distinctive are the words "Elvis" and "Presley". They are peculiarly suitable for use on the wide range of products sold as Elvis Presley memorabilia. He therefore does not contest but adopts Enterprises' assertion that "Elvis is about as famous a name as could be, made famous by the efforts of Elvis Presley ... Why else do members of the public wish to [purchase] Elvis merchandise?" Just as members of the public will go to see a Tarzan film because it is about Tarzan, so they will purchase Elvis merchandise because it carries the name or likeness of Elvis and not because it comes from a particular source. To adopt the approach from W & G, there is no reason why Mr. Shaw or anyone else for that matter should not sell memorabilia and mementoes of Elvis Presley, including products embellished with pictures of him, and such traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the name Elvis or Elvis Presley upon or in connection with their own such goods.

Mr. Prescott argued that this was not the correct approach to adopt in the late 1990's. He said I should take judicial notice of the fact that markets have changed since the days of the *Tarzan* case. There is more public awareness of character merchandising now. Therefore cases such as *Tarzan* which were lost in the 1970's would succeed now. He drew my attention to *Mirage Studios v. Counter-Feat Clothing* [1991] FSR 145. That was a judgment of Browne-Wilkinson V.C. on an application for interlocutory relief in a copyright infringement and passing off action. The plaintiffs exploited on a wide variety of products the name and likeness of a group of fictitious humanoid cartoon characters called the Teenage Mutant Ninja Turtles. The defendants made drawings of rather similar looking turtle figures and licensed third parties to put their drawings on T-shirts. During the course of his judgment, the Vice-Chancellor said:

> "The second point taken by Miss Victoria was that the plaintiffs had to prove by evidence that the public in purchasing T-shirts or other clothing carrying Turtle pictures on them would rely on the misrepresentation, namely that the picture of the Turtles was one licensed by the plaintiffs. That is to say, would the public decline to buy T-shirts if they knew that what they were buying were the defendants' counterfeits as opposed to the plaintiffs' genuine Turtles? For that purpose she relied on *Politechnika Ipari Szovetkezet v. Dallas Print Transfers Ltd* [1982] FSR 529. In my judgment, that case does not support

> the proposition. That case was purely concerned with establishing that the plaintiff in a passing off case had to show a reputation which he enjoyed in the goods, which reputation was being interfered with. It does not, as I see it, come anywhere near requiring affirmative evidence that the public will rely on the misrepresentation in acquiring the goods. In my judgement, if the misrepresentation is made there is no requirement of law for further evidence to show that the misrepresentation was the cause of the public buying the goods in question. In general, the public expect to buy what they think they are getting, namely the genuine article. So, here, a teenage child wishing to buy a Mutant Turtle as part of the craze would wish to get a genuine Turtle, one which was indeed a Teenage Mutant Ninja Turtle. In the absence of evidence, the court must infer that the object he is buying is not genuine, he would not buy it but would seek the real object."

As I have said, this was a judgment on an interlocutory application. It was given *ex tempore*. It is not clear what evidence was before the Vice-Chancellor. He appears to have held that the plaintiffs had the necessary reputation to support a passing off action, the passage quoted above only going to the issue of whether the plaintiffs needed to prove that the public relied on the misrepresentation which he had already held that the defendants had made. I do not read it as laying down a finding of fact of universal application that the products of plaintiffs in similar circumstances are viewed by the public as "genuine" and that traders in competing goods are therefore making a misrepresentation. I suspect that the difficulty arises in knowing precisely what is meant by the word "genuine". However Mr Prescott suggested 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. By "genuine source" I assume that he meant, in the case of a dead human, either his estate or someone with "rights" granted by his estate. In the case of fictitious characters perhaps "genuine" refers to the creator or his successors.

I am quite unable to accept that proposition. It may be that in some cases a plaintiff in a passing off action or an applicant for a registered trade mark will be able to show that to be the case. But I am not willing to assume that that is the public perception generally. On the contrary, my own experience suggests that such an assumption would be false. When people buy a toy of a well known character because it depicts that character, I have no reason to believe that they care one way or the other who made, sold or licensed it. When a fan buys a poster or a cup bearing an image of his star, he is buying a likeness, not a product from a particular source. Similarly the purchaser of any one of the myriad of cheap souvenirs of the royal wedding bearing pictures of Prince Charles and Diana, Princess of Wales, wants mementoes with likenesses. He is likely to be indifferent as to the source. Of course it is possible that, as a result of the peculiarities of the way goods are marketed or advertised, an inference of association with a particular trader may be possible to draw. This may be the case when the proprietor's products bear the word "Official". But that does not mean that absent that word members of the public would draw any such inference. That type of inference appears to have been drawn by the Vice-Chancellor in the *Mirage* case. But, as I have already said, there is no reason to assume that it would be drawn in all cases for all products. In particular there is nothing here which indicates that any significant section of the public seeing any of Enterprises' products would associate them with Enterprises by reason of the use of the words "Elvis" or "Elvis Presley". On the contrary, everything is consistent with those words being used and recognised as what the relevant public want not because of any trade source they may indicate but because they are a reminder of the famous musician. As Mr Prescott put it during his submissions, the motivation for buying Elvis Presley after shave must have something to do with Elvis Presley. That does not indicate distinctiveness of trade origin. This is a matter to which I will return below. I note, in passing, that although Mr Shaw has sold millions of pounds worth of memorabilia bearing the name 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.

It follows that I have come to the conclusion that there is very little inherent distinctiveness in the mark "ELVIS". However this initial view may be overcome in accordance with s.9(3)(b) as a result of use of the trade mark by the proprietor or other circumstances. Enterprises relies on both of these matters to bolster its application. I shall take them separately.

Evidence of use

During the course of his submissions, Mr Prescott was at pains to make it clear that he was only here to represent his clients in relation to their application for Class 3 goods. He said he was not in a position to make any concessions or submissions in relation to any other products. Insofar as Enterprises is seeking to rely on use to support their application for registration of this mark, primary importance must be given to evidence showing use in the United Kingdom of the mark on the goods covered by the registration and the impact that has had on the public.

Mr Meade says that the evidence of use by Enterprises on Class 3 goods is vanishingly thin. Such evidence as there is, is to be found by Mr Soden's statutory declaration. He says that Enterprises has since 1982 carried on a substantial business which "included a wide range of products, including the goods for which registration is sought". He exhibits two catalogues demonstrating, but not exhaustive of, the typical product range sold by Enterprises and Elvis Presley himself. He also says;

> "... sales in the UK of products under the trademarks referred to above, including products covered by the opposed Applications, were made in the 1980's through a retail outlet in Blackpool operated by a Mr Todd Slaughter. The sales were discontinued when Mr Slaughter went out of business."

Photocopies of what are referred to as "typical products of the Applicant sold through Mr Slaughter" are also exhibited.

The sales made by Mr Slaughter can be dealt with quite quickly. No indication is given of how many products were sold nor their value. The exhibited documents do not suggest, let alone prove, that he ever sold any Class 3 products. The only Class 3 product, the photocopy for the packaging of which was exhibited to Mr Soden's declaration, bears a price ticket in US dollars. There is no evidence that it was sold in the United Kingdom. Mr Prescott did not suggest otherwise. The catalogue exhibits are also of interest. The first is a document entitled "Elvis Collectibles" and is stated to be "An identification and Value Guide to hundreds of pieces of memorabilia for the most promoted celebrity of them all." It has pictures of a large number of products sold by Enterprises or its licensees but also includes some items which were not produced by them. The products depicted cover a wide range including an Elvis puzzle from England, various lapel badges bearing slogans such as "I like Elvis", "Don't blame me I voted for Elvis" and "Elvis for President", Elvis Presley Lipstick (with the advertising copy "Keep me always on your lips!"), Elvis Presley "Teddy Bear" eau de parfum, Elvis Presley pocket watches with the numerals on the face replaced by the letters of his name, dog tags bearing the words "I'm an Elvis Fan" and the like. There is nothing to indicate which, if any, of these products, save for the puzzle, were sold in the United Kingdom. The second catalogue is dated 1991, two years after the application date for the registrations in suit and appears to emanate from Enterprises. It also illustrates a wide selection of products of low inherent value. One of them, under the banner heading "NEW!" is "Elvis Cologne". There is nothing to suggest that this product was available before 1991 or that it has ever been sold in the United Kingdom. Other products include T-shirts carrying a picture of the performer over the word "Elvis", toothpick holders, cups, salt and pepper shakers and plates all bearing the legend "Elvis Presley / 1935-1977" and a tie-pin bearing the words "#1 Fan - Elvis". Once again there is nothing to suggest that any of these have been sold in the United Kingdom.

This evidence is incapable of assisting Enterprises. It does not show that any products bearing the names "Elvis" or "Elvis Presley" were sold in the United Kingdom at any time. But more than that, insofar as it shows anything, it undermines the applicant's case. Not a single use of the names Elvis or Elvis Presley is in a trade mark sense. They are all uses which accurately refer back to the performer. When a cup is offered for sale bearing the legend "Elvis Presley / 1935-1977" the use of the musician's name does not perform the function of enabling a customer to distinguish that cup as a cup emanating from Enterprises from other memorabilia from other suppliers. It is not an indication of trade origin at all. The fact that Mr Soden calls such use trademark use, does not mean that it is. No attempt has been made to show that it was so regarded by any members of the public.

Other circumstances

Mr Prescott argued that there were also here 'other circumstances' within the meaning of s.9(3)(b) which indicate inherent distinctiveness. He said that the words "any other circumstances" are perfectly general and therefore it was possible to take into account what he referred to as collateral circumstances which had demonstrated the mark to have the necessary distinctiveness or to have acquired it. He did not suggest that Enterprises' relationship to the estate of Elvis Presley, whatever that relationship may have been, was such a collateral relationship. To have done

so would have brought him into collision with another part of the *Tarzan* decision. Instead he said it was the fame of Elvis Presley, which was the other circumstance. He said that Mr Shaw's arguments were based on a logical contradiction which he explained as follows;

> "If Elvis Presley had never been born, so that "Elvis" had no special resonance amongst the British public today, the word would not count as "the name of an individual" at all within the meaning of s.9(1)(a). It would be, at best, just a forename, possibly American, not referring to any particular individual (like "Tex" or "Brad", only rarer). In order to get this part of their case of the ground, therefore the Appellants need to *pray in aid* the fame given by the words Elvis Presley, so that they can say it is the "name of an individual" within s.9(1)(a). But, in so doing, they themselves introduce the requisite evidence of "any other circumstances" required by s.9(1)(e)+9(3)(b)"

I cannot accept this submission. Mr Prescott apparently is arguing that the fame of Elvis Presley constitutes "another circumstance" which demonstrates inherent distinctiveness (or capacity to distinguish under s.10). But for reasons given above, it does nothing of the sort. It does not help to identify the goods with a particular **proprietor**, as required by the Act. It only helps to identify the goods with a particular **subject matter**, namely Elvis Presley. In other words Elvis Presley's fame leads away from distinctiveness in the trade mark sense.
For the above reasons I have come to the conclusion that the "ELVIS" mark is not a distinctive mark within the requirements of s.9 of the 1938 Act. In these circumstances it is not necessary to consider the alternative arguments advanced on behalf of Mr Shaw under ss.11 and 12 of the Act. However I must confess that if, contrary to the views expressed above, I had come to the conclusion that "ELVIS" was a registrable mark, I have difficulty in seeing how Mr Shaw's extensive use and registration of "ELVISLY YOURS" could fail to give rise to an objection under those sections.

The "ELVIS PRESLEY" application

This is applied for under s.10 of the Act in Part B of the Register. Enterprises accepts that it is less distinctive that the word "Elvis" alone. However the hurdles to be crossed to achieve registration under s.10 are somewhat lower than those under s.9. The former provides;

> "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".

It will been seen that the requirement of "adapted to distinguish" in s.9 is replaced by "capable of distinguishing". The obscurity introduced into our law by this difference is set out with clarity in *Kerly's Law of Trade Marks and Trade Names* (12th Edition) at paragraphs 8-74 to 8-76. Little point would be served by repeating what is said there. The essence of Part B registrations was that they allowed onto the register new unused marks and little used marks which were near the borderline of registrability under s.9. However it was still necessary to show that the mark had the ability to distinguish in a trade mark sense. That is to say, to perform the function of distinguishing the proprietor's goods from similar goods from another trader. All the factors which have led me to the conclusion that

"ELVIS" is incapable of distinguishing in that sense apply equally strongly to "ELVIS PRESLEY". Neither of those marks qualifies for registration under s.10 either.

The signature mark

This is applied for under s.9. The mark is as follows;
Against this, Mr Shaw has raised a number of objections. He says that Enterprises has not discharged the onus on it to show that the mark is a signature of Elvis Presley, has not shown that it is distinctive and that there are ss.11 and 12 objections to it based on his own use and registration of his "Elvisly Yours" trade mark. In the alternative, he argues that registration of the mark should be subject to suitable wide disclaimers under s.14 of the Act.
Signatures are dealt with expressly under the 1938 Act. To understand this it is useful to have in mind some of the provisions of s9(1);

> "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) ....;
> >
> > (d) 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."

The initial words "any other distinctive mark" in s.9(1)(e) have been taken to confirm that all marks which pass muster for entry in Part A of the register must be distinctive *[see Fanfold Ltd's Application (1928) 45 RPC 325]*. S.9(1)(a), (b) and (d) also indicate that names, and particularly surnames, which are not rendered in a special or particular manner or in the form of a signature are, *prima facie*, not distinctive whereas those that are so rendered are, *prima facie*, distinctive.
Although the Registry and the court must start from the premise that signatures are *prima facie* distinctive, they are not inevitably so. A person may adopt any manuscript rendering of the whole or a part of his name as a signature. It is well known, and confirmed by consulting any sizeable telephone directory, that many people have surnames which are *prima facie* descriptive or non-distinctive if used for trade mark purposes. There are many adjectival surnames such as Good, Best, Perfect, Brilliant, Most, Round, Sharp and Blunt, numerous surnames such as Gold, Silver, Bacon, Shine, Sheen, Bottom, Tough to say nothing of those names derived from well known locations like London, Glasgow, York, Hampshire, England, Scotland, Ireland and French. Someone with one of these names 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. What makes most signatures distinctive is that they consist of a substantially unique and frequently highly distorted way of writing the author;s name. They are in a sense a private graphic tied to one person. If Elvis Presley had signed his name in block capitals that signature would not be any more registrable than the "ELVIS PRESLEY" mark dealt with above. To allow registration of such a mark, simply on the basis that it was how the author signed his name, would be to give the

proprietor trade mark rights which could be enforced against other traders using block capitals or any other legible script. But that is just the sort of use which, according to *W&G* should not be the subject of monopoly rights. To allow such a signature to be registered would be to forget that the mark, whether falling within s.9(1)(b) or not, still has to be distinctive.

If the signature mark in issue here is registrable, its distinctiveness must be dependent on the particular graphic style used to write it. However, particularly having regard to the wide infringement provisions of the 1994 Act, an unqualified registration of the mark might well give rise to protection far beyond the graphic style used. In effect it could well give rise to protection for the words "Elvis", "Presley", "Elvis A Presley" or "Elvis Presley" but all of those, absent the special graphic style are, for reasons already given, not distinctive. It is for this reason that Mr Shaw says that any registration should be subject to a disclaimer under s.14 of the Act. That provides;

> "14. If a trade mark
>
> (a) .....
>
> (b) contains matter common to the trade or otherwise of a non-distinctive character;
>
> the Registrar or the Board of Trade or the Court, in deciding whether the trade mark shall be entered or shall remain on the register, may require, as a condition of its being on the register,
>
> (i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter as aforesaid, to the exclusive use of which the tribunal holds him not to be entitled; or
>
> (ii) that the proprietor shall make such other disclaimer as the tribunal may consider necessary for the purpose of defining his rights under the registration:
>
> Provided that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made."

It seems to me that, at the very least, the signature mark contains matter common to the trade or otherwise of a non-distinctive character, namely the individual words that go to make up Elvis Presley's name. As a result it seems to me that if this mark is to be registered it must be subject to a disclaimer. I did not understand Mr Prescott to dissent from that in principle. If registered, I would subject this mark to a disclaimer in the following terms;

> "Nothing in this registration shall give rise to any exclusive rights in the words "Elvis", "A" and "Presley" whether used separately or together save when used in substantially the script shown."

It would be easy to say that with such a disclaimer the signature mark would not be a significant impediment to others engaged in the trade of selling Elvis Presley memorabilia and should therefore be allowed on the register. For some time I thought that this was the course that I should adopt. However in the end the onus is still on Enterprises to demonstrate that the signature mark, even with the disclaimer, is adapted to distinguish its goods from the same or similar goods of other traders.

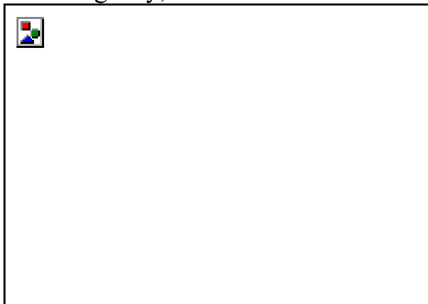
The signature mark is not a highly stylised writing of Elvis Presley's name. In fact its most notable features are the words of the name itself. There is nothing graphically or visually distinctive about the style in which the words are written. It is jut a simple, if not very fluent, cursive rendition of the name. On the face of it, the signature does not appear to me to be adapted to distinguish. Nevertheless, in accordance with the provisions of s.9(3)(b), in determining whether the mark is adapted to distinguish the court is "entitled to have regard to the extent to which by reason of the use of the trade mark or of any other circumstances" the mark is in fact adapted to distinguish the proprietor's goods. As noted above, Mr Prescott argued that the words "other circumstances" is of the widest generality. I agree. It is open to the court to look at all factors which point towards and away from distinctiveness. As was the case with the other two marks, there is no evidence that Enterprises used the signature, whether as a trade mark or otherwise, on any Class 3 goods in the United Kingdom and there is no evidence that any member of the public here has learned to treat it as a mark distinguishing goods as coming from a particular source. It therefore seems to me that none of the trading history helps Enterprises. On the contrary, such evidence as does exist showing

the way that Elvis Presley memorabilia is marketed world-wide points away from distinctiveness. The catalogues exhibited to Mr. Soden's statutory declaration show that there have been many instances where the names "Elvis" and "Elvis Presley" have been used in order or less cursive fonts on products but in a way which gives no suggestion that they are signatures. I have in mind particularly the following to be found in Bundle C;

Page 10 - *Elvis Presley* Belt Buckle
Page 11 - *Elvis Presley* "Love me tender" Necklace
Page 26 - Elvis Presley Jeans - *Elvis Presley*
Page 62 - *Elvis* small colour booklet
Page 65 - *The Elvis Presley Story*
Page 87 - *Elvis Presley* 1935 - 1977 (toothpick holder, cup shakers)
Page 90 - #1 Fan *Elvis, Elvis Presley* 1935 - 1977 (cup, plate, ceramic bell)

This is reinforced by the way in which Mr. Shaw has used his own mark and the name "Elvis Presley". His mark, which appears on many of his products, his headed notepaper and as the masthead of the fan magazine he produces, is;

and over the last eighteen years he has sold a variety of products bearing the name "Elvis Presley" depicted in the following way;



I have come to the conclusion that other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the name "Elvis" or "Elvis Presley" in a cursive script which is the same as or nearly resembles the script in the signature mark upon or in connection with their own goods. The mark is not adapted to distinguish in the sense used in the 1938 Act.
In addition to this, I have come to the conclusion that Mr. Shaw's objections to the signature mark on the basis of ss.11 and 12 are also made out. S.11 provides;

> "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".

and 5.12 provides;

> "(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."

Both parties agreed that the test to be applied in deciding whether the s. 11 objection is made out is that prescribed by Parker J. in *Pianotist Co's Application* (1960) 23 RPC 774;

> "You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse registration, or rather you must refuse the registration in that case".

Mr Prescott also drew my attention to the test adopted by Evershed J in *Smith Hayden's Application* (1946) 63 RPC 97. He dealt with both s.11 and 12;

> "(a) (under Sec.11) "Having regard to the reputation acquired by [the superior mark], is the Court satisfied that the [junior mark], if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons". (b) (under Sec. 12) "Assuming use by [the opponents] of their marks .... in a normal and fair manner for any of the goods covered by the registrations of those marks .... is the Court satisfied that there will be no reasonable likelihood of deception or confusion among a substantial number of persons if [the applicants] also use their [junior] mark normally and fairly in respect of any goods covered by their proposed registration?""

Those passages make it clear that unless the applicant, i.e. Enterprises, satisfies the Court that there is no reasonable likelihood of deception or confusion among a substantial number of persons, registration must be refused. So far as possible the register is to be kept clean of marks which run the risk of causing confusion or deception. I have already mentioned that Mr. Tuck in the registry came to the conclusion that Mr. Shaw's mark both as registered and used was a strong mark involving a degree of invention. Mr. Prescott did not challenge that assessment. If, contrary to my views, Enterprises' signature mark was adapted to distinguish in the trade mark sense, then the similarity between it and Mr. Shaw's mark would be likely to give rise to deception and confusion.

In the light of these findings it is not necessary for me to consider Mr. Shaw's additional point that there is no relevant evidence that the writing in the signature mark is in fact the signature of Elvis Presley.

I will allow the appeal in relation to all three applications.