

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2117532 BY
CORSAIR TOILETRIES LTD TO REGISTER
THE MARK JANE AUSTEN IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 47071 BY THOMAS FRANCIS CARPENTER,
CATHERINE JEANIE DEAN, LADY MAVIS COULSON,
PETER RUSSELL-JONES, AS TRUSTEES TO THE
JANE AUSTEN MEMORIAL TRUST**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2117532**
by Corsair Toiletries Ltd to register the mark
JANE AUSTEN in Class 3

and

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IN THE MATTER OF Opposition thereto under
No 47071 by Thomas Francis Carpenter, Catherine
Jeanie Dean, Lady Mavis Coulson, Peter Russell-Jones,
as trustees to The Jane Austen Memorial Trust

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DECISION

20 On 3 December 1996 Corsair Toiletries Ltd applied to register the mark JANE AUSTEN for
the following specification of goods:

25 "Soaps, perfumery, essential oils, eau de cologne, toilet water, body sprays, hair
lotions, dentrifices; toilet preparations, deodorants, anti-perspirants; preparations for
the care of the scalp, skin, hair and body; shampoos, bubble bath preparations; shower
gel, preparations for conditioning the hair, preparations for styling the hair, hair spray;
talcum powder, cleansing preparations, moisturising lotions and creams, skin make-up;
shaving and after-shave preparations."

30 The application is numbered 2117532.

On 19 June 1997 Thomas Francis Carpenter, Catherine Jeanie Dean, Lady Mavis Coulson,
Peter Russell-Jones, as trustees to The Jane Austen Memorial Trust filed notice of opposition
to this application. The grounds of opposition run to some eight pages. It will be sufficient if
35 I summarise them as follows:-

- (i) under Section 3(1)(a) in that the mark is a sign which is not capable of
distinguishing the goods of the applicants from those of other undertakings
- 40 (ii) under Section 3(1)(b) in that the mark is devoid of any distinctive character and
consists of a common christian name combined with a surname which taken
together with the phonetically identical surname "Austin" appears more than
400 times in the London residential telephone directory
- 45 (iii) under Section 3(3)(a) in that, given the reputation attaching to the name Jane
Austen, registration would be contrary to public policy having regard to the use
which registration would enable the applicants to make of the mark; the

precedent it would establish for use by others; and the prejudice it would cause to the Trust or persons authorised by the Trust

- 5 (iv) under Section 3(3)(b) in that, given the reputation and literary status of Jane Austen, use of the mark is likely to deceive the public into thinking that the applicants' goods have been approved or authorised by the trustees. Further it is said that use on goods other than those with a connection with the literature of Jane Austen would deceive the public as to the nature of the goods
- 10 (v) under Section 3(6) in that the application was made in bad faith because the applicants cannot claim to be entitled to the mark in suit; that registration and use would damage the literary and educational heritage of Jane Austen; that the applicants are or should be aware that there is no connection with the works of Jane Austen and the Memorial Trust; and that there is no intention to use the
- 15 mark on all or any of the goods in respect of which the application is made
- (vi) under Section 5(4) in that use of the mark is liable to be prevented by virtue of any rule of law (in particular the law of passing off).

20 The applicants filed a counterstatement denying the above grounds. Both sides ask for an award of costs in their favour.

Only the opponents filed evidence. The matter came to be heard on 1 June 1999 when the opponents were represented by Mr Cuddigan of Counsel instructed by Alexander Ramage Associates, Trade Mark Attorneys. The applicants were not represented but written submissions were made on their behalf by Reddie & Grose, Trade Mark Attorneys.

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Opponents' evidence

30 The opponents filed a statutory declaration by Thomas Francis Carpenter, the Chairman of the trustees of the Jane Austen Memorial Trust, a registered charity. A statement of the background is contained in the opponents statement of grounds. It would in my view have been preferable for this material to be contained in Mr Carpenter's evidence but I note that he confirms that the information is correct and his declaration covers much of the same ground

35 and provides material in support of the claims made. The applicants have done nothing to cast doubt on any of this material. For convenience, therefore, I reproduce the following summary of the background:

40 "5. The Trust owns the property known as Jane Austen's House at Chawton, Alton in Hampshire, which houses the Jane Austen Museum. Both the Trust and the said establishment have been active in the exposition of the works of Jane Austen, and in so doing, sell a substantial range of souvenirs bearing the name, signature or likeness of Jane Austen. The Trust has also been involved in the provision of advice to research teams, and filming facilities for news or features stories for broadcast teams and

45 presenters representing a range of networks from around the world, including the British Broadcasting Corporation and the Independent Television Companies in this country. Information and photography has often been provided to support

programmes and features generated by these broadcasting companies, and the facilities are regarded as merely one aspect of the educational function of the Trust.

5 6. The Jane Austen Museum, housed in a former residence of the author, receives a substantial number of visitors (57,000 in 1996) who also purchase souvenirs from the Museum.

10 7. The author, Jane Austen, is known for her six major novels - Sense and Sensibility (published 1811), Pride and Prejudice (published 1813), Mansfield Park (published 1814), Emma (published 1816), Persuasion (published 1818) and Northanger Abbey (published 1818). There were three secondary novels not published or unfinished during her lifetime - Lady Susan, The Watsons and Sanditon. Today the major novels in particular are regarded as worldwide best-sellers and her novels Sense and Sensibility, Pride and Prejudice and Emma have inspired numerous films or TV adaptations, which themselves have achieved international notoriety in their own right.

20 8. By reason of the activities referred to in paragraphs 5, 6 & 7 herein a substantial notoriety and reputation with attendant goodwill have been established in the Jane Austen nomenclature. Furthermore, the name and status of Jane Austen and the associated literary works have acquired substantial importance as great literary works and have thereby made a considerable contribution to the nation's heritage. In the circumstances, the Opponents are in a position to show that use by a third party of JANE AUSTEN is likely to deceive or cause confusion with consequential damage to Jane Austen nomenclature and literary status and/or otherwise cause prejudice to Jane Austen nomenclature and literary status."

In support of the opponents' position Mr Carpenter provides the following exhibits:-

30 TFC1 and 2 - a copy of the Conveyance concerning the property formerly held by the Jane Austen family and purchased for the original Trustees along with a Deed of Trust concerning the origins of the opponents

35 TFC3 - a copy of the advertisement of the application now under opposition

TFC4 - copy correspondence with various television companies

40 TFC6 - a selection of souvenirs bearing the name, signature and likeness of Jane Austen and sold at the Chawton premises."

Mr Carpenter says that:

45 "As the Applicants application covers products within Class 3 of the official nomenclature, it is well known and documented that Jane Austen did not use cosmetics and toiletry products of any significance and therefore any product of this nature which might be sold bearing the JANE AUSTEN name, signature or likeness as listed in the

application's specification, herein opposed, is deceptive in suggesting that Jane Austen had any association with such products in her lifetime or that if she did that she would approve of those which the Applicants will or may offer for sale. Jane Austen was not noted for her vanity as far as is known."

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He comments on issues to do with the applicants' choice of marks and suggests that the applicants are involved in plagiarism (exhibit TFC7). I do not propose to record these remarks as they are of marginal relevance only to the issues before me.

10 The remainder of Mr Carpenter's declaration mainly concerns the issues of law that arise in relation to the names of famous people (including exhibits TFC8 to 10); further information substantiating visitor numbers etc to the Jane Austen House (exhibit TFC11); and details from the 1997 London Telephone Residential Directory (TFC12) relating to the name Austen.

15 Mr Carpenter concludes by saying that:

20 "the Opponents believe that to use Jane Austens' name, likeness or signature for that matter, is not only deceptive if used by anyone other than the Trust or the Jane Austen Society referring to genuine Jane Austen material and creations but cheapens the memory of the famous authoress and of her globally known works, thus on behalf of the Opponents I trust that the application will be refused."

He exhibits (TFC13) a letter from the opponents to the applicants' agents seeking an amicable settlement. It seems that nothing came from this.

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That completes my review of the evidence.

Section 3 of the Act reads:

30 "3.-(1) The following shall not be registered -

(a) signs which do not satisfy the requirements of Section 1(1),

(b) trade marks which are devoid of any distinctive character,

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(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

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(d) trade mark which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

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

(2) A sign shall not be registered as a trade mark if it consists exclusively of -

(a) the shape which results from the nature of the goods themselves,

5 (b) the shape of goods which is necessary to obtain a technical result, or

(c) the shape which gives substantial value to the goods.

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

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

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

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(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.

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(5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).

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

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At the hearing Mr Cuddigan indicated that he would not be pursuing the objection based on Section 3(1)(a) and I do not, therefore, need to say anything more about that ground.

I will take the remaining grounds in order commencing with Section 3(1)(b).

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The trade mark issues surrounding names of well known individuals have recently attracted a good deal of attention and, not surprisingly, Mr Cuddigan relied on the ELVIS PRESLEY Trade Marks case (the High Court decision is reported at 1997 RPC 543, the Court of Appeal decision is dated 12 March 1999 but has not yet been reported). I was also referred to the older TARZAN Trade Mark case 1970 RPC 450. Both of these cases involved proceedings under the preceding law but the issues that they give rise to and the guidance that emerges seem to me to be of equal relevance in approaching proceedings under the current law subject, of course, to the necessary proviso that each case needs to be considered on its own particular facts. In particular, and for reasons which I will explain below, the names of well known individuals give rise to a variety of considerations and potential outcomes that suggest it is not possible to lay down a template that will cover all circumstances.

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I should say at the outset that there is no evidence before me that the applicants in this case have used the mark JANE AUSTEN so the proviso to Section 3(1) does not come into play and I have only the prima facie case to consider. My understanding is that the opponents do

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not go so far as to say that the mark is incapable of achieving registration but rather that in the absence of any such use the applicants cannot succeed. I was referred firstly to the following passage from TARZAN:

5 "I do not think that there is anything about the word TARZAN which would make it
inherently incapable of distinguishing the applicants' goods in any circumstances at any
future time. On the other hand, there is no evidence of use or any other circumstance
which makes the mark now in fact capable of distinguishing the applicants' goods.
Nothing that has been urged before us can, so far as I am concerned, undermine the
10 conclusion at which the learned judge arrived on this point. He said, however, that if
in the course of time the applicants' use of the mark did produce the effect of
associating the goods in question with these applicants, that is to say, if when the
public or the trade saw the name TARZAN it suggested that the goods in relation to
which it was used were connected in the course of trade with the applicants, they
15 might renew their application. He was not satisfied, however, that, as the matter now
stands, the word TARZAN was in fact capable of distinguishing the goods. I entirely
agree with that view."

The TARZAN case was one of a number of cases considered by Mr Justice Laddie and,
20 subsequently, the Court of Appeal in ELVIS PRESLEY where the question arose as to
whether anyone could claim the exclusive right to use the names (or the signature) of the well
known rock and roll singer. The following extracts from the headnotes will serve to
encapsulate the view reached by Mr Justice Laddie:

25 "(1) Ignoring any trade mark rights which might be secured, neither the singer nor
anyone else exclusively owned his name. There was no copyright in a name. Similarly,
no-one owned his likeness, apart from any copyright which might exist in a particular
reproduction.

30 (2) Whether or not the names could have been registered before Elvis Presley
achieved fame, their merits had to be judged at the date of application. At that date
Elvis Presley was so well known that his names (ELVIS was synonymous with ELVIS
PRESLEY) possessed very little inherent distinctiveness.

35 (3) ELVIS and ELVIS PRESLEY were peculiarly suitable for use on a wide range of
products sold as Elvis Presley memorabilia. These products were bought by many
because they carried the names and likeness of the singer and referred back to him, not
because they came from a particular source. There was no reason to believe that
current merchandising practice led the public to assume in all cases that products
40 bearing the name or likeness of a famous personality would come from a particular
source, ie from the personality himself or from his beneficiaries.

.....

45 (6) In considering use and any other circumstances which would permit registration,
all factors which pointed toward and away from distinctiveness had to be considered.
There was virtually no evidence that E. used the proposed marks as trade marks, or

otherwise, in the United Kingdom and there was no evidence that the public had come to regard them as trade marks. On the contrary, such evidence as existed concerning Elvis Presley memorabilia pointed away from distinctiveness."

5 These views were endorsed by the Court of Appeal. Mr Cuddigan drew my attention particularly to the following (per Morritt LJ):

10 "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.

20 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."

35 There are a number of obvious parallels between the ELVIS PRESLEY case and the one before me insofar as both individuals are, albeit for quite different reasons, well known; both cases involve parties who have some connection with the individual; and, perhaps coincidentally both revolve around goods (in Class 3) with which the well known individuals had no direct connection. Equally however, there are a number of marked differences. Elvis Presley died in 1977 and so is relatively recently deceased whereas Jane Austen died in 1817. Mr Justice Laddie records that "[Elvis Presley] Enterprises in some way carried on and has expanded on the merchandising activities which had been carried on by or on behalf of Elvis Presley before his death". For obvious reasons no such claim is made in relation to Jane Austen. Helpful though it is, therefore, to bear in mind the guiding principles arising from the ELVIS PRESLEY case it does not necessarily or straightforwardly point to the outcome of the case before me.

45 The underlying question I have to consider is whether use of the name JANE AUSTEN in relation to the goods of the application would be taken as an indication of trade origin or

whether it would be devoid of distinctive character for any of the reasons advanced by the opponents. The alternative arguments advanced by the opponents are that because of the reputation of the author the use of her name would be seen as satisfying a resultant demand for souvenirs or memorabilia; that it should be disqualified as it consists of a common christian
5 name and surname (taking into account also the incidence of the phonetically similar surname Austin); or that the name is required for descriptive use as (to use Mr Cuddigan's words) a <classically romantic reference'. It is the first of these grounds on which the opponents mainly rely but I will briefly consider the others in due course.

10 As to the first point it seems to me that the opponents are right, and consistent with the ELVIS PRESLEY decision, to suggest that if a well known individual's name is likely to result in a demand for memorabilia or commercial consumer items (neither Mr Justice Laddie nor the Court of Appeal considered the distinction to be a saving factor in the ELVIS PRESLEY
15 case) then the general public are unlikely to see that name as anything other than an indication of the content or character of goods rather than signifying trade origin. A number of factors are likely to have a bearing on how any given name is perceived and whether it is required for descriptive purposes in this way. In the case of literary or artistic figures in the broadest sense those factors might include:-

- 20 (i) the nature and extent of the individual's reputation
- (ii) whether there are any surrounding reasons why a trade in souvenirs etc may have developed, for instance, because of an individual's strong association with
25 an area (Hardy's Wessex or Bronte country) or a particular style (William Morris say)
- (iii) whether, in the case of contemporary figures, the individual established any trade mark rights during his or her lifetime
- 30 (iv) whether any existing trade in souvenirs, memorabilia etc exists or (in the case of someone recently deceased) can be expected to arise
- (v) whether descendants, the estate, trustees or other such body have, through use, established any rights in relation to the name of the individual (and, if so,
35 whether to the exclusion of others)
- (vi) the extent to which the life and works of the individual are kept alive either by general public interest or media coverage etc in such a way as to generate demand for commercial consumer items
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- (vii) the nature of the goods in respect of which registration is sought (see for instance the doubts expressed in the Court of Appeal regarding the applicability of the objection in relation to the Class 28 goods of the TARZAN application).

45 The above is not, of course, intended as an exhaustive list and it would be equally true to say that not all of the factors will be relevant in every case. Merchandising in particular is, in relative terms, a recent phenomenon. In the case of well known individuals from the more

distant past it is the demand for commercial consumer items that is likely to be a more relevant consideration.

5 Against this background it is not difficult to see that in the case of a well known literary figure
such as William Shakespeare there is likely to be a high level of demand for commercial
consumer items generated by his widespread fame, his association with the Stratford-on-Avon
area and the many tourist attractions based around his life and works. His name or image is
highly unlikely to be an indicator of trade origin for a broad range of souvenir type items. On
10 the other hand the names of literary figures of somewhat lesser repute or whose memory is
less well preserved may be capable of fulfilling the functions of a trade mark. Where then does
the name JANE AUSTEN stand? I do not think there can be much doubt about Jane Austen's
standing in the literary field. Although her canon is relatively small her novels are held in high
esteem and their popularity has endured. They are not simply of interest as academic texts.
15 As is apparent from the evidence there is continuing interest from television companies and the
novels have been turned into major television series and films. The Jane Austen house at
Chawton in Hampshire and the activities of the Trust have provided something of a focal point
for this continuing interest in the author. I note too that this interest has extended to wider
areas of publicity such as Chawton featuring on the 'Holiday' programme. The opponents are
probably right to infer that the large increase in visitors to the house in 1996 and 1997 is a
20 direct consequence of the various television series and programmes. More directly relevant,
however, to the issue before me is the fact that the Memorial Trust has developed a trade in
souvenirs relating to Jane Austen, her life and works. Exhibit TFC10 lists over 50 items that
are available ranging from aprons, bookmarks, posters, stationery items, mugs, key rings,
paper weights, tea towels, clothing and china etc. Some actual examples of such goods are at
25 Exhibit TFC6. I will comment further on this in relation to the Section 5(4)(a) ground.
Suffice to say at this point that the opponents have established that a fairly typical range of
souvenir items are available bearing the name Jane Austen, her image or some other
association with her. It is acknowledged that soaps, perfumes and the other goods that are the
subject of the application in suit are not at present offered for sale but it would, I think, be no
30 surprise to find such goods featuring in a list of souvenir items as an extension of this trade.

The applicants say in the written submissions put forward on their behalf:

35 "In contrast to the ELVIS and ELVIS PRESLEY names, the mark of the application,
JANE AUSTEN, means no more to the man in the street than the name of a long-dead
authoress. Sent out to acquire a JANE AUSTEN body spray, for example, he would
not, it is submitted, be looking for a commemorative article and, if in the course of his
visit to the chemists he were to come across a JANE AUSTEN body spray, he is
highly unlikely to have cause to say to himself "they must have a licence from the
40 person who owns the rights in the books of the now long dead authoress", in particular
given that the copyright in the books has expired. The authoress has not reached a
level of fame where the purchaser is buying the name rather than the product. Her
likeness, it is submitted, would not be recognised by her average consumer. It would
be wrong to compare the mark JANE AUSTEN with the names ELVIS and ELVIS
45 PRESLEY. The marketing angle intended by the Applicant when this name was
derived was to conjure up old fashioned fragrances and images of bonneted ladies.
The mark JANE AUSTEN is *prima facie* distinctive of the Applicant's goods."

I accept the applicants' submission that a purchaser encountering a JANE AUSTEN toiletry would not necessarily assume a licensing arrangement with some body or person connected with the author. But that is not, I think, the point at issue. The opponents have been cautious as to what claims they themselves might have. Their main concern, it seems to me, is to prevent the applicants or others gaining what they see as an undeserved monopoly without having established thorough use that goods sold under a descriptive mark are associated with them. The circumstances here are somewhat different to the ELVIS PRESLEY case where there was, it seems, an established merchandising trade before his death. It should not be assumed that the sort of commercial activity that is now commonly associated with well known individuals will necessarily arise in the context of historical figures. There is no evidence before me to indicate how other traders or the public would view use of the name JANE AUSTEN. I note that the opponents refer to a third party registration (their attitude to this is likely to be influenced by the outcome of this action) but there is no evidence that the registration (covering three Classes) is being used. So far as I can tell, therefore, the only use with which the public will be familiar is the souvenir trade and other activities conducted by the opponents. For reasons which I will expand on in relation to the Section 5 ground I do not think that use will be seen as anything other than indicating the nature and subject matter of the goods. Unless educated through use to see the name differently the public will not in my view regard it as a badge of origin. Accordingly the opposition succeeds under Section 3(1)(b).

In the light of the above finding I need give brief consideration only to the other Section 3(1)(b) objections. The first relates to the inherent characteristics of the proposed mark consisting as it does of a forename and surname combined (leaving aside the fame of the author). The Registry's published practice is set out in Chapter 6 of the Work Manual at 3.12.8 as follows:

"Full names have, by their nature, a greater capacity to distinguish the goods/services of one undertaking than a surname per se. The Registrar takes the view that, unless the full name is extremely common, eg JOHN SMITH *and* the number of traders involved in the relevant market is very large, eg clothing, the likelihood of a number of different traders using the same full name as a badge of origin is sufficiently remote that the public are likely to take a full name as a sign which indicates goods or services from a single source. Such marks will therefore usually be accepted prima facie."

The evidence submitted by the opponents is that the surname Austen is relatively uncommon using the London Telephone Directory as a yardstick. The phonetically similar surname Austin is significantly more common but I do not consider that acceptance of the mark at the examination stage was inconsistent with the published practice. The other issue raised is that the associations or images conjured up by the name make it apt for use as a classically romantic reference. On reviewing the papers I am not at all clear that this has been explicitly pleaded and arguably should not be addressed at this late stage. However I can dispose of the point fairly briefly as whatever characteristics or associations the name might have are not in my view so clearly defined as to constitute any reasonable basis for objection. The opponents, therefore, fail in these supplementary grounds.

Mr Cuddigan took Sections 3(3)(a) and (b) together at the hearing as being in various ways issues arising from Jane Austen's fame as an author. It seems to me that there is a fundamental problem with objections under these heads if I have correctly understood the opponents' position which is that the mark could through use overcome all the potential hurdles and
5 achieve registration. Such use could bring an applicant within the proviso to Section 3(1) but there is of course no comparable means of overcoming an objection under Section 3(3) or the other subsections. This must raise the question as to whether objection arises in the first place. Beyond this however I am not persuaded that there is a public policy issue involved. Mr Cuddigan put it to me that the names of historical figures should not be "acquisitively
10 registered". I have already suggested that each case needs to be considered on its particular facts taking account of all the factors which might have a bearing on the capacity of the name to function as a badge of origin. I am not aware of, or been directed to, any particular authorities on the question of what is or is not a matter of public policy. I would have some difficulty in accepting that such an issue arises in relation to the names of famous individuals
15 given that each case is likely to turn on its own facts.

The concluding remarks of Simon Brown LJ in the Court of Appeal's consideration of the ELVIS PRESLEY case were:

20 "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
25 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
30 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."

35 Given the unwillingness to legislate in respect of character or personality rights it would in my view be unwise to assume that there is nevertheless a public policy interest going beyond whatever rights may be built up and protected through other areas of law. I am unable, therefore, to find in the opponents' favour under Section 3(3)(a). Similar considerations also apply under Section 3(3)(b) where the opponents claim that the public would be deceived into thinking that goods sold under the mark would have the approval of the trustees or that the
40 goods have a connection with the literature of Jane Austen. The opponents themselves say that Jane Austen had no particular connection with cosmetics and toiletry products any more presumably than the other gift and souvenir items offered by the Memorial Trust. The public is well aware of the nature of the commercial trade in such goods and would not be deceived into believing that a connection of the kind envisaged by the opponents existed. More

importantly, however, the objection as framed has more to do with association as to origin and does not appear to be appropriate to a Section which is dealing with objections on absolute grounds as a result of some inherent characteristic of the mark. The Section 3(3)(a) and (b) grounds fail.

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The opponents' objections under Section 3(6) is broken down into a number of sub-heads as indicated in the summary of the grounds. Three of them relate specifically to issues to do with Jane Austen's reputation as an author. The other basis of objection is that the applicants have no intention to use the mark in respect of some of the goods (or at all).

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The Notes on the Trade Marks Act 1994 (based on the Notes on Clauses which were prepared for use in Parliament when the Trade Marks Bill was before it) suggest, by way of an example, that bad faith might be found:

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"(iii) where the mark incorporates the name or image of a well-known person without his agreement. (This should not be taken as meaning that this provision is legislating for the protection of a personal name or reputation - these remain unprotected under English law, but the nexus between unregistrability and the name of a well-known person is that of the bad faith in which the application is made.)"

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The above is directed towards well-known persons who are still living. It could conceivably extend to cover the position of administrators of the estate of a deceased person where some intellectual property right existed or had been acquired. It is more difficult to see its relevance in the context of historical figures. Mr Carpenter in his declaration for the opponents says that "the applicants do not own Jane Austen, her past, her reputation or her literature *any more than the opponents do*. The Opponents, as a matter of public interest, only seek to preserve the dignity of the reputation and status of Jane Austen as a literary giant and to finance themselves to that end". (my emphasis). Mr Cuddigan suggested that this should not be read as if it were a statement in relation to the law. That may well be the case and it would also be going too far, I think, to say that it amounts to a claim that no intellectual property rights can ever exist in the name not least because the opponents themselves suggest that such a right exists under Section 5(4)(a) (see below). However the objection here has been framed not in terms of competing claims to ownership but by reference to some general disentitlement on the applicants' part arising from Jane Austen's fame and her literary heritage. Specifically it is said that the applicants should have been aware of the Jane Austen nomenclature and works; that registration and use will prejudice and damage the literary and educational heritage of Jane Austen; and that there is no connection between the application in suit and the literary works of Jane Austen and the Memorial Trust. It is said on the applicants' behalf that the choice of mark was intended to "conjure up old fashioned fragrances and images of bonneted ladies". There is no suggestion that the applicants were aware of or should have been aware of the Memorial Trust. It is true that the application appears to have been filed at about the time that particular interest was being generated by television and film dramatisation of the novels. That might suggest commercial opportunism but not in my view bad faith.

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Mr Cuddigan suggested that it was inappropriate for the name of a historical literary figure to be registered as a trade mark. I cannot see that any general presumption of this kind exists though as I have already indicated such names may be open to objection for other reasons

depending on the particular circumstance of the case. It follows also that I cannot accept that there will be any damage to Jane Austen's literary heritage. Trade in the goods at issue under the mark would in my view have no discernible effect on Jane Austen's standing as an author.

5 So far as the issue of lack of intention to use is concerned there is in my view no evidence bearing directly on the point. The opponents point to the number of pending and registered marks in the applicants' name but this is insufficient for me to draw any conclusion adverse to the applicants. None of the Section 3(6) grounds are made out.

10 Finally there is the claim made under Section 5(4). So far as appears to be relevant this reads:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

15 (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

20 A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

This again is broken down into three strands, two of which relate to issues that I have largely covered already that is to say the risk that the applicants will engender a belief that they are
25 connected with the trustees of the Memorial Trust and the possible damage to the author's literary standing. The opponents also refer to the reputation and goodwill built up in the Jane Austen nomenclature. I take this to represent a claim under Section 5(4)(a). A summary of the elements of an action for passing off were set out in WILD CHILD trade mark (1998 RPC 455). Briefly, the opponents are required to establish that they have goodwill in an
30 indicium; that there will be an operative misrepresentation and that there will be consequential damage.

The opponents have provided little information which directly supports the ground. There is some information on the number of people visiting the house at Chawton and a sample
35 indication of cash receipts resulting therefrom for a week in September 1996. There is also the listing of souvenir items together with a price list but no information on the level of sales. Furthermore it is by no means clear from consideration of the Exhibits at TFC6 that they would be seen as creating goodwill in an indicium or at least one relevant to the opponents' case. I say this because many of the items such as postcards appear to carry the card
40 manufacturers' mark together with a purely descriptive indication of the subject matter (views of the house, the author's writing table, scenes and quotations from the novels). Other items such as the cross-stitch kit refer to copyright and design claims of third parties. The most that can be said is that a number of the items refer to the Memorial Trust.

45 In short the claim to goodwill lacks proper substantiation and faces fundamental difficulties in terms of the nature of the use shown. The opponents cannot, therefore, succeed under Section 5(4)(a).

In the event the opposition is successful as a result of my finding in relation to Section 3(1)(b). The opponents are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £835.

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Dated this 12 day of July 1999

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15 **M REYNOLDS**
For the Registrar
the Comptroller General