

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2174300 BY  
A FARLEY TO REGISTER THE MARK PQASSO IN  
CLASSES 16 AND 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
NO 49545 BY THE JOINT OWNERSHIP ON THE MONOPOLY  
OF THE INTELLECTUAL PROPERTY ATTACHED TO THE  
WORK OF PABLO PICASSO**

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the Monopoly of the Intellectual Property  
attached to the work of Pablo Picasso**

### **DECISION**

1. On 7 August 1998 A Farley applied to register the mark PQASSO for:
  - Class 16 - printed matter, instructional and teaching material
  - Class 41 - training relating to quality assurance systems
2. The application is numbered 2174300.
3. On 2 March 1999 The Joint Ownership on the Monopoly of the Intellectual Property attached to the work of Pablo Picasso filed notice of opposition to this application.
4. The opponents are an organisation administered by Mr Claude Ruiz Picasso the son of the famous artist and painter, Pablo Picasso. The opponents are tasked with overseeing and regulating usage of the artistic and intellectual property rights subsisting in the work of the late Pablo Picasso, including, it is said, the control of usage of the name PICASSO as a trade mark in the United Kingdom and worldwide. The opponents contend that the mark of the subject application is the phonetic equivalent of PICASSO and visually closely resembles the name.
5. Arising from this objection is said to arise under Section 3(1)(b)(c) and (d) and also under Section 3(6). The latter ground is said to arise because the opponents have not granted permission to use the name PQASSO nor has the applicant sought consent from the opponents. The opponents, therefore, say that the application was filed in bad faith.
6. The applicant filed a counterstatement in which he says inter alia that:
  - “The name PQASSO is an acronym for Practical Quality Assurance Systems for Small Organisation, and is based on a workbook that I wrote for small voluntary organisations to help them set up basic quality systems.

I also run a small company registered as PQASSO Management Ltd, which provides training and consultancy for voluntary sector organisations. I have an email address and a website using the PQASSO name.

There is no connection between the artistic works of Pablo Picasso and PQASSO (pronounced as PKWASSO). It is not the phonetic equivalent, nor does [it] visually closely resemble the name. Anybody who has an interest in Picasso would know it is not spelt that way.

There is no link between the intellectual rights of his descendants to his artistic works, and the material I produce, as it is textual and relates to quality systems. The logo is used on training material that I develop. It has been in use for three years now, and has never been confused by anybody with Picasso, or anything to do with him, or his works. It does not have any artistic pretensions, and I would not wish it to.”

7. Both sides ask for an award of costs in their favour. Both sides filed evidence. The matter came to be heard on 5 February 2001 when Mr Farley represented himself and Mr B Marsh of Wilson Gunn M’Caw represented the opponents.

### **Opponents’ Evidence**

8. The opponents filed a declaration by Claude Ruiz Picasso, the son of the famous artist and the administrator of the opponent organisation (hereinafter referred to as the Estate). The main points to emerge from his evidence are:
  - S the Estate regulates usage of the artistic and intellectual property rights subsisting in the late artist’s work and also it is said, usage of the name PICASSO
  - S the Estate is represented in the UK by the Design and Artists Copyright Society (DACS)
  - S DACS processes applications for licensees for the reproduction of the works of Picasso in consultation with the Estate
  - S permission to reproduce Picasso’s works is subject to DACS terms and conditions, payments of fees and credit being given to the name PICASSO. Net revenue for 1997, by way of example, was £52,856
  - S the name PICASSO is famous and synonymous with the work of Pablo Picasso.
9. Various exhibits are supplied in support of the above. Reference is also made to a Community Trade Mark registration. The significance of this is not clear in the context of the grounds pleaded.

### **Applicant’s Evidence**

10. Mr Farley filed a declaration in support of his application. For the most part this confirms the basic information provided in his counterstatement and provides exhibits to support the claims made. The

quality assurance system published under the mark was launched in 1997 and is said to have acquired a distinctive character before the date of application. There is, however, insufficient evidence to establish this latter point. Mr Farley says there has never been any confusion between his PQASSO system and Picasso. He also offers a number of submissions on the question of visual and phonetic similarity between PQASSO and PICASSO. I will deal with these points in my decision below.

11. That concludes my review of the evidence to the extent I consider it necessary.
12. At the hearing Mr Marsh led with the opponents' case under Section 3(6). I infer that this is considered to be their strongest case. Section 3(6) reads:

"A trade mark shall not be registered if or to the extent that the application is made in bad faith".
13. The Notes on the Trade Marks Act 1994 (based on the Notes on Clauses which were prepared for use in Parliament while the Trade Marks Bill was before it) gives as an example of a circumstance where bad faith might be found:

"(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.)"
14. The above is directed towards well-known persons who are living. However I see no reason why it could not extend to cover the position of administrators of the estate of a deceased person.
15. The 'Notes on Clauses' do not themselves have any statutory force. Guidance on the approach to dealing with a bad faith claim was given by Lindsay J in *Gromax Plasticulture v Don & Low Nonwovens Ltd*, 1999 RPC 367.

"I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances."

16. Thus it seems that business dealings which, though not actually dishonest, may be caught by the provision if they fall short of standards of acceptable commercial behaviour. This includes conduct that is not fraudulent or illegal, but may be regarded as unacceptable or less than moral in a particular business context and on a particular set of facts. Commenting on the passage from *Gromax* reproduced above, in *Demon Ale Trade Mark* [2000] RPC 345, the Appointed Person stated:

"These observations recognise that the expression "bad faith" has moral overtones which appear to make it possible for an application for registration to be rendered invalid under

Section 3(6) by behaviour which otherwise involves no breach of any duty, obligation, prohibition or requirement that is legally binding upon the applicant."

17. The test is an objective one (Autonet Trade Mark, O-257-00) and bad faith may be found where an applicant sees nothing wrong in his own behaviour (Demon Ale Trade Mark).
18. In addition to such objections as arise from Picasso's fame as an artist Mr Marsh also suggested that the evidence pointed to the opponents' having some established trade mark rights of which, by implication, the applicant should have been aware. They have not pointed to any UK registration of their own. There is a reference in the evidence to a Community Trade Mark but it does not figure in the pleaded grounds. Nor have the opponents pointed to common law rights which might provide the basis for an objection under Section 5(4)(a). What they do claim is an active copyright protection and licensing regime. But so far as I can see that relates to reproductions of Picasso's paintings and has no bearing on the issue before me. Even allowing for the fact that it is a condition of each reproduction that credit must be given to the artist's name (ie. descriptive use) that has no relevance to the Section 3(6) ground. As Laddie J indicated in *Elvis Presley Trade Marks*, 1997 RPC 543, ignoring any trade mark rights which might be secured, there is no copyright in a name.
19. Mr Farley, for his part, has explained how he came to adopt the mark PQASSO, it being an acronym for Practical Quality Assurance Systems for Small Organisations. Mr Marsh suggested that this was somewhat contrived and questioned why it was necessary for the acronym to sound so like the name Picasso. On the basis of the above authorities, even though Mr Farley saw nothing wrong with his adoption of the mark, that might not save the application once an objective test is applied. Fundamental to this whole question is what I make of the mark PQASSO in the first place. My view on this is likely to have a bearing not just on the Section 3(6) ground but also on the grounds under Section 3(1)(b)(c) and (d).
20. The mark at issue is clearly not the word PICASSO. The opponents' case is, therefore, heavily dependent on them establishing that notwithstanding this fact, it would be taken to be the artist's name. The visual differences between PQASSO and PICASSO are obvious. Even allowing for the possibility of misspellings I cannot think that any one would suppose the artist's name is written this way. I know of no other word in the English language commencing with PQ. Furthermore if there are words which do not have a U following a Q they are likely to be few and far between. The result is that the applicant's mark is an unusual combination. It is highly unlikely to be taken as the name of the artist.
21. Mr Marsh's submissions at the hearing concentrated primarily and necessarily on the potential phonetic similarity between PQASSO and PICASSO. Mr Farley says his mark is pronounced PKWASSO (a closer phonetic rendering is said to be PER-KWA-SO). There is no evidence before me as to how the public would pronounce it or even whether they would treat it as an acronym rather than an abbreviation. In my view it is conceivable that some people might try to pronounce the applied for mark as an approximation of PICASSO. I say this because there is a natural disposition, when faced with an unrecognisable word or acronym, to pronounce it by reference to some equivalent sounding word that is known. Allowing for that does it help the opponents? In my view it does not. Even if some people, on encountering the mark, chose to pronounce it by analogy with the name PICASSO they would not thereby be mistaking it for the artist's name with the adverse consequences stemming from that that the opponents would have me accept.

22. Names are personal identifiers and even relatively small differences do not usually go unnoticed (Smith/Smyth/Smythe for instance). Whether a small variation in a relatively unusual name (Picasso written with one s for instance) would escape objection, if the choice of PICASSO itself as a mark was found to be objectionable, is perhaps debatable. But I have come to the clear view that there is no basis for a finding of bad faith in the circumstances of the case before me.
23. Two further aspects call for comment. The first is that in coming to the above view I have not needed to consider the potential extent of an objection under Section 3(6). Where an objection is raised based on the fame of an individual it seems to me to raise a number of interrelated questions about the nature and extent of that fame and the relationship between it and the goods/services of the application to which objection has been raised. Prima facie the closer the goods or services to the famous individual's area of fame or expertise the more readily sustainable an objection is likely to be. The converse is also likely to be true. The core services of interest to the applicant here, that is training in quality assurance systems, do not immediately strike me as being an area of trade which would obviously attract objection in terms of the artist's reputation. However for the reasons given above I do not consider that this is a case which fully tests the scope of Section 3(6) in this way.
24. The second point I must briefly touch on is the suggestion made in submissions that in his trade literature Mr Farley has adopted a form of representation of the word PQASSO which is or might be reminiscent of Picasso's signature (as purportedly shown in a number of the exhibits such as CRP A). The representation concerned is a hand drawn form of PQASSO. Mr Marsh suggested it looked as if it was executed with a brush or a piece of chalk. That may be so but it is block capitals and not signature form. To suggest that it is in some way an attempt to bring to mind the artist's signature is in my view fanciful. It follows that the opposition fails under Section 3(6).
25. Section 3(1) reads as follows:
- "3.-(1) The following shall not be registered -
- (a) signs which do not satisfy the requirements of Section 1(1),
  - (b) trade marks which are devoid of any distinctive character,
  - (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
  - (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:
- Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."
26. Submissions at the hearing concentrated on Section 3(1)(b). It is, I think, accepted that if the

objection cannot be made out under this general head the opponents will not be in any better position under paragraphs (c) or (d). I was referred to two reported cases (Elvis Presley Trade Marks, 1999 RPC 567, and Jane Austen Trade Mark, 2000 RPC 879) involving applications to register the names of well known individuals. The ELVIS case was decided under the preceding law. The JANE AUSTEN case was decided under Section 3(1)(b) of the 1994 Act. Both cases involved consideration of the capacity of the names of the individuals concerned to function as badges of origin, that is to say whether the public would purchase the merchandise because it came from a particular source or simply because it carried the name of the famous individual (ie. as a souvenir item).

27. There are a number of significant differences between these cases and the one before me which mean they cannot be determinative of this case. Both involved the actual names of the famous individuals and both involved goods (in Class 3) which often feature as souvenir items. That is not the case with the mark PQASSO or the services of quality assurance training.
28. It seems to me, therefore, that the high point of the opponents' case must be the question of whether PQASSO would be descriptive of the content or subject matter of 'printed matter, instructional and teaching material' relating to the famous artist.
29. For the reasons given above I discount any suggestion that in visual terms the mark is open to objection. The matter therefore, turns on whether the word PQASSO might nevertheless be pronounced as if it were the name Picasso and, if so, what the consequences are.
30. In *Froot Loops Trade Mark*, 1998 RPC 240, Simon Thorley QC, sitting as the Appointed Person, took the view that the mark at issue FROOT LOOPS was the phonetic equivalent of FRUIT LOOPS and open to objection in relation to 'loop shaped cereal containing fruit' just as much as the words in their correctly spelt form. He concluded that decision by saying that:

"I should make it plain that I was not called upon to decide whether the phonetic equivalence dicta of *Electrolux* did represent the law under the 1994 Act. Had I been asked so to do I should have indicated, pursuant to section 76(3)(a), that such an argument appeared to me to involve a point of general legal importance and would have given the parties an opportunity to make representations as to whether the appeal should be referred to the court."

31. I have not been referred to any relevant court authorities on the point. The Registry practice in relation to mis-spellings and phonetic equivalents of descriptive words can be found at paragraph 4-12 of Chapter 6 of the Work Manual. The guidance (and it is merely that) is that objection may arise if the word presented for registration is a common mis-spelling of a descriptive word (xtra for extra for instance) or it is a mis-spelling which fails to disguise the descriptive word on which it is based (the FROOT LOOPS type of case). The guidance goes on to indicate that:

"d. In the (relatively rare) circumstances where the mis-spelling effectively disguises descriptive words and creates a significant 'surplus' (eg PNEUSTILE - new style), there will be no objection;

e. Mis-spellings of words which, in the true spelling, would be excluded by Section 3(1)(b) alone - such as surnames and other non-distinctive (but not descriptive) words - will not normally face an objection, eg LUWIS (Lewis)."

32. It is probably not appropriate to write in terms of PQASSO attempting to disguise the word Picasso because I do not think it was the applicant's intention to suggest the artist's name. The most that can be said is that the name Picasso may be said to provide a convenient reference point for pronunciation purposes. I doubt that it would be seen as a covert descriptive reference to the nature of the goods or services. I can in any case see no objection to the mark being applied to the quality assurance system training services in Class 41 (services which have no obvious association with Picasso). The Class 16 specification is, however, more general in scope and is for 'printed matter, instructional and teaching material'. It seems probable from the evidence that in fact this is documentation in support of the Class 41 services but there is no restriction to that effect. As I have already said it may be that, contrary to Mr Farley's expressed intention, some people will pronounce PQASSO as if it were Picasso because that name represents the closest phonetic benchmark. Should that influence my decision in relation to the Class 16 Specification? In my view it should not. Even assuming (which is not certain) that a phonetic rendition produces 'Picasso' or something equivalent I do not consider that any one would have cause to think that it was descriptive usage. There would be little point in using the mark in relation to printed matter about Picasso because the artist's correct name would be used not a mark that is obscured in this way. The Section 3(1)(b) objection also fails and with it the objections under paragraphs (c) and (d). PQASSO has not been shown to be customary in the language of the trade (d). Nor with the future in mind is it a mark that may be required in trade for any of the reasons expressed in paragraph (c).
33. As the opposition has failed the applicant is entitled to an award of costs. I order the opponents to pay the applicant the sum of £635. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated Monday this 19<sup>TH</sup> day of February 2001**

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