

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 11941
BY LADY SARAH McCORQUODALE
AS EXECUTOR OF THE ESTATE OF DIANA, PRINCESS OF WALES
FOR THE REVOCATION OF TRADE MARK No. 1293766
IN THE NAME OF H KALATIZADEH AND Y KALATIZADEH**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 11941
by Lady Sarah McCorquodale as executor of the estate
of Diana, Princess of Wales
for the revocation of Trade Mark No. 1293766
in the name of H Kalatizadeh and Y Kalatizadeh**

BACKGROUND

1. Trade Mark No. 1293766 is for the trade mark DIANA and is registered in Class 14 for the following specification of goods:

“Precious metals and their alloys and articles made therefrom or coated therewith, jewellery, precious stones and pearls; watches and clocks and parts and fittings for the aforesaid goods; all included in Class 14.”

2. The mark stands registered from the filing date of 27 November 1986.

3. On 22 September 2000 Lady Sarah McCorquodale, as Executor of the estate of Diana, Princess of Wales, applied for the revocation of the trade mark registration under Section 46(1)(d) of the Trade Marks Act 1994 on the grounds that in consequence of the use made of it by the proprietor it is liable to mislead the public, particularly as to the nature, quality or geographical origin of the relevant goods. In the Statement of Case the applicant goes on to say that, while the registered mark consists of the word DIANA in plain type face, the registered proprietors have taken to using it in conjunction with a Crown or Coronet device in place of the dot above the letter “i” and that the addition of this device makes the proprietors’ mark liable to mislead the public that the proprietors’ goods are in some way connected with or approved by the Estate of Diana, Princess of Wales and/or the Diana, Princess of Wales Memorial Fund when there is no such connection or approval.

4. The registered proprietors filed a Counterstatement denying the grounds of revocation and stating that use of the proprietor’s mark as claimed by the applicant would not be “use” as defined in Section 46(2) of the Act, since such use would alter the distinctive character of the mark as registered.

5. The applicant filed evidence and both sides requested an award of costs in their favour. Neither party requested a hearing but the registered proprietor, through its trade mark attorneys, Withers & Rogers, forwarded written submissions for the Hearing Officer to take into account in the making of the decision.

Applicant for Revocation's Evidence

6. This consists of a statutory declaration by Andrew Charles Dobson dated 15 May 2001. Mr Dobson is a partner in the firm of Lawrence Graham, Solicitors, professional advisors of the applicant.

7. Mr Dobson refers to Exhibit ACD1 to his declaration which contains copies of documents to illustrate that the mark in suit is registered in upper case and in ordinary plain script and is not adorned with any device element. Mr Dobson adds that since the date of registration, the registered proprietors have adapted their mark to contain a "crown" or "coronet" device. He states that the proprietors trade under the trading style "London Pearl Company" and that "London Pearl Company" notepaper and promotional literature and materials include an ® symbol (which is indicative of a registered trade mark), directly to the right of the DIANA trade mark incorporating the "crown" device.

8. Mr Dobson goes on to draw attention to pages 4-11 of his Exhibit ACD1 which, contains examples of material produced by the London Pearl Company containing the DIANA plus "crown" device trade mark. An example of this mark is as follows:



9. Mr Dobson submits that the presence of a crown device in the use of the registered proprietors mark is highly significant and misleads the public. He adds that the registered proprietors have made several approaches to the Diana, Princess of Wales Memorial Fund since February 1988 requesting "official" approval from the Memorial fund in re-launching its range of "Diana" items, but he makes it clear that there has been no such approval.

10. Next, Mr Dobson points out that the Estate of Diana Princess of Wales has obtained a European Community Trade Mark Registration (No. 791905) in Classes 3, 9, 14, 16 and 25 and a UK Trade Mark registration (No. 2217075) in Classes 3 and 31 for the following marks:



European Community Registration
No. 791905



United Kingdom Registration
No. 2217075

11. Mr Dobson declares that the Estate's "D plus crown" trade mark features as a logo on all products authorised by the Estate and Memorial Fund and has been used in this way since December 1997. He adds that the success of the Memorial Fund's activities shows the perceived and very real strength of any association with the late Princess of Wales.
12. This completes my summary of the evidence filed in this case.
13. The registered proprietors have submitted written submissions for my consideration and I take them fully into account in reaching my decision.
14. In summary the registered proprietors admit use of the following unregistered trade mark:

Diana

15. They admit that, as the above trade mark is unregistered, the proprietors were "in error" to use it accompanied by the "R" symbol and thereby indicate that it was registered. They add that of the "R" symbol with the above mark has now ceased.
16. The registered proprietors go on to submit that as the mark in suit (the registered mark) does not incorporate a crown device, the applicant's reason for seeking revocation does not exist. Furthermore, the applicant has raised no objection to the registered mark.
17. The registered proprietors point out that Diana is a common female forename in the UK and they state that there is no reason why the public should associate the name Diana, used in relation to the goods, with the late Princess of Wales. They add that even if the goods

specifically related to the late Princess e.g. use of the word DIANA and the late Princess of Wales' image on commemorative items, the public would see the word DIANA as indicating the nature of the goods and not their trade provenance.

18. In the submission of the registered proprietor, even use of the name or image of the late Princess on commemorative items would not imply approval by the Diana, Princess of Wales Memorial Fund or by anyone else. They go on to draw attention to the decision of the Registry dated 31 July 2000 when an application (by the applicant for revocation in the current case) to register the words DIANA, PRINCESS OF WALES as a trade mark was rejected by the Registry.

19. I now turn to the decision.

DECISION

20. The only ground of revocation is Section 46(1)(d) of the Act, which reads as follows:

“**46.**-(1) The registration of a trade mark may be revoked on any of the following grounds -

- (a)
- (b)
- (c)
- (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.”

21. Section 72 of the Act is also relevant in that it places the onus on the applicant to show that the registration should be revoked.

It states:

“**72.** In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

22. In essence, the applicant bases its case on the premise that use of the registered mark with the addition of a “crown” device makes the mark, as used, liable to mislead the public. The registered proprietors counter that use of the registered mark with the addition of the “crown” device constitutes use of a different, unregistered, trade mark, since such use would alter the distinctive character of the mark as registered. On this point my attention has been drawn to Section 46(2) of the Act which reads as follows:

“46.(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.”

23. From the above it follows that if the addition of the “crown” device alters the distinctive character of the mark in the form in which it was registered, there will have been no use of the mark for the purposes of Section 46(1)(d).

24. In my considerations in relation to the distinctive character of the mark I am guided by the following comments of Lord Walker of Gestingthorpe who in the recent Court of Appeal decisions in *Budejovicky Budvar Narodni Podnik v Aneuser Busch Inc* (A3/2002/0048, A3/2002/0049), stated at paragraphs 43 to 45:

“43 *The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?*

44. *The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:*

“Bare ruin’d choirs, where late the sweet birds sang”

is effective whether or not the reader is familiar with Empson’s commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. *Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of ‘whose eyes? – Registrar or ordinary consumer?’ is a direct conflict. It is for the Registrar, through the hearing officer’s specialised experience and judgment, to analyse the “visual, aural and conceptual” qualities of a mark and make a “global appreciation” of its likely impact on the average consumer, who “normally perceives a mark as a whole and does not proceed to analyse its various details.”*

*The quotations are from paragraph 26 of the judgment of the Court of Justice in *Lloyd Schuhfabrik v Klijsen Handel* [1999] ECR I – 3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance.”*

25. The mark under consideration (the composite mark) comprises the well known female forename DIANA and the device of a “crown”. The “crown” device is relatively simplistic in

appearance and is not, as far as I am aware, a representation of any particular crown or any protected symbol. While the word DIANA is the dominant element within the mark the “crown” device is a prominent feature, having an obvious impact upon the totality of the mark. Furthermore, it is my view that the word DIANA is in itself distinctive in relation to the relevant goods and while the device of a “crown” could represent the shape of certain items of jewellery e.g. broaches, it would be distinctive in relation to a wide range of relevant goods e.g. pearls and pearl necklaces – goods upon which the applicant’s evidence shows the composite mark being used.

26. The visual qualities of the composite mark are such that both the word and device elements are prominent and striking and in my view they impact upon the mark’s totality and how the mark would be seen and perceived by the average customer. I would add that my own knowledge and experience tells me that jewellery items and the like are likely to be selected by the eye rather than by placing orders by word of mouth. While catalogue and telephone orders play a role in this trade, the initial selection is still made by the eye and subsequent order usually placed by reference to a catalogue order.

27. Turning to the aural qualities of the composite mark, it seems to me that “words speak louder than devices” and it is perfectly feasible that the mark would be merely described as a DIANA mark in oral use. I suspect that a good proportion of the public would describe the mark purely by reference to the word DIANA, but it does not follow that the “crown” device would necessarily be omitted from aural descriptions of the mark.

28. On a conceptual basis it seems to me that both the word and device elements would impact upon the customer as both elements have obvious connotations of a female forename and a royal symbol. While I do not consider the totality to bring to mind any definite concept I believe it could remind some people of the late Princess of Wales.

CONCLUSION

29. Taking into account the visual, aural and conceptual impact of the additional “crown” device element to the registered mark and the consequential totality and also taking into account the nature of the goods at issue and how they are normally purchased, on a global appreciation, I believe that the composite mark used by the registered proprietors possesses a different distinctive character from the mark in the form in which it is registered. Furthermore, it seems to me that the applicant’s own Statement of Case must infer this conclusion, in that they submit that it is “the addition of the “crown” or “coronet” device which makes the proprietor’s mark liable to mislead the public”. The applicant does not contend that the word DIANA, in itself, misleads the public.

30. Consequent to my decision that the mark used is in a form differing in elements which alter the distinctive character of the mark in the form in which it is registered, the application for revocation under Section 46(1)(d) of the Act must fail.

ADDITIONAL COMMENTS

31. During the course of these revocation proceedings it has become apparent that the

registered proprietors have used the unregistered composite DIANA and “crown” device trade mark accompanied by an “R” symbol. Section 95 of the Trade Marks Act states:

“95.-(1) It is an offence for a person-

- (a) falsely to represent that a mark is a registered trade mark, or
- (b) to make a false representation as to the goods or services for which a trade mark is registered

knowing or having reason to believe that the representation is false.

(2) For the purposes of this section, the use in the United Kingdom in relation to a trade mark-

- (a) of the word “registered”, or
- (b) of any other word or symbol importing a reference (express or implied) to registration,

shall be deemed to be a representation as to registration under this Act unless it is shown that the reference is to registration elsewhere than in the United Kingdom and that the trade mark is in fact so registered for the goods or services in question.

(3) A person guilty of an offence under this section is liable on summary conviction to a fine not exceeding level 3 on the standard scale.”

32. While the matter is not directly before me in relation to these revocation proceedings, it seems to me that use of the mark in such a manner has resulted in some confusion in relation to these proceedings. However, I note the registered proprietors’ assurance that use of the “R” symbol with the mark has ceased.

COSTS

33. As the application for revocation has been unsuccessful, the registered proprietors are entitled to a contribution towards costs.

34. In their submissions the registered proprietors requested an award of substantial costs against the applicant because the applicant unnecessarily delayed the proceedings by requesting extensions of time without adequate reasons. However, I note that when the Registrar granted the extensions of time, no submissions were received from the registered proprietors. No disagreement or comment on the Registrar’s preliminary views on the extensions were submitted by the registered proprietors at the time when they may have had a practical impact upon the proceedings. In the circumstances, I am not minded to depart from the “normal” scale of costs.

35. I order the applicant to pay the registered proprietors the sum of £850. This sum to be paid within seven days of the end of the period allowed for appeal or, in the event of an unsuccessful appeal, within seven days of the final determination of the matter.

Dated this 28th day of November 2002

**JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General**