

Names, signatures and images of individuals; fictitious character, titles of books, films and songs

Registrability of surnames and personal names

The principles for assessing the distinctive character of marks constituted by surnames have been considered in the European Court of Justice's ("ECJ") judgment in Case C-404/02 *Nichols plc v Registrar of Trade Marks* [2005] R.P.C. 12.

In *Nichols*, the ECJ confirmed that the assessment of the distinctive character of a trade mark constituted by a surname, even a common one, must be carried out specifically, in accordance with the criteria applicable to any sign, in relation, first, to the products or services in respect of which registration is applied for and, second to the perception of the relevant consumers. The criteria for assessment of the distinctive character of trade marks constituted by a personal name are the same as those applicable to other categories of trade marks.

Stricter general criteria of assessment based on:

- a predetermined number of persons with the same name, above which that name may be regarded as devoid of distinctive character,
- the number of undertakings providing products or services of the type covered by the application for registration, or
- the prevalence or otherwise of the use of surnames in the relevant trade

cannot be applied to surname marks as a rule-of-thumb.

Registration of a trade mark constituted by a surname cannot be refused for the purpose of ensuring that no advantage is afforded to the first applicant for registration.

All relevant facts and circumstances should be taken into account. It is proper to take into account any and all characteristics of the sign in question which bear upon its distinctiveness according to the perception of the average consumer of the goods and services in question (*Oska's Ltd's Trade Mark Application* [2005] R.P.C. 20).

The average consumer does not necessarily perceive surnames in the same way as other categories of signs and this may make it more difficult to establish that they are distinctive. Individuals generally acquire surnames at birth, and they form an important part of an individual's identity. It is inherent in the nature of surnames that they are shared with a greater or lesser number of other individuals. Those other individuals may also supply the relevant goods or services or desire to do so.

The commonness of a surname is a factor that may be taken into account as part of a specific assessment of the distinctive character of the surname in relation to the goods or services in question, particularly where the field in question is one where the use of surnames to designate origin is prevalent.

Examination of trade marks consisting of surnames

In view of the above decisions, the Registrar will not predetermine the number of persons with the same name above which that name would be regarded as devoid of distinctive character. A surname, whether it is common or not, must be specifically assessed for distinctive character in accordance with the same criteria applicable to all categories of marks.

The commonness of a surname is a factor that may be taken into account as part of the specific assessment of the distinctive character of a particular surname in respect of the goods and services applied for. The Registrar will take into account all relevant circumstances, including the commonness of using surnames in the relevant trade, the

number of traders in that trade, and the extent of the use of a particular surname in that trade, as part of the specific assessment of the distinctiveness of the relevant mark in respect of the goods and services applied for.

Although the Registrar will not generally have any specific information as to the extent of the use of a particular surname in the relevant trade, facts which are generally known may be taken into consideration. The reason is that the extent to which a surname is used in that trade is likely to have an impact on the perception of the relevant consumers, and hence on the distinctiveness of the particular surname in respect of the goods and services in question.

For example, it is common for suppliers of food and drinks to operate under their surnames in Hong Kong. On this basis, the Registrar may properly conclude that a mark that consists of a surname being used by a large number of undertakings in the provision of food and drinks services would be devoid of distinctive character.

A surname which is objectionable under section 11(1)(b) may still be acceptable for registration if it has in fact acquired distinctive character as a result of the use made of it (section 11(2)). To show acquired distinctive character, the applicant must file evidence of use of the mark.

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For example, the application for registration of the sign 陳博士 for goods in Classes 3 and 5 was accepted on the basis of distinctiveness acquired through use.

Surnames in simplified Chinese characters are treated in the same way as surnames in traditional Chinese characters.

Surnames with other meanings

A word that is a common surname may, apart from being a surname, have another meaning and that meaning may face an objection to registration under sections

11(1)(b) to (d) of the Ordinance. For example the word "BROWN" and the Chinese character "黃" if applied to 'paints' may face an objection under sections 11(1)(b) and (c) of the Ordinance because it designates a characteristics (colour) of the goods.

Personal names and forenames

Full personal names (combining a forename or given name and a surname) on the whole have more capacity to distinguish than surnames. **李萬山** for goods in Class 5, and CARMEN HO for goods in Classes 14, 18 and 25 have been accepted. Forenames may be devoid of distinctive character in relation to, for example, those goods where use of forenames as decoration is common, e.g. key chains, mugs.

Names and images of famous people

Applications to register the name or image of a famous person or well-known organisation can be made by that person or organisation, or with their consent in writing. If it is not made by that person or organisation, or is not made with their written consent, we must refuse the application on grounds of bad faith (section 11(5)(b)).

In an application to register the name or image of someone who has died recently, consent must be given by the personal representatives (executors or administrators) or by the successor to the business.

Apart from the authority to apply, the name or image of a famous person must be "capable of distinguishing", that is, it must be capable of functioning as a badge of trade origin. The test is whether the name or image is likely to be taken as an indication that the goods or services have come from a particular source, or if the use of the name in relation to the goods or services will merely be seen as a commemoration of that famous person or as an indication that they are *about* that person.

See *Elvis Presley Trade Marks* [1999] RPC 567, where the marks ELVIS and ELVIS PRESLEY were refused, as members of the public purchased Elvis Presley merchandise not because it came from a particular source, but because it carried the name or image of Elvis Presley.

If a well known person's name is likely to result in a demand for memorabilia, the general public are unlikely to see that name as anything other than an indication of the content or character of goods, rather than as an indication of trade origin.

If the name of an artist or a group of artists affixed to compact discs and displayed on packaging merely indicates the name of the performer whose performance is recorded on the compact disc, and if this use of the name is not likely to be understood as indicating the trade source of the goods, then such use would be descriptive only. By identifying the performer it would be descriptive of the contents of the disc and nothing more. Whether particular labeling and packaging satisfy this test is a question of fact in each case.

Furthermore, a mark may by becoming distinctive for one class of goods or services (e.g. musical performances) become descriptive for another class of goods or services (e.g. posters, mugs and compact discs).

Applicants have to file evidence to show that the name or image of the famous person has a connection with the applicant, as it is wrong to assume that only a celebrity, or his successor, would ever market his own character (see *Elvis Presley, supra*).

Other factors that affect the question of whether a famous person's name or image indicates trade origin include the following (although not all these factors will be relevant in every case):

- the nature and extent of the individual's reputation;

- whether any trade in souvenirs has developed, and the reasons for this;
- whether the famous person or individual has established any trade mark rights during his or her lifetime;
- whether descendants or trustees have established any rights and the nature of those rights;
- the extent to which demand for commercial consumer items is generated by the media or the public interest; and
- the nature of the goods in respect of which registration was sought.

(See *Jane Austen Trade Mark* [2000] RPC 879 at 886). Applying these considerations in relation to JANE AUSTEN, the mark was found to be incapable of serving as a badge of origin, in respect of a line of toiletry items.

To take another example, an application for the name ALEXANDER GRAHAM BELL in respect of “charitable collections, financial grant services, charitable fund raising services for the preservation and rehabilitation of sites, artefacts, and papers reflecting the scientific and historical heritage of Alexander Graham Bell” would, in the absence of evidence of distinctiveness, merely be taken as an indication of the nature of the services to be provided under the mark. Because of the historic reputation of the inventor, the use of his name would be seen as descriptive of activities promoting his work and his scientific and historical significance, not as indication of the trade origin of the services.

It is important to make the distinction between names of persons and names of organisations associated with certain goods or services. DIANA, PRINCESS OF WALES was refused registration in the United Kingdom but PRINCESS DIANA

MEMORIAL FUND was accepted. The latter mark presents itself as the name of an undertaking responsible for the particular charitable fund raising services named in the specification. It is source-specific and indicates a trade connection rather than a characteristic of the goods (see *Diana, Princess of Wales Trade Mark* [2002] ETMR 254 and *Diana, Princess of Wales Memorial Fund Trade Mark* (UK Registry, 25 January 2002)).

Famous person actually trading

On the other hand, if the person actually trades in the goods or services of the application, the mark is likely to be able to indicate trade origin (see *STELLA McCARTNEY* registered in class 25 in the Hong Kong SAR).

Fictitious character, titles of books, films and songs

Characters of fiction, titles of books, films and songs may be registrable as trade marks where the name or title is likely perceived by the relevant consumers to be an indicator of origin of the goods or services specified. Regard should be had to the primary connotation of the mark as at the date of the application.

Where the primary connotation of a mark is that of the name/title of a character/story/film/song, but the name/title has passed into the currency of the language or entered into the public domain, an objection under section 11(1)(b), (c) or (d) may be raised as appropriate. This may include in particular, a case where the name/title is long-established, so that it is likely to be viewed by consumers as a description of the content or subject matter of the goods and/or services claimed, or where that name/title has become customary in the language of the trade.

“Subject matter” objections are generally more relevant in relation to applications in Classes 9, 16 and 41 for registration of marks consisting of characters of fiction, titles of books, films or songs. However, such objections should not be routinely raised. The fundamental question is whether the mark is likely to be taken as an indicator of origin.

Examiners may conduct dictionary or Internet searches to support the objection that the mark is used for descriptive purposes or has already fallen into the public domain. For example, the Chinese characters “孫子兵法” if applied to “printed matter”, or the words “SHERLOCK HOLMES” or the Chinese characters “白蛇傳” if applied to “films; videos; organization of plays and shows”, or the title “Beethoven’s 5th Symphony” if applied to “cassette tapes, CDs, videos; organization of concerts”, may face objections under section 11(1)(b) and (c) because they simply designate the characteristics (subject matter) of the goods or services and are devoid of distinctive character.

In some cases, grounds for objection may also exist based on the ordinary literal meaning of the words in the title. For example, “Science and Technology” would likely be viewed as a description of the subject matter of a publication relating to science and technology, rather than as an indicator of trade origin. Therefore objection under section 11(1)(b) and (c) may be raised.

The fact that the applicant owns copyright in the name of a character, or in the title or contents of a book, film or song, or that the applicant has the exclusive right to produce or reproduce the relevant work is not conclusive. In terms of registrability, the main enquiry remains whether the mark could serve the function of indicating trade origin.

Signatures

An application to register a person’s signature can be made by that person, or with his consent, in writing, permitting the applicant to make the application (see *Names and images of famous people* above). If it is not made by that person, or with his consent in writing, or if authenticity of the signature is an issue, we must refuse the application on grounds of bad faith.

Signatures are generally considered distinctive and are registrable *prima facie* (*Elvis Presley, supra*) as long as there are no difficulties with regard to consent or

authenticity. For example,  has been accepted for goods and services in Classes 16, 18, 25 and 42. The same considerations apply for signatures in Chinese characters.

However, a name in perfect script that is indistinguishable from an ordinary typeface is not a signature. It is treated in the same way as surnames and personal names (see above).

For questions regarding a signature mark conflicting with an earlier mark, see *Elvis Presley* at 595, where the signature “Elvis A Presley” and the mark “Elvisly Yours” shared a cursive script and were considered confusingly similar. In relation to the similarity of marks, the similarity of goods or services, and the distinctiveness of marks and their likelihood for confusion, see chapter on Relative grounds for refusal.

Because signatures qualify for trade mark registration in view of their unique representation, a disclaimer of exclusive rights for the name in plain form is not necessary.

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