

NAMES AND REPRESENTATIONS OF FAMOUS PEOPLE, BUILDINGS, ETC

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NAMES AND REPRESENTATIONS OF FAMOUS PEOPLE, BUILDINGS, ETC

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1 INTRODUCTION

This chapter is concerned with marks which contain or consists of the name or representation of a famous person, building or fictional character or story.

2 RELEVANT LEGISLATION

The Trade Marks Act (Cap. 332, 2005 Rev. Ed.)

Absolute grounds for refusal of registration

7. —(1) The following shall not be registered:

...

(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;

...

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

...

The Trade Marks Rules

Persons living or recently dead

14. —(1) Where the name or representation of any person appears on a trade mark which is the subject of an application for registration, the Registrar may, before proceeding to register the mark, require the applicant to furnish the Registrar with the consent of the person or, in the case of a person recently dead, of his legal representatives.

(2) Where the consent referred to in paragraph (1) is not furnished within the time specified by the Registrar and the applicant fails to satisfy the Registrar that it is impossible or impracticable in the circumstances of the case to obtain the consent, the Registrar shall refuse to register the mark.

3 NAMES AND REPRESENTATIONS OF FAMOUS PEOPLE

A mark contains or consists of the name of a famous person even if it is not the person's full name. It may be the surname, given name or even the nickname.

Two issues will have to be looked at when a trade mark which contains or consists of the name or representation of a famous person is sought for registration. Firstly, whether the name or representation is capable of functioning as a badge of origin and secondly, whether authorization, if required, has been obtained to use that name or image of the famous person.

(a) Can it function as a badge of origin?

(i) Name or representation of a famous person

The question here is whether the name or representation is likely to be taken as an indication that the goods or services originate from a single source or whether it will be seen as a description of the subject matter of the goods or services or some other non-origin specific purpose. For example, a representation of a famous person found on goods is likely to be viewed as mere decoration in relation to the goods involved and if so, an objection under Section 7(1)(b) will arise.

This is assessed by looking at the goods/services applied for and the perceptions of the consumers of such goods (who are assumed to be reasonably well informed, observant and circumspect). If the average consumer would not expect all goods or services claimed in the application bearing the famous name or representation to be marketed under the control of a single undertaking, an objection under section 7(1)(b) and/or (c) will arise.

For example, the name of a famous performer for soaps and toiletries in class 3 would be devoid of distinctive character as the name would serve to act as a reminder of the performer and not as an indication of any specific trade source.

Whether or not a name is distinctive is to be judged at the date of application. If at that date the name was so well known that the name possessed very little inherent distinctiveness, the name is not registrable. The name and representation would also not be registrable if the products were bought by many because they carried the names and likeness of the performer and not because they came from a particular source. The public do not assume in all cases that products bearing the name or likeness of a famous personality would come from a particular source, (eg. from the personality himself or from his beneficiaries).

Further, if the fame of the famous person is not due to the production of the goods or offering of the services concerned, there will be no reason why the public would perceive a trade connection between that name and the goods/services. As such the

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name will not connote to anyone a connection between applicant and the goods/services so as to distinguish their goods/services from that of other traders.

If a well known individual's name is likely to result in a demand for memorabilia or commercial consumer items then the general public is unlikely to see that name as anything other than an indication of the content or character of goods. 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 any way, such as:-

- the nature and extent of the person's reputation;
- whether there are any surrounding reasons why trade in souvenirs etc. may have developed, for instance, because of the person's strong association with an area, or a particular style;
- whether, in the case of contemporary figures, the person established any trade mark rights during his or her lifetime;
- whether any existing trade in souvenirs, memorabilia etc. exists or in the case of some one recently deceased, can be expected to arise;
- 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 whether to the exclusion of others);
- the extent to which the life and works of the person are kept alive either by public interest media coverage etc in such a way as to generate demand for consumer items; and
- the nature of the goods themselves in respect of which registration is sought.

The above is not an exhaustive list and it would be equally true to say that not all the factors would be relevant in every case.

In DIANA, PRINCESS OF WALES Trade Mark [2001] E.T.M.R. 25, the Estate of the late Diana, Princess of Wales applied to register DIANA, PRINCESS OF WALES in classes 3, 4, 9, 12, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 30, 31, 36, 41 and 42. The applications were refused for being devoid of distinctive character. Any use had been descriptive only and had not been use as a trade mark. The Hearing Officer said,

“Personal names do not usually allude to non-origin attributes of the goods and services. Indeed, most personal names are readily taken as denoting the trade source of the goods, e.g. ‘Laura Ashley’, ‘Harry Ramsden’ and ‘Dorothy Perkins’. However, where a famous name is concerned (other than names which are famous as indicators of trade source, as in these examples) there is the possibility that the name will serve to signify not the trade source of the goods/services but merely the subject matter. The Elvis case is an example of this.”

The essential function of a trade mark is to guarantee that the items bearing it had originated under the control of a single undertaking responsible for their quality. Unless, therefore, such control can be shown, the use of a famous name to endorse a product is not a trade mark use. The average consumer would not have expected all commemorative items bearing Diana's name to be marketed under the control of a single undertaking. Diana's name was not used for commercial purposes by her during her life. Although her name was often used, none of this use of her name indicated any trade connection between the source of any goods and services and the Princess. The reasonably well informed and observant average consumer would be aware that there was a long history of use on mementoes featuring the royal family which had no significance as to trade source. It seemed most unlikely that the average consumer would have attached such trade mark significance to the name as at the date of the application when they had not done so when she was alive.

The name of a well known rock band is also not registrable for “posters and poster books” in Class 16 as it would be exclusively descriptive of such goods and would be precluded from registration by section 7(1)(c). This would be so even if the mark was originally an invented word coined by the group. The relevant date for assessing the meaning of the mark was at the date of application and not the date when the mark was coined. The fact that the mark was already well known to be the name of the Group by the application date meant that the mark was no longer meaningless. Further, the fact that the term is not a dictionary term is not relevant to the issue as cases such as DOUBLEMINT and POSTKANTOOR has shown that this is not a prerequisite of section 7(1)(c).

(ii) Signature of a famous person

The ECJ said in the *Baby Dry* case that a trade mark “*presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics*” is registrable. Hence a signature mark that is presented in a form which visually distinguishes the mark from the usual means of designating the goods or services in question is generally more distinctive than the name in ordinary typeface.

(b) Consent to registration of the name/representation/signature of the famous person necessary?

An application to register the name/representation/signature of a famous person or a recently deceased famous person may face an objection under section 7(6) which provides that, a trade mark shall not be registered if or to the extent that the application is made in bad faith. Whether a bad faith objection is triggered depends on whether the application covers goods/services with which the famous person is associated. For example, an application to register the name of a famous footballer for “footballs” would be objectionable because it is likely to indicate either the patronage of the footballer, or that he/she is involved in the production of the goods and thereby take advantage of the footballer's reputation. Conversely, an application to register

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the famous footballer's name for "photocopiers" would not be an issue at examination stage. However, the application may still be opposed.

Bad faith objections can be overcome if the applicant obtains the written consent of the individual or his/her legal representative to the registration of the mark.

Under rule 14 of the Trade Marks Rules, the Registrar may, before proceeding to register a mark in which the name or representation of any person appears, require the applicant to furnish the Registrar with the consent of the person. Thus, the Registrar has full discretion to require the consent of the person whose name or representation appears on the mark and this discretion will be exercised in appropriate circumstances, especially in the case of the name (including a signature) or representation of a famous person. Where consent is required by the Registrar, it is not sufficient to provide consent to the use of the mark. The applicant must furnish the person's consent to the registration of the mark for the specified goods or services.

4 NAMES AND REPRESENTATIONS OF WELL KNOWN BUILDINGS

An objection under section 7(1)(b) and/or (c) will apply where:

- (i) the name or representation of the well known building is likely to generate demand for memorabilia such as a representation of the Esplanade on magnets, is likely to be seen by consumers as an indication of the content/character of the goods rather than signifying trade origin.
- (ii) the building concerned has an association with the goods, either because it is well known for the goods or services or it is a likely source of location of the goods or services.

Objections under Section 7(6) may also arise if the applicant is not the owner or developer of the building. This objection will be waived if consent from the owner or developer of the building is obtained.

5 NAMES AND REPRESENTATIONS OF WELL KNOWN FICTIONAL CHARACTERS/STORIES

If the name or representation is likely to be regarded as a sign indicating the origin of goods/services, the name or representation may be accepted on a prima facie basis.

However, if the name in question is well known, it is possible that it will only be viewed as the name of the character in the story concerned and not as an indication of trade source. In such cases, the mark may be seen as serving some other function, for example, designating that the goods feature the story/character concerned and will thus face Section 7(1)(b) and (c) objections. For example, the name "CINDERELLA" on goods such as dolls may be seen to serve the sole purpose of designating a characteristic of the goods and not as a badge of origin. Thus, it will be open to Section 7(1)(b) and (c) objections.

An objection under Section 7(1)(d) will also arise if the name has become commonly used by other traders in the trade.

In order to decide whether the name has become “well known”, the critical date to look at is the date of the application. If at the date of application the name is not well known, the applicants’ own success at promoting the name after the date of application should not jeopardise the application. Conversely, if the name is already well known at the date of the application, promotional activities after the date of application by the applicant will not benefit the applicant even if it has brought about a certain level of association with the applicant.