

# SCRIPT-ed

*Volume 1, Issue 2, June 2004*

## **Celebrity and Trade Marks: the next instalment**

*Gillian Davies\**

### **Abstract**

*In response to the increasing use of registered trade marks by celebrities to protect their names from exploitation, the UK Trade Marks Registry has recently issued guidance on registration of "famous names". This article seeks to examine the implications of the guidance in light of the existing legislative framework for registration of a personal name and recent judicial developments, together with examples of some famous names that have been granted registered protection.*

DOI: 10.2966/scrip.010204.230

© Gillian Davies 2004. This work is licensed through [SCRIPT-ed Open Licence \(SOL\)](#).

---

\* Teaching Assistant, Private Law; University of Glasgow

## 1. Introduction

Which of the following is the odd one out: Jamie Oliver, Tecwen Whittock (of Who Wants to be a Millionaire infamy), Van Morrison or Mikhail Gorbachev? Anyone watching “Have I Got News for You” on Friday 16 April will be familiar with the answer, for this was one of the questions posed to contestants that evening. The correct answer is Mikhail Gorbachev, and not for any political reasons. While Messrs Oliver, Whittock and Morrison have all applied for, or registered, trade marks in their name, the former President of Russia has apparently applied to register his distinctive birthmark as a trade mark instead. Fascinating as this may be as a piece of celebrity trivia, it also serves to highlight the increasing use of trade mark registration by those keen to safeguard their personal name against unwanted use or attention. In fact, such is the trend for registration of names by “famous people” that the Trade Marks Registry at the UK Patent Office has recently issued a Practice Amendment Notice (the “Notice”) governing “Names of Famous People (living and deceased) and Groups”.<sup>1</sup> The purpose of this article is to examine this guidance and the implications that it has for celebrities intent on preserving their number one brand: themselves. I shall start by examining the definition of a trade mark under existing legislation and the criteria for registration, before going on to consider marks applied for, or registered, by a selection of “famous people” and the intended uses of these marks. The article concludes with a consideration of the scope of the recent Notice and the implications this has for celebrities and their names.

## 2. What is a trade mark?

### 2.1 Trade Marks Act 1994

The Trade Marks Act 1994, which is the current UK legislation, states quite clearly that a trade mark is “any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A trade mark may, in particular, consist of words (including personal names)...”<sup>2</sup> There is therefore no doubt that, *prima facie*, anyone in the UK can apply to register a name as a trade mark.<sup>3</sup> Applicants seeking to register their name must also meet the essential criteria for trade mark registration, as set down in sections 3, 5 and 7 of the Act: no special treatment is afforded to such marks. I shall examine each of these to determine their impact upon registration of a personal name.

---

<sup>1</sup> Practice Amendment Notice 5/04

<sup>2</sup> Section 1(1) of the Trade Marks Act 1994. All future references are to this Act, unless otherwise specified.

<sup>3</sup> This article is concerned with the UK Act, which is territorial. Thus, although a registration of a name in the UK would prevent others from registering that name in the UK, it is still possible to use the name elsewhere in the world. Some of the celebrities discussed later also have Community Trade Marks to increase the scope of their registered protection.

## 2.2 Section 3

Any name which is devoid of any distinctive character shall not be registered, as it would fail to satisfy the requirements of section 3(1)(b). Applications will be reviewed on a case-by-case basis, but either forenames or surnames alone are more likely to lack distinctiveness. Accordingly, an application to register “Brown” or “Brown’s” may lack the distinctiveness required by section 3(1). Chapter 6 of the Trade Marks Registry’s Work Manual suggests at section 3.12 that a surname is likely to be regarded as common (and presumably insufficiently distinctive) if there are more than 100 entries for that surname in the London Telephone Directory.<sup>4</sup> This guidance then goes on to consider applications for full names, that is a forename and surname, such as “Mary Smith”. While this particular example is an extremely common name and is therefore likely to be refused as a trade mark, the guidance states that “full names have, by their nature, a greater capacity to distinguish the goods/services of one undertaking than a surname per se.”<sup>5</sup> It therefore seems that, in the majority of cases, an application to register a full personal name will satisfy the criteria for registration: only where the full name is exceptionally common would it be refused. In addition, names that are common elsewhere in the world may be taken to be sufficiently distinctive in the UK to allow registration here.<sup>6</sup>

As well as considering the distinctiveness of the name in itself, the Trade Marks Registry has indicated that it will also consider the number of traders operating in the relevant market when looking at this issue.<sup>7</sup> This means that traders in more heavily populated markets, such as clothing, will require a more distinctive name before it will be considered acceptable for registration under section 3(1)(b). In the case of so-called “famous people” however, I would suggest that this stipulation is misleading. The music, film and sporting industries could all be described as heavily populated, yet the very fact that someone is famous for their music, on-screen or sporting achievements means that their name is well known and that the sort of confusion which might result in other trading circles is therefore less likely to apply. Michael Jackson is an excellent case in point: despite having a particularly common name<sup>8</sup> no-one ever asks which Michael Jackson is being referred to when the name arises in the news or in conversation. His fame is such that, despite operating in the heavily populated music industry, his name is sufficiently well known to identify him and is therefore capable of distinguishing him from other musicians. This is particularly the case with actors and singers, who register their professional name with Equity so that no two Equity members can have the same professional name. Accordingly, there can only ever be one Catherine Zeta-Jones in the field of acting in the UK.<sup>9</sup> In some cases,

---

<sup>4</sup> Chapter 6 of the Trade Marks Registry’s Work Manual, section 3.12.1, p54

<sup>5</sup> *Ibid.*

<sup>6</sup> In particular, see *EI DuPont de Nemours v ST Dupont* [2003] EWCA 1368 (decided under the Trade Marks Act 1938)

<sup>7</sup> Chapter 6 of the Trade Marks Registry’s Work Manual, section 3.12.8, p61

<sup>8</sup> There are two Michael Jacksons and 16 unspecified M. Jacksons in the Edinburgh telephone directory alone.

<sup>9</sup> Interestingly, although the same system is in operation in the US, there is no cross-check between Equity and American Equity. This means that it is possible for two actors to share the same name on different sides of the Atlantic. Apparently there was an Errol Flynn in Grimsby for a time.

singers even drop their surname and find that their forename offers adequate marketing potential on its own: Kylie and Madonna being two examples in this category. As a result of this fame, it would seem unnecessary to consider the size of the market in which the famous person operates: the very fact of their celebrity is usually sufficient to prove distinctiveness in that field.

The next hurdle for an applicant to overcome is bad faith: section 3(6) excludes any application to register a name, made in bad faith. An example in this context would be an application to register “Robbie Williams” made by someone with an entirely different name and completely unconnected with anyone called Robbie Williams. This can be contrasted with an application by someone genuinely called Robbie Williams and trading under that name, which is unlikely to fall foul of the bad faith test. This section will apply whether or not there is a pre-existing registration of the name in question. Section 3(6) therefore reduces the chance of the real-world equivalent of cyber-squatting, whereby Joe Public applies to register the name of someone famous, either for his own use or with the intention of selling it on to the holder of the name at an inflated price.

### 2.3 Section 5

Even where the provisions of section 3 are met, applicants seeking to secure their name as a registered trade mark must also overcome the relative grounds for refusal of registration set down in section 5 of the Act. Section 5(1) entitles the Trade Marks Registry to refuse an application if the mark is identical with an existing trade mark and is to be used for identical services. Thus, if George Michael had chosen to register his name in, for example, use class 41 in relation to music and entertainment services<sup>10</sup>, this would preclude any other George Michaels (or indeed any third party) from seeking registered protection of that name in relation to such services.

Section 5 also prevents registration of a mark either because (a) it is identical with an earlier mark and is to be registered for similar goods or services as that earlier mark or (b) it is similar to an earlier mark and is to be registered for goods or services identical with or similar to that earlier mark. In both cases an additional element of “a likelihood of confusion on the part of the public” must also be present. To continue the George Michael example, this would prevent other George Michaels from registering their name in relation to any similar services, such as entertainment services involving singing and dancing. George Michel, Greg Michael and Georgina Michael would likewise possibly be prevented from registering their names in relation to entertainment or indeed “similar services”. Whether or not the gender of the applicant would affect the similarity or otherwise of the two names is not considered by Registry guidance, but it may be that a Georgina Michael would have less difficulty registering her name than male applicants with similar names. Notwithstanding this possibility, this section still gives George Michael, and every other applicant, the comfort of knowing that he or she can prevent a wide range of registrations. It would, however, still allow a George Michael in an entirely unrelated sector to register his name for those unrelated goods or services.

On rare occasions, however, it may be decided that an existing registered mark is so well known that no other registration of that mark, for any goods or services

---

<sup>10</sup> As at 30 April, he has not.

whatsoever, should be permitted. This can be seen in the case of *Lego Systems A/S v Lego M Lemelstrich*<sup>11</sup> where an action of passing off (rather than trade mark infringement) was raised by the Danish manufacturer of Lego toy bricks against the manufacturer of agricultural sprinklers, being sold under the name Lego. The action was successful and the presiding judge held that the goodwill and reputation attaching to the name “Lego” was so strong that it extended beyond the primary trading field of toy bricks into all fields of trading activity. However, this result is unusual and only likely to be of relevance to the largest brands in their field. In addition, it is not entirely in point with the current article concerning the use of proper names as trade marks, as the name in question was not a personal name.<sup>12</sup> Although this case illustrates the power of good branding, it is suggested that its implications are more limited in cases where both the existing owner and the new applicant share the same name.

## 2.4 Section 7

One of the most contentious issues with permitting individuals to register their personal name is that, unless you are one of Bob Geldof’s daughters (named Fifi Trixibelle, Peaches and Pixie), there is likely to be at least one other person in the UK sharing your name and therefore legitimately entitled to use it. Will this innocent individual therefore infringe the registered trade mark every time they use their name? The Act includes a number of provisions to deal with this eventuality.

Section 7 permits the registration of a mark, which would otherwise be refused under the relative grounds of section 5, where the new applicant can show that there is “honest concurrent use” of his mark and the pre-existing registration. In defining “honest concurrent use” the Act refers back to the relevant section of the 1938 Trade Marks Act. Honest concurrent use would arise where a trade mark has been legitimately used over a period of time by two unconnected parties and where both have developed goodwill and reputation in their use of the mark. Although this situation is harder to envisage in today’s global village, where online trading is the norm, it arguably had greater use at the time of the 1938 Act, when it was quite possible for a retailer in Aberdeen and one in Manchester to use the same name without any confusion on the part of the public, given the distance between them. However, section 7 of the 1994 Act re-affirms the applicability of this exception to the relative grounds of refusal and it is therefore possible that an applicant seeking to register his personal name, which he uses in trade, could succeed in his application, despite the existence of a pre-existing mark. It should be noted that this section is at odds with the requirements of EC Directive 89/104 (to approximate the laws of member states relating to trade marks) by allowing registration of a mark that would otherwise fail the criteria for registration under section 5. This creates the possibility that two similar marks could be registered under the doctrine of honest concurrent use, despite the potential for public confusion. Holyoak and Torremans suggest that any proprietor of an earlier mark adversely affected by the application of this section would be within his rights to “jump on the first plane to Luxembourg and require that the European Court of Justice strike out section 7 of the 1994 Act as being wholly

---

<sup>11</sup> [1983] FSR 155

<sup>12</sup> The name in fact comes from the Danish to “play well”, according to the company website.

incompatible with the Directive.”<sup>13</sup> Until that day, however, section 7 continues to exist in the field of UK trade mark law.

## 2.5 Defences to infringement: sections 10 and 11

While section 7 provides for an application to register the same name, a more likely scenario is that a third party will simply use their own name from day to day, without considering whether they are infringing a registered trade mark. To provide for this situation, and to ensure that all Robbie Williams’s in the UK are not in breach of the singer’s trade mark every time they sign their name, section 11(2)(a) states that “A registered trade mark is not infringed by the use by a person of his own name.”

In addition to these two sections of the Act, further relief is afforded to those sharing a name with a famous person by way of section 10. This section defines infringement of a registered mark and states that “a person infringes a registered trade mark if he uses *in the course of trade* a sign...”<sup>14</sup> Individuals using their own name on a daily basis are unlikely to be using it in the course of trade, thereby escaping the reach of this section. For those that do use their name in the course of trade, however, the protection of this section will not apply.

## 2.6 Conclusion

It can be seen from this examination of certain sections of the Act that provisions are in place to allow people (famous or not) to apply for a trade mark in their own name, but that this protection is, in some circumstances, more limited than the protection granted to a business or invented name, simply because there will be other people in the country legitimately entitled to use that name.

## 3. *Celebrity Marks*

Being no different from other providers of goods or services to the public, and clearly having excellent legal advice, celebrities in the UK have proved more than happy to follow the requirements of sections 1, 3, and 5 of the Act and register their names as trade marks. In this section, I shall examine some of these marks and, in particular, the use classes for which each mark has been registered. The celebrity trade marks discussed here are a random sample taken from a search of the online register maintained by the Trade Marks Registry,<sup>15</sup> illustrating a range of approaches to registration. (Unfortunately the marks chosen do not include the Community Trade Mark registration made by Britney Spears for inflatable furniture.<sup>16</sup>)

---

<sup>13</sup> Holyoak & Torremans, *Intellectual Property Law*, 3<sup>rd</sup> edn, (2001) p393

<sup>14</sup> Emphasis added. This wording is used in section 10(1) which deals with direct infringement and section 10(2) which deals with infringement where either the infringing trade mark or the goods and services are similar, but not identical, to the registered mark.

<sup>15</sup> at [www.patent.gov.uk](http://www.patent.gov.uk)

<sup>16</sup> CTM 1610021

The first example is Catherine Zeta-Jones, who registered her full name in 2002.<sup>17</sup> Her chosen use class was 41 and the specification of services covered was simply “Entertainment services”, which would seem to be a fair assessment of her career to date. This moderation is impressive when compared with the 1998 registration made by Robbie Williams,<sup>18</sup> which covers four different use classes: 9, 16, 25, 41. These four classes encompass video and sound recordings and films; printed matter, books, calendars and posters; articles of clothing; and entertainment services. His specification for each class, however, is considerably wordier than Mrs Douglas’s, often running to seven or more lines and including some curious goods. While the books and advertising materials that are detailed in relation to class 16 cannot be questioned, the inclusion of artists’ materials and paint brushes in this class is slightly harder to fathom. There is therefore a risk that these goods could be challenged on the grounds of five years’ non-use for these items, under section 46(1) of the Act.

One of the four celebrities mentioned in the “Have I Got News For You”<sup>19</sup> broadcast was Jamie Oliver. His application, made in 2000,<sup>20</sup> secured his name in nine different use classes, while a further application in 2002<sup>21</sup> added an additional two classes to his portfolio. In brief, Jamie Oliver’s registrations cover kitchen goods and utensils; ovens and microwave ovens; certain foodstuffs; recipe books; calendars; accommodation services; DVDs and videos; and the ubiquitous entertainment services. This unusual mix clearly reflects Jamie’s crossover role, from chef to celebrity, and the wider range of goods and services he provides to his public.

The final registration to be considered is that made by David Beckham, whose name and brand is arguably the most valuable in sporting circles. Given his European presence, Mr Beckham opted for a Community Trade Mark rather than a UK one and filed an application to register his name with the Office for Harmonisation in the Internal Market (OHIM) in 2000.<sup>22</sup> The application covers eight use classes,<sup>23</sup> which are all for goods rather than services, and includes perfumes and toiletries; keyrings; DVDs and computer accessories; watches; posters and calendars; clothing (including football kit); and games.

What can be seen from the majority of these applications, leaving aside Catherine Zeta-Jones’ modest (but all-encompassing) registration for entertainment services, is that celebrities use trade mark protection to cover not only the primary goods or services for which they are famous, but also ancillary products designed to provide publicity material and merchandise to fans. There is no doubt that Robbie Williams’s career in music would legitimately require his name to be registered for entertainment services as well as music CDs and DVDs. Jamie Oliver can also justifiably claim entertainment services as a result of his television series, in addition to kitchen utensils and accessories which he now markets. David Beckham, who primarily

---

<sup>17</sup> TM No. 2301083

<sup>18</sup> TM No. 2170088

<sup>19</sup> Which has two trade marks of its own

<sup>20</sup> TM No. 2236072 covers classes 8, 11, 16, 21, 29, 30, 32, 33 and 43

<sup>21</sup> TM No. 2297754 adds classes 9 and 41

<sup>22</sup> CTM No. 1796721

<sup>23</sup> Use classes 3, 6, 9, 14, 16, 18, 25 and 28

provides sporting and entertainment services to the public by way of his football career, has not registered his name in relation to these services, but his registration includes DVDs and videos as well as articles of sporting goods and clothing, which could arguably all relate to and stem from his career as a footballer at international level. However, all three of these chosen celebrities have also elected to register their names in relation to what could be termed ancillary services, such as posters or calendars. A poster with a picture of Robbie, Jamie or David on it will usually also include their name, but such a poster produced without their consent will now infringe their registered trade marks.<sup>24</sup> This would be the case despite the fact that none of these celebrities trade in posters as their primary function, nor do they derive their fame from any business activity in the poster industry. Instead, they are using their fame, generated by their activities in entirely unrelated fields, to protect their reputation and prevent unauthorised poster manufacturers from using their names to describe the product in question. In addition, their own use of the name on such products is unlikely to constitute use in a trade mark sense, i.e. it is not being used to distinguish the goods supplied by the celebrity from goods supplied by other traders in that field.

#### **4. Trade Marks Registry Practice Amendment Notice**

It is to tackle exactly this problem of expansive registrations in the case of personal names that the Trade Marks Registry has issued Practice Amendment Notice 5/04. Allowing celebrities to control the use of their names beyond their primary field of operation would effectively give them far greater control, backed up by law, than is allowed to others who register their business name as a trade mark for typical commercial activity. It would also potentially have the effect of stifling competition, as traders who are used to providing unofficial merchandise could find themselves on the receiving end of a writ for trade mark infringement.

The Notice recognises that, in many cases, the famous name attached to any product will indicate to consumers that the product is “*about* the person whose name it is rather than as an indication that the goods/services are supplied by, or under the control of, one undertaking.”<sup>25</sup> In this situation, any use of the celebrity’s name in relation to the product will not be taken as an indication of the origin or quality of the goods, the purposes usually performed by trade marks, but as descriptive of the subject matter of the goods. Where the use is purely descriptive it will of course fall within the absolute grounds for refusal set down in section 3(1)(c) of the Act.

The Registry note goes on to distinguish between the type of goods that a celebrity could reasonably require to provide with his or her name on, such as films or music videos, and for which applications will still be accepted, and those goods which are “mere image carriers”, for example, posters, calendars, photographs and figurines of the famous person. Use of the famous name in relation to this latter type of product will be regarded as descriptive of the goods, rather than an indication of authenticity. Consumers are more likely to regard a poster of Robbie Williams, which also bears

---

<sup>24</sup> And in light of the decision in *The Football Association Premier League Ltd and Others v Panini UK Limited* ([2003] ECWA Civ 995), a poster of David Beckham in a Manchester United, England or Real Madrid strip could also breach any copyright arising in the club logo.

<sup>25</sup> Practice Amendment Notice 5/04, para 1

his name, as an indication that this is a poster *of* the singer, rather than a poster *authorised* by him. Accordingly, the Notice advises that applications to register a famous name in relation to mere image carriers will be open to objection under sections 3(1)(b) and 3(1)(c) of the Act, relating to distinctiveness and descriptiveness respectively.

The scope of the note is not limited to names of famous individuals, but also covers names of groups as well. In particular, the Trade Marks Registry refers to “badges of allegiance”, which can be used in relation to individuals but are commonly used by supporters of groups and football clubs. With reference to the decision of the trial judge, Laddie J, in the recent *Arsenal* case<sup>26</sup>, the Registry acknowledges that names of famous groups or clubs are often used on scarves, mugs and t-shirts as a badge of allegiance. Such goods are usually available from authorised and unauthorised sources, for example, the official club shop and street traders (as was the case in *Arsenal*). The Registry’s policy is now that such names should not be automatically refused for use on goods which serve as badges of allegiance: “such marks will normally be accepted for such goods unless there is a particular reason to believe that the mark in question cannot fulfil the function of a trade mark.”<sup>27</sup> The example given is that of the name of a member of the Royal family, which may sometimes be incapable of registration as a trade mark as a result of “widespread historical trade” in souvenirs bearing that name. Likewise, the Notice refers to the 1999 Court of Appeal which held that the name Elvis Presley “had very little inherent distinctiveness” and that “members of the public purchase Elvis Presley merchandise not because it comes from a particular source, but because it carries the name or image of Elvis Presley.”<sup>28</sup> In other cases, however, there will be a presumption that the group, club or famous person will be able to register their name in relation to badges of allegiance, unless there is evidence to the contrary. It is worth noting that, if the club or group is successful in registering their name as a trade mark, they will then benefit from the extensive protection granted by the Court of Appeal (following the ruling of the ECJ on this matter) in the *Arsenal* case,<sup>29</sup> whereby use of the registered mark on unofficial products will constitute trade mark infringement.

The Notice also raises the issue of bad faith, in section 3(6) of the Act, in relation to trade marking the names of famous people by third parties. Using the example of Tony Blair, the Registry expands upon the recognised uses of this section (discussed above) and advises that, in future, “Care should... be taken where the reputation of a famous individual is not commercial. For example, Tony Blair, whose fame stems from politics, should not be accepted for **any** goods/services without his consent.”<sup>30</sup> Applications for famous names which do have a commercial use may also be subject to an objection under section 3(6), but only where the application made by the third party is in relation to the type of goods or services for which they are famous.<sup>31</sup> In practice, this means that an application by anyone other than Robbie Williams to

---

<sup>26</sup> *Arsenal v Reed* [2001] RPC 622

<sup>27</sup> Practice Amendment Notice 5/04, para 7

<sup>28</sup> *Elvis Presley Trade Marks*, [1999] RPC 567, per Walker LJ at 585

<sup>29</sup> *Arsenal v Reed* [2003] EWCA Civ 696

<sup>30</sup> Practice Amendment Notice 5/04, para 11

<sup>31</sup> *ibid*, para 10

register “Robbie Williams” in relation to CDs would constitute bad faith, whereas no such presumption would apply in the case of registering that name for chemical herbicides, for example.

### **5. Commentary on the effects of the Notice**

It can be seen from this Notice that future celebrities will not be able to register their names in relation to mere image carriers. The Trade Marks Registry has confirmed that existing registrations for such goods will remain on the register,<sup>32</sup> but I would suggest, however, that this comfort is not sufficient to allow Jamie, Robbie and David to sleep soundly at night. Any attempt by them to enforce their marks for these goods is likely to be met with a strong defence by the alleged infringer that the trade mark is invalid as the name in question is simply descriptive of such goods, in accordance with the Notice. An alternative argument would be any unauthorised use on posters does not constitute use of the name in a trade mark sense and is therefore not an infringement.

Despite this guidance, however, the Trade Marks Registry has not attempted to address one of the wider issues arising in relation to celebrity trade marks. As noted above, the 1994 Act defines a trade mark as a sign capable of distinguishing goods and services provided by different undertakings. This is emphasised on the Patent Office website, which states that “A trade mark is any sign which can distinguish the goods and services of one trader from those of another.” To what extent can it truly be said that a famous name fulfils this purpose in relation to any goods or services? While acknowledging that use of a famous name on mere image carriers is not appropriate, the Registry does not consider whether use of the famous name for primary goods or services does indeed distinguish the goods of one trader from those of another. In many cases, the famous name will be used to identify the content of the goods or services, rather than the goods or services themselves, and this can often be protected by other forms of intellectual property. One example would be the case of a singer who does not register her name for CDs or for concerts. In both cases, the singer is not manufacturing CDs or promoting pop concerts, but is in fact providing the content of these. Anyone else who produced an unauthorised CD of the singer would, *prima facie*, be guilty of copyright infringement. If a concert were to be staged in the name of the singer, but featuring an imitator, then her remedy would arguably lie in passing off. Authority for such a course of action can be found in *Irvine v Talksport*,<sup>33</sup> where Laddie J held that a photo that had been manipulated to show Eddie Irvine promoting Talk Radio amounted to passing off. Instead, a singer such as Robbie Williams, who has trade mark protection in these areas, would simply raise an action for trade mark infringement. It is suggested that the lack of recognition given to, and the inconvenience of raising an action in relation to, alternative forms of intellectual property protection is partially responsible for the increasing use by celebrities of trade mark protection. Although an examination of these alternatives or the possibility of developing a new “personality right” is beyond the scope of this note, it is worth noting that trade mark registration is not necessarily the only, or indeed the most appropriate, option for celebrities keen to preserve their most

---

<sup>32</sup> As at 28 April, in response to a personal inquiry.

<sup>33</sup> [2003] EMLR 538

valuable asset. This is, however, ground upon which the Trade Marks Registry has so far chosen not to tread and, indeed, should more properly be a matter for consideration by Parliament.

One final point that is not addressed by the Notice could be regarded as the sting in the tail of celebrity trade mark registration. Dress designer Elizabeth Emanuel had the foresight to register her name as a trade mark to capitalise on her high profile during the 1980s. As a result of increasing debt, however, she sold her design business in the late 1990s, complete with intellectual property rights, and was then very painfully and publicly stung when she realised that she was no longer able to trade under her own name: the registered trade mark protecting it was now the property of the purchaser. Although the European Court of Justice ruling on this matter is awaited, the very facts of the case provide a salutary lesson to those intent on preserving their name through trade mark registration.

## **6. Conclusion**

There can be no doubt that this Notice clarifies the position in relation to the registration of famous names. Celebrities and famous groups or clubs wishing to register their name as a trade mark will in future have to take note of this guidance and modify their applications accordingly. However, it is submitted that the Notice itself does no more than clarify the existing legal position and that, while the commercial rationale behind expansive registrations is understandable, celebrities should not be attempting to register their name for “mere image carriers”. Use of a trade mark on these goods is more than likely to be largely descriptive and certainly not use in a trade mark sense, and therefore to fall outwith the purpose of the legislation. Wider questions, such as whether or not trade mark protection is in fact the correct method of protecting celebrities’ names and personalities, remain unconsidered and unanswered by the Notice.