

1 THE PATENT OFFICE

2 Harmsworth House,
3 13/15 Bouverie Street,
4 London, EC4Y 8DP

5
6 Wednesday, 22nd March 2006

7 Before:

8 MR. GEOFFREY HOBBS QC
9 (Sitting as the Appointed Person)

10 -----
11 In the Matter of THE TRADE MARKS ACT 1994

12 - and -

13 In the Matter of Application No. 2323092B in the name of
14 SIR ALEXANDER CHAPMAN FERGUSON

15 -----
16 Appeal from the decision of Mr. C. Hamilton, acting on behalf
17 of the Registrar, dated 23rd September 2005

18 -----
19 (Computer-aided Transcript of the Stenograph Notes of
20 Marten Walsh Cherer Ltd., Midway House,
21 27/29 Cursitor Street, London EC4A 1LT.
22 Telephone No: 020-7405 5010. Fax No: 020-7405 5026)

23 -----
24 MR. ALAN FIDDES of by Messrs. Urquhart-Dykes & Lord appeared on
25 behalf of the Applicant.

MR. ALLAN JAMES appeared on behalf of the Registrar.

26 -----
27 D E C I S I O N
28 (As approved)
29 -----

1 THE APPOINTED PERSON: Everyone knows that celebrity sells. It is
2 therefore not surprising that persons in a position to do so,
3 should wish to benefit from the commercial exploitation of
4 names, devices and images which enjoy celebrity status as a
5 result of their efforts and endeavours.

6 Appropriate trade mark registrations have long been seen
7 as a way of enabling them to secure such benefits. However,
8 the path to registration has not been as easy to tread as
9 applicants would have wished from a commercial point of view.

10 In the United Kingdom the Registrar's practice with
11 regard to the registration of famous names is set out in the
12 following terms in section 21 of Chapter 6 of the Trade Marks
13 Registry Work Manual.

14 "21 Famous Names Where a famous name is concerned
15 (and where the reputation does not stem from a trade in the
16 goods/services applied for) it is possible that, when used in
17 relation to certain goods/services, the name may appear to the
18 average consumer as an indication that the goods/services are
19 about the person whose name it is rather than as an indication
20 that the goods/services are supplied by, or under the control
21 of, one undertaking.

22 "The Court of Appeal decided that 'Elvis Presley' was
23 not registrable under the 1938 Act for memorabilia products in
24 Class 3: see [1997] RPC 543.

25 "In the case of Arsenal v. Reed [2001] RPC, Laddie J

1 held that the trade mark 'Arsenal' was validly registered
2 under the 1994 Act, even though it could and had been used by
3 others in a non-trade mark sense. He concluded that this did
4 not automatically make the trade mark ARSENAL non-distinctive
5 for scarves etc. Although Arsenal is the name of a famous
6 football club rather than the name of an individual or group,
7 a similar point arises; namely, whether the name of a person
8 or organisation which others wish to use in order to
9 demonstrate their support/allegiance should be registrable as
10 a trade mark for relevant goods. The decision in the ARSENAL
11 case indicates that such protection should not be
12 automatically refused or invalidated in these circumstances.

13 "Accordingly, the correct approach appears to be to
14 consider whether the famous name put forward for registration
15 is so descriptive in relation to the goods/services for which
16 registration is sought that it could not be perceived by
17 consumers as anything more than a description of the subject
18 matter of the goods/services. The following paragraphs are
19 directed at the main areas of uncertainty.

20 "21.1 Media The names of famous persons or groups may
21 serve as trade marks for printed publications, recorded
22 sounds, films, videos, TV programmes, musical or live
23 performances etc as use of the mark on such goods or services
24 would be likely to imply some form of control of, or guarantee
25 from, the holder. Consequently, there will not usually be an

1 objection to the registration of a famous name for these
2 goods.

3 "21.1 Mere Image Carriers The name of a famous person
4 or group is likely to be perceived as merely descriptive of
5 the subject matter of posters, photographs, transfers and
6 figurines. Names of famous persons or groups are therefore
7 unlikely to be accepted by consumers as trade marks for these
8 goods because they will usually be seen as mere descriptions
9 of the subject matter of the product. Objections will arise
10 under Section 3(1)(b) & (c) of the Act.

11 "21.3 Badges of Allegiance The name of a famous
12 person or group may serve to identify the trade source of
13 badges of allegiance (including T-shirts, mugs, scarves etc)
14 even if the possibility of other traders producing unofficial
15 merchandise cannot be ruled out. Consequently, such marks
16 will normally be accepted for such goods unless there is a
17 particular reason to believe that the mark in question cannot
18 fulfil the function of a trade mark, for example, the names of
19 some members of the Royal Family may be incapable of
20 performing a trade mark function for such goods because of the
21 widespread historical trade in Royal souvenirs.

22 "21.4 Names of Deceased Famous Individuals or Defunct
23 Groups In these circumstances the name is more likely to be
24 seen by consumers as merely an historical reference to the
25 subject matter of the goods or services, rather than to the

1 trade source of the goods. However, each such case must be
2 judged on its own facts taking account of the length of time
3 that has passed since the person concerned died, or the group
4 became defunct, and the relationship (if any) between the
5 goods/services in the application and those associated with
6 the dead person or defunct group. A Team Leader will be
7 involved in each case.

8 "21.5 Pictures of Famous Persons (living and deceased)
9 and Groups Pictures of famous persons/groups present similar
10 issues to famous names. However, depending upon the goods,
11 they may be more likely (compared to a name) to be taken as
12 mere decoration and therefore to lack a trade mark character.
13 Each case will be judged on its own merits and a Hearing
14 Officer will be involved in each case."

15 The Registrar's practice and the legal context in which
16 it operates were recently considered by Mr. Richard Arnold QC
17 sitting as the Appointed Person in LINKIN PARK Trade Mark
18 (BL 0-035-05, 7th February 2005). I understand that, in the
19 course of the hearing of that appeal, he invited the appellant
20 and the Registrar to consider whether a reference to the
21 European Court of Justice might be appropriate in relation to
22 the points of law arising. Both parties asked him to decide
23 the appeal without making a reference. This he duly did.

24 Having considered the Registrar's published practice, he
25 expressed the view in paragraph 68 of his decision that it

1 might, in certain respects that were not material to the case
2 before him, be unduly lenient to applicants.

3 Sir Alexander Ferguson and those who know or have heard
4 of him would not deny that his name enjoys celebrity status.

5 On 7th July 2003, he applied to register the designation
6 ALEX FERGUSON as a trade mark for use in relation to various
7 goods and services in Classes 6, 9, 14, 16, 25, 28 and 41. The
8 Registry raised objections to registration under sections
9 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994.

10 The Applicant subsequently addressed the objections by
11 dividing the application into two parallel applications under
12 section 41(1)(a) of the Act and Rule 19 of the Trade Marks
13 Rules 2000.

14 The larger part of the divided request for protection
15 was covered by Application 2323092A. This proceeded to
16 registration on 9th December 2005. The Applicant thereby
17 obtained registration of the designation ALEX FERGUSON as a
18 trade mark for use in relation to the following goods and
19 services:

20 "Class 06: Ornaments; ornaments of common metal or
21 their alloys; figurines; figurines of common metal or their
22 alloys; trophies; trophies of common metal or their alloys;
23 signs; signs of common metal or their alloys.

24 "Class 09: Pre-recorded videotapes; pre-recorded audio
25 tapes; laser read disks for recording and playing sound and

1 video; DVDs; CDs; CD-ROMs; computer tapes and disks; records;
2 recordings of sound or images; films; photographic film;
3 teaching, training and instructional films, videos, DVDs, CDs,
4 CD-ROMs; and cassette tapes, teaching, training and
5 instructional films, videos, DVDs, CDs, CD-ROMs; and cassette
6 tapes all relating to soccer; computer software and programs;
7 computers; computer peripherals; data carriers; electrical
8 communications apparatus and instruments; electronic machines
9 and instruments; video games; computer games; computer
10 programs for playing games; electronic equipment for playing
11 video and computer games; photographic transparencies;
12 photographic films, photographic transparencies and
13 photographic films prepared for exhibition and purposes; and
14 parts and fittings for all of the above goods.

15 "Class 14: Precious metals; coins; medals;
16 commemorative coins; commemorative medals; trophies made of or
17 coated with precious metals and or their alloys; horological
18 and chronometrical instruments; stop-watches; sports
19 stop-watches; wrist-watches; sports wrist-watches.

20 "Class 16: Calendars; playing cards; magazines;
21 magazines relating to football; newspapers; newsletters;
22 instruction manuals; greetings cards; notelets; paper;
23 cardboard; periodical publications; instructional and teaching
24 materials (except apparatus); instructional and teaching
25 materials (except apparatus) relating to football, football

1 management, team management and motivational skills; record
2 token cards; gift token cards; stationery; pens; pencils; pen
3 and pencil cases.

4 "Class 25: Clothing; footwear; headgear; clothing for
5 men; clothing for women; clothing for children; sports
6 clothing; football strips; shirts; shorts; t-shirts; socks;
7 sweatshirts; hats; caps; scarves; jackets; tracksuits; ties;
8 vests.

9 "Class 28: Games; playthings; toys; dolls; sporting
10 articles; sporting articles for use in the training for and
11 playing of football; bags adapted for sporting articles;
12 footballs; shinpads; goalkeeper's gloves; goal posts; goal
13 nets; temporary and reduced size goal posts.

14 "Class 41: Public speaking, public speaking relating to
15 football, football management, team management and
16 motivational skills; instruction; coaching; training;
17 instruction, coaching and training relating to football,
18 football management, team management and motivational skills."

19 I think it is important to emphasise that the
20 application was accepted without any requirement for evidence
21 as to the capacity of the designation ALEX FERGUSON to serve
22 as a trade mark for goods and services of the kind specified.

23 The balance of the original request for protection was
24 covered by Application 2323092B. This sought to protect the
25 designation ALEX FERGUSON as a trade mark for use in relation

1 to the following sub-set of goods in Class 16: printed
2 matter; posters; photographs; transfers; stickers;
3 decalcomanias; stickers relating to football.

4 The Registry maintained its objections to registration
5 in respect of these goods. It did so for the reasons given by
6 Mr. Charles Hamilton on behalf of the Registrar in a decision
7 issued on 23rd September 2005 (BL 0-266-05).

8 The Hearing Officer's decision was based on
9 paragraph 21.2 of the Registrar's Practice relating to Famous
10 Names and the approach to the evaluation of descriptiveness
11 and distinctiveness found in the judgments of the European
12 Court of Justice in Case C-363/99 POSTKANTOOR, Case C-191/01P
13 DOUBLEMINT, Case C-104/01 LIBERTEL, Case C-104/00 COMPANYLINE
14 and Joined Cases C-53/01 to C-55/01 LINDE.

15 He found further guidance and support in paragraphs 65
16 to 68 of the decision of the Appointed Person in LINKIN PARK
17 Trade Mark and paragraphs 27 to 29 of the opinion delivered by
18 Advocate-General Jacobs in Case C-498/01P Zapf Creation AG v.
19 OHIM on 19th February 2004, although the latter case was
20 withdrawn and the European Court of Justice was therefore not
21 required to adjudicate upon the matters in issue after the
22 Advocate-General's opinion had been delivered.

23 His conclusion that the objections to registration
24 should be maintained rested upon the proposition stated in
25 paragraph 12 of his decision: "I believe that the mark of

1 this application may serve in trade to designate one of the
2 essential characteristics of the goods, for example, image
3 carriers that may be referred to as 'Alex Ferguson posters'".

4 He re-affirmed the point in paragraph 19 of his decision
5 where he said: "In the present case the applicant is seeking
6 registration of the words ALEX FERGUSON for goods which
7 include 'image carriers'. In all cases the mark ALEX FERGUSON
8 designates an essential characteristic of the goods since the
9 mark will be perceived immediately by potential purchasers as
10 defining the subject matter of the goods. For example, a
11 poster depicting Sir Alex Ferguson sold under the mark ALEX
12 FERGUSON would clearly be identified by buyers and sellers as
13 an 'Alex Ferguson' poster."

14 These observations appear to me to assume that the mode
15 of use covered by the application for registration would be
16 use of the designation ALEX FERGUSON as a way of referring to
17 the character or quality of goods which had been produced for
18 the purpose of capitalising, in one way or another, upon the
19 persona of Sir Alex Ferguson. It is, to say the least,
20 interesting that no such assumption appears to have stood in
21 the way of the divided application for registration which was
22 allowed to proceed in Classes 6, 9, 14, 16, 25, 28 and 41.

23 Two further points should be mentioned at this juncture.
24 First, the Hearing Officer rejected the suggestion on the part
25 of the Applicant that the registrability of the designation

1 ALEX FERGUSON should be assessed on the basis that anyone
2 using it descriptively in accordance with honest practices in
3 industrial or commercial matters would have a defence under
4 section 11(2) of the Act corresponding to Article 6(1) of
5 Council Directive 89/104/EEC of 21st December 1988 in the
6 event that they were sued for infringement of any registration
7 granted pursuant to Application 2323092B.

8 Second, the Hearing Officer rejected the suggestion on
9 the part of the Applicant that the objections to registration
10 could be overcome by restricting the application in Class 16
11 so as to exclude goods bearing images of Sir Alex Ferguson.
12 He did so on the basis that the European Court of Justice had
13 decided in paragraphs 111 to 117 of its judgment in
14 POSTKANTOOR that it was impermissible for a trade mark
15 registration authority to register a mark for certain goods or
16 services on condition that they do not possess a particular
17 characteristic. That outcome may be contrasted with the
18 practice relating to the imposition of the so-called "Rolling
19 Stones" condition favoured in the United Kingdom in years gone
20 by.

21 For the purpose of correlating the mark with goods of
22 the kind it was intended and expected to distinguish, UK Trade
23 Mark No. 996132 ROLLING STONES was registered in Class 9 with
24 effect from 1st August 1972 on condition that "the mark shall,
25 when in use in relation to discs and tapes, be used in

1 relation only to such discs and tapes comprising
2 pre-recordings performed, written or produced by members of
3 the Rolling Stones group".

4 On 11th October 2005 the Appellant gave Notice of Appeal
5 to an Appointed Person under section 76 of the Act. The
6 papers for the appeal were subsequently forwarded to me by the
7 Treasury Solicitor's department. For the purposes of the
8 screening process envisaged by section 76(3) of the Act and
9 Rule 64(5) of the Trade Marks Rules, I looked at the Hearing
10 Officer's decision and the Grounds of Appeal. On doing so, I
11 formed the view that the appeal raised a question of general
12 importance as to the basis on which celebrity could be
13 regarded as an impediment to registration (if indeed it could
14 legitimately be regarded as an impediment to registration)
15 under the harmonised law of trade marks now operating in the
16 Member States of the European Community.

17 Paragraph 5 of the Grounds of Appeal summarised the
18 Applicant's main contention in the following terms: "5. The
19 Grounds of Appeal in this matter are that the Registry's
20 practice with regard to the registration of the name of a
21 famous person is unlawful as it discriminates against that
22 individual on the basis of their status, namely that they are
23 famous and that such discrimination is contrary to the
24 provisions of the European Convention on Human Rights which
25 were established in English Law by virtue of the Human Rights

1 Act 1998".

2 Paragraph 7 referred to Article 1, Protocol 1 of the
3 European Convention on Human Rights which provides that:
4 "Every natural or legal person is entitled to the peaceful
5 enjoyment of his possessions. No one shall be deprived of his
6 possessions except in the public interest and subject to the
7 conditions provided for by law and the general principles of
8 international law."

9 It also referred to Article 14 of the Convention which
10 provides that: "The enjoyment of the rights and freedoms set
11 forth in this Convention shall be secured without
12 discrimination on any grounds such as sex, race, colour,
13 language, religion, political or other opinion, national or
14 social origin, association with a national minority, property,
15 birth or other status."

16 These Articles were said to support the contention that:
17 "The applicant has been denied the right to enjoy and protect
18 his possessions, namely his own name and his reputation by the
19 unlawful actions of the Registry in that the Registry has
20 discriminated against the applicant on the basis of his
21 status, namely that he is a famous person, thereby denying him
22 the protection of the law provided through the registration of
23 his possessions as a trade mark under the provisions of the
24 Act."

25 Inequality of treatment was alleged on the basis that

1 the Applicant had been refused, in circumstances where an
2 applicant who was not famous would have been allowed,
3 registration of the relevant designation for the goods of
4 interest in Class 16. There was said to be no objective
5 justification for the treatment the Applicant had received.

6 In support of that contention it was maintained that the
7 rights of third parties with regard to use of the designation
8 ALEX FERGUSON for goods of the kind specified by the Applicant
9 were fully protected by the defences to infringement available
10 under section 11(2) of the Act and Article 6(1) of the
11 Directive.

12 There clearly were difficulties in the way of the
13 Applicant's attempt to pursue his complaint about unequal
14 treatment by reference to Article 1, Protocol 1 and Article 14
15 of the European Convention on Human Rights, with or without
16 reference to the saving provisions of section 11(2) and
17 Article 6(1).

18 I should at this point briefly refer to the principal
19 difficulties: (1) The prevailing view is that in order to
20 prevent trade marks from being improperly registered, the
21 grounds for refusal of registration should be applied
22 independently of the defences that might be available to
23 traders accused of infringement: see, for example, the
24 judgment of the ECJ in Case C-404/02 Nichols Plc v. Registrar
25 of Trade Marks at paragraphs 31 to 33.

1 (2) Article 14 of the European Convention on Human
2 Rights does not prohibit all discrimination. It prohibits
3 discrimination only in certain respects and on certain
4 grounds. The scope of Article 14 is restricted in two ways:
5 first, it sets out a restricted list of the matters in respect
6 of which discrimination is forbidden. They are the enjoyment
7 of the rights and freedoms set forth in the Convention.
8 Second, it has a restricted list of the grounds upon which
9 discrimination is forbidden. They are any ground of the kind
10 specified "or other status". These considerations are
11 examined in the judgments of the House of Lords in R. (on the
12 application of Carson) v. Secretary of State for Work and
13 Pensions [2005] UKHL 37 (26th May 2005).

14 (3) There is room for debate as to how broadly or
15 narrowly the concept of "status" should be construed in
16 accordance with the meaning to be attributed to it for the
17 purposes of Article 14: see, for example, Francis v.
18 Secretary of State for Work and Pensions [2005] EWCA Civ 1303
19 (10th November 2005) at paragraphs 20 to 28 of the judgment of
20 Sir Peter Gibson.

21 (4) Subject to the outcome of any appeal to the Grand
22 Chamber in the case of Anheuser-Busch Inc. v. Portugal
23 (Application no. 73049/01), in which judgment was delivered by
24 the European Court of Human Rights on 11th October 2005, it
25 appears to be settled that an application for protection of a

1 trade mark by registration is not eligible to be regarded as a
2 possession for the purposes of Article 1, Protocol 1 of the
3 Convention.

4 It seemed likely to me that the Applicant's appeal
5 would, in the light of considerations such as these, boil down
6 to the question: Why was he refused protection and was he
7 legitimately refused protection on that basis? From that
8 point of view, the appeal would depend upon the correct
9 approach to the assessment of "celebrity" in the context of
10 absolute grounds for refusal of registration. In particular,
11 it would put the spotlight on the correctness or otherwise of
12 imbuing the goods or services specified in an application for
13 registration with content or character linked to the celebrity
14 of the mark put forward for registration.

15 I therefore sent a Notice to the Applicant and the
16 Registrar in the following terms: "1. I have read and
17 considered: (1) the decision issued by the Registrar's
18 Hearing Officer Mr. Hamilton on 23 September 2005
19 (BL 0-266-05); (2) the Notice and Grounds of Appeal filed on
20 behalf of Sir Alexander Chapman Ferguson ('the Appellant') on
21 11 October 2005; and (3) the Registrar's approach to the
22 examination of 'Famous Names' as set out in section 21 of
23 Chapter 6 of the Trade Marks Registry Work Manual.

24 "2. I also note that in LINKIN PARK Trade Mark
25 (BL 0-035-05, 7 February 2005) at paragraph 68 the Appointed

1 Person (Mr. Richard Arnold QC) said: 'My conclusion is that
2 paragraph 21.2 of the Work Manual represents a correct
3 application of the law as it presently stands. For the
4 reasons I have given, I am less sure about paragraphs 21.1 and
5 21.3; but if they are wrong it is because they are unduly
6 lenient to applicants, which does not assist the present
7 applicant.'

8 "3. It appears to me that the Registrar's practice, the
9 decision in the LINKIN PARK case and the decision in the
10 present case conform to the view that a name is prima facie
11 unregistrable as a trade mark for goods of a kind that may be
12 designed: (1) to serve as mementoes or souvenirs of the
13 personage(s) or event(s) signified by the name in question; or
14 (2) to impart information (in verbal, non-verbal, visible or
15 audible form) about the personage(s) or event(s) so signified.

16 "4. The more famous the personage(s) or event(s), the
17 more likely it is that there will be a market for such goods
18 and the less likely it is that the name will be regarded as
19 acceptable for registration in relation to goods of that kind
20 on the basis of the approach currently applied by the Registry
21 in the United Kingdom.

22 "5. Recent examples of refusals on the basis of that
23 approach are: DIANA PRINCESS OF WALES Trade Mark [2001] ETMR
24 254; LINKIN PARK Trade Mark (above); and AMBERLEIGH HOUSE
25 Trade Mark (BL 0-258-05, 16 September 2005).

1 "6. It is not clear to me that the same approach is
2 applied in the Community Trade Marks Office (cf the
3 Cancellation Division decision of 28 October 2005 in Case 968
4 C 002047843 Ferrero oHG mbH v. Federation Internationale de
5 Football Association) or in other Member States.

6 "7. I do not consider that the observations in
7 paragraphs 27 to 29 of the Opinion delivered by Advocate
8 General Jacobs in Case C-498/01P Zapf Creation AG v. OHIM
9 [2004] ETMR 67, p.964 resolve the question whether the
10 approach applied in the United Kingdom is too strict, too
11 lenient or substantially correct in terms of the requirements
12 of Community law.

13 "8. That question appears to me to be a question of
14 general importance. I believe that it arises for
15 determination in the context of the present appeal. I
16 therefore wish to receive representations from the Appellant
17 and the Registrar as to whether the appeal should be referred
18 to the Court under section 76(3)(a) of the Trade Marks Act
19 1994 or whether there should be a request for guidance on
20 interpretation from the European Court of Justice under
21 Article 234 of the EC Treaty with a stay of proceedings in the
22 meantime.

23 "9. A preliminary hearing to consider these matters
24 will be appointed through the usual channels. At that hearing
25 the Appellant and the Registrar will also be invited to make

1 representations as to whether I should give any directions
2 under Rule 57 of the Trade Marks Rules 2000 for the provision
3 of information as to the approach adopted by the Community
4 Trade Marks Office and/or other Member States in relation to
5 the matters identified in paragraphs 3 and 4 above."

6 The hearing to consider these matters was scheduled for
7 20th March 2006. In advance of the hearing I received
8 skeletons of argument from the Appellant and the Registrar.
9 The Registrar's skeleton was the first to be received. It
10 indicated that the Registrar's approach to registration was
11 more liberal than paragraph 3 of my Notice would suggest. It
12 drew attention to the difficulties involved in the appellant's
13 decision to concentrate on Article 14 and Article 1,
14 Protocol 1 of the Convention in his grounds of appeal. In the
15 absence of amendment to the Grounds of Appeal, the Registrar
16 considered that there was no sufficient reason for pursuing
17 any of the avenues for determination mentioned in paragraphs 8
18 and 9 of my Notice. The Registrar acknowledged that a point
19 of trade mark law of general importance might arise if the
20 Grounds of Appeal were amended so as to present the
21 discrimination argument on a broader basis. In that event,
22 the approach preferred by the Registrar would be a reference
23 to the European Court of Justice under Article 234 of the EC
24 Treaty. The utility of inquiring into the practice followed
25 by the Community Trade Marks Office and at the national level

1 in other Member States was doubted on the basis that it was
2 likely, in the context of the hypothesised point of general
3 importance, to reveal a diversity of approach and thereby
4 raise more questions than it answered.

5 As an example of that, the Registrar referred to a copy
6 of a case report of Ferrero et al's Application v. FIFA (3
7 August 2005) in which the German Federal Patent Court upheld
8 the cancellation of FIFA's trade mark in Germany for "media
9 products" on the ground of descriptiveness. This contrasted
10 with the decision of the Cancellation Division of the
11 Community Trade Marks Office referred to in paragraph 6 of my
12 Notice.

13 The Applicant's skeleton opposed the proposals
14 identified in paragraphs 8 and 9 of my Notice. It did so on
15 the basis that the Appointed Person was simply being asked to
16 apply the Registrar's practice on Famous Names and the
17 decision in LINKIN PARK Trade Mark in accordance with the
18 provisions of the Human Rights Act 1998 and that this gave
19 rise to no point of law of general importance or any point on
20 which it would be useful to inquire into the practice either
21 of the Community Trade Marks Office or at the national level
22 in other Member States.

23 It was submitted: "That the determining question in this
24 matter is whether the trade mark application is a possession
25 under English law." The judgment of the European Court of

1 Human Rights in Anheuser-Busch Inc. v. Portugal was said to be
2 merely persuasive on this point. It was submitted that the
3 dissenting judgment in that case should be regarded as correct
4 so far as the position in the United Kingdom was concerned.

5 These positions were confirmed at the hearing before me.
6 In particular, it was confirmed on behalf of the Applicant
7 that he accepted the correctness of the Registrar's practice
8 on Famous Names and of the reasoning of the decision in the
9 LINKIN PARK case and that both had been correctly applied by
10 the Hearing Officer in the decision under appeal subject only
11 to the question whether due regard for the provisions of the
12 Human Rights Act should have led him to accept the relevant
13 application for registration. There would, accordingly, be no
14 amendment to the Grounds of Appeal and no presentation of the
15 discrimination argument on the broader basis that I had
16 foreseen when considering the papers for the appeal.

17 Having re-considered paragraph 3 of my Notice in the
18 light of the Registrar's comments, I remain of the view that
19 it does indeed identify the basis on which registration is
20 refused in cases where an application is rejected in
21 accordance with the published practice, notwithstanding that
22 the published practice may be applied with a greater degree of
23 lenience than would be the position if the underlying
24 proposition was carried to its ultimate conclusion.

25 However, it is unnecessary for me to go any further in

1 relation to the prevailing practice. The Applicant's appeal
2 is confined to the points on the Human Rights Act I have noted
3 above. There will be no broader basis of attack on the
4 Hearing Officer's decision. It is no part of the role of a
5 judicial tribunal (especially an appellate tribunal) to raise
6 arguments for presentation by professionally represented
7 parties in adversarial proceedings. That was recently and
8 emphatically re-affirmed in the judgment of the Privy Council
9 on appeal from the Court of Appeal in Guernsey in The
10 President of the State of Equatorial Guinea and Another v. The
11 Royal Bank of Scotland International and Others [2006] UKPC 7
12 (27 February 2006). In the result, there will be no further
13 action of the kind envisaged in paragraphs 8 and 9 of my
14 Notice and the appeal in the present case will, in due course,
15 be listed for hearing in the ordinary way.

16 THE APPOINTED PERSON: That is the judgment that I indicated to
17 you the other day I would deliver explaining my reasons for
18 deciding as I did. What I would intend to do now is to
19 arrange for this appeal to be listed in front of one of the
20 other Appointed Persons, since, in a sense, I have had a go at
21 it already. That will be notified to the Registrar and the
22 Applicant through the usual channels in the ordinary way.

23 I am not sure that there is anything else we need to
24 discuss, but if anybody wants to raise it, please do so now.

25 MR. FIDDES: No, I do not have anything to raise at this time,

