

O-006-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2463230
BY CATHERINE HUGHES TO REGISTER THE
TRADE MARK
IAN ADAM
IN CLASS 41**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 96672 BY
ANNETTE CAMPBELL & BENTE ZABER**

BACKGROUND

1) On 4 August 2007 Catherine Hughes applied to register the trade mark IAN ADAM. After examination, the trade mark was accepted and subsequently published for opposition purposes on 21 December 2007 in Trade Marks Journal No.6715 for the following services:

Class 41: Education; providing of training, voice training, voice coaching; voice lessons; entertainment; sporting and cultural activities.

2) On 20 March 2008 Annette Campbell and Bente Zaber (the opponents) filed a notice of opposition. In summary the opposition is based upon the following:

a) Ian Adam was a world renowned vocal coach who died in May 2007. He developed a substantial reputation in the musical world for his voice coaching and for the techniques that he developed. The opponent's are Annette Campbell (Ian Adam's next-of-kin) and Bente Zaber (one of Ian Adam's closest business partners). The opponent's contend that the mark in suit is of such a nature to deceive the public as to the nature and origin of the services. The public would assume that the services provided would be in accordance with the techniques and philosophy developed by Ian Adam and approved by him, or his estate. The opponents contend that the applicant has no such approval and is not in a position to guarantee such standards. The application therefore offends against section 3(3)(b) of the Trade Marks Act 1994.

b) The opponents contend that the applicant has no rightful proprietary claim to the mark in suit. The mark in suit is said to have been applied for in bad faith, contrary to section 3(6) of the Act.

3) On 27 June 2008 the applicant filed a counterstatement which simply denied the opponent's contentions.

4) Both sides filed evidence in these proceedings which to the extent that I consider it necessary I have summarised below. The matter came to be heard on 29 October 2009 when the applicant was represented by Mr Marsden of Messrs Saunders and Dollymore and the opponents by Ms Szell of Messrs Venner Shipley LLP.

OPPONENTS' EVIDENCE

5) The opponents filed fifteen witness statements. The first, dated 26 September 2008, is by Edward Carstairs the opponents' Trade Mark Attorney. At exhibits EC1-EC7 he provides copies of pages from the internet which show that Ian Adam was a well known and acclaimed voice coach who worked with actors, singers and television personalities. He dealt with the greats of the stage and screen such as Michael Crawford, Clive James and Anita Harris. I do not intend to summarise the evidence which refers to the reputation of Mr Adams as this is acknowledged by both parties. However, I note that at exhibit EC1 in a copy of an obituary from the Guardian it states "...and Scottish Opera in Glasgow, where he met his lifelong assistant Kate Hughes and

started to develop his singing practice in London”. At exhibit EC2 is an obituary from the Guardian dated 4 June 2007 by Clive James in which he states:

“Ian’s devoted assistant, Kate Hughes, who filled in for him when he was away, imposed the same regime of disciplinary warm-up; so we all got to reproduce these strange sets of sounds week by week, forever. Before they got to work on that week’s song or an aria, everybody had to go through the same preparation”.

6) The opponents’ second witness statement, dated 28 October 2008, is by Bente Zaber. Ms Zaber states:

“In the late nineties Catherine Hughes began coming down from Scotland to teach as a stand-in for Ian Adam now and then when he was abroad to teach in Denmark or other places. This was something that he had a number of people doing, among these several of his pianists, in order to keep business going. Ian had no expectation that the various stand-in’s could carry on his work to the same level as himself, but at least his many distinguished clients would be able to do his exercises and rehearse whatever music they were working on. Open minded as Ian was he would trust them to do their best and in the end he would come back and correct what he didn’t like. But... he is not coming back anymore!

On Ian suggestion I had a lesson by Catherine Hughes (in 1999 I think). He thought it’d be interesting as it’d be something entirely different and actually paid for the lesson. Initially Catherine Hughes did not use Ian’s techniques, which I then had to insist on doing. Thus, from this personal experience I regard her as a competent teacher and a good musician, she has her very own ideas about singing and vocal production. She never worked closely together with Ian Adam and though standing in for him on several occasions, she is not trained to teach his method.”

7) Ms Zaber then goes on to describe at great length how she came to meet and work with Ian Adam, including staying at his house in London and how he would stay with her when working in Copenhagen. She describes how he persuaded her to begin teaching his methods in Denmark and how she took master classes in Denmark using the techniques that Ian Adam had taught her. She also assisted Ian Adam to teach in Norway. It is clear from her account that Catherine Hughes helped to plan the funeral and the Memorial concert for Ian Adam. Ms Zaber states that she and others would prefer to set up a non-profit trust to honour Mr Adam’s name and perhaps offer a scholarship once a year to a young gifted singer. Attached to her statement as exhibits are witness statements that have been separately filed and also letters and articles. The witness statements are summarised later. The letters are from singers and musicians who confirm that Ms Zaber was a personal friend and work colleague of Mr Adam, also included are articles which show Ms Zaber and Mr Adam teaching in Norway.

8) The third witness statement, dated 3 November 2008, is by Sarah Kate Szell the opponents Trade Mark Attorney. She provides as exhibits sheet music and exercises and an exercise CD and also a DVD of Mr Adam’s BBC programme.

9) The fourth witness statement by Glory Anne Clibbery is undated. She states that she was a personal assistant to Mr Adam for a number of years. She states:

“7. At least three other people were more likely to fill in than Kate [the applicant] as she had her own life in Scotland but we all felt like an extended family with Ian as the head of that family.”

10) Also filed were witness statements by Peder Kragerup, Soren Valente Oveson, Carl Henrik Molgaard, Suse Svanekier Pederson, Lisa Freeman-Nielsen, Lillian Abeck, Anders Fastbong, Ole Jorgensen, Henrik Hartvig Jorgensen, Donna Cadogan and Madeleine L Sjostrand. All provided detailed accounts of how they meet Ian Adam in Denmark or Sweden during his many visits to teach his singing methods. Many provide personal details and hearsay evidence which are of no relevance to the decision. They all comment that in their experience Ms Zaber worked very closely with Mr Adam and used his techniques, some state that the applicant assisted by teaching in London during Mr Adam’s overseas travels. They also state their opposition to anyone, other than Ms Zaber, owning the mark in suit as they describe Mr Adam as a free spirit who would want his teaching method freely available to all.

APPLICANT’S EVIDENCE

11) The applicant, Catherine Christie Hughes, filed a witness statement, dated 19 March 2009. She states that she worked with Ian Adam in London since early in 1970. She states that she provided singing lessons and voice coaching to a wide range of clients alongside Ian Adam since the 1990s. She states that she and Ian Adam operated the Ian Adam Song Studio providing singing lessons and voice coaching to clients. Ms Hughes states that she had sole responsibility for running the studio during Mr Adam’s overseas visits and during his illness when he was in hospital. She states that since the early 1990s this has meant that she was responsible for the operation of the studio for months at a time, and since Mr Adam’s death in 2007 she has continued to operate from the same premises under the same name. At exhibit 2 she provides a letter from Mr Rob Nash a piano accompanist. Mr Nash states that he worked for Mr Adam from 1991-2007. He states that during this time Ms Hughes would come from Scotland to London three or four times a year for two-six weeks at a time whilst Mr Adams was abroad. He states she would teach Mr Adams clients and also new students.

12) At exhibit 3 she provides two letters. One from a Jennifer McGrath confirms that Ms Hughes gave her singing lessons. The second from Mr Patterson, confirms that he lodged at Mr Adam’s house from 1968-1979 and witnessed Ms Hughes teaching on behalf of and with Mr Adams. He states that after this date he also stayed at the premises and that he witnessed Ms Hughes teaching Mr Adam’s clients whilst Mr Adam was abroad teaching.

13) At exhibit 4 she provides a copy of a stamp which she states was applied to all receipts when invoicing clients of the Ian Adam Song Studio. The stamp has the following wording:

KATE HUGHES
“IAN ADAM SONG STUDIO”
15 OVIINGDON ST.

LONDON SW3 2JA
020 7584 0547

14) She states that Ian Adam appointed her his next of kin. At Exhibit 6 is a copy of the hospital record that shows Ms Hughes as Mr Adam's next of kin.

OPPONENTS' EVIDENCE IN REPLY

15) The opponents filed six witness statements in reply. Also filed with these statements is a letter from the opponents Trade Mark Agent which made a number of allegations against Ms Hughes of a serious nature, including accusing her of making false claims in her witness statement.

16) The first witness statement, dated 9 May 2009, is by Andrew McRobb. He states that he was a close personal friend of Mr Adam for nearly forty years. He states that there were few subjects in Mr Adam's public and private life that they did not discuss. He states that there were three "strong-minded, strong-willed women" in Mr Adams life; Ms Hughes, Ms Zaber and Jane Ottaway. He states that Ms Hughes stood in for Mr Adams when he was abroad, but was not his assistant. He categorizes Ms Zaber as working as an assistant to Mr Adams in Scandinavia and also continuing his work after he returned to London. Ms Ottaway he states sorted out Mr Adam's finances. He states that it was Mr Adam's habit to name whoever was with him when he entered hospital as his next of kin. He states that he himself was nominated in this manner on more than one occasion.

17) The second witness statement, dated 3 June 2009, is by Marguerite Clibbery. She states that she was a close friend of Mr Adam. She confirms that Ms Hughes was one of many people who stood in for Mr Adam when he was overseas. She states that Mr Adam did not run his business under the name "Ian Adam Song Studio", and points out that no evidence such as bank statements have been provided to back up this claim of a working partnership. Ms Clibbery states that she and her daughter, Glory, kept a daily book of Mr Adam's lessons, collected payment for same and answered phones etc. She states that the idea of a stamp was her daughters, but she does not recognise the stamp from Ms Hughes evidence.

18) The third witness statement, dated 3 June 2009, is by Glory Anne Clibbery. She states that she observed students paying for lessons either in cash or by cheque made out to Mr Adam. She states that Ms Hughes travelled from Scotland to stand in for Mr Adam "for a few days once or twice a year", beginning "in about 1993". Ms Clibbery states that Ms Hughes was not a partner in Mr Adam's business, and she states "I have never seen the stamp she [Ms Hughes] has put into evidence".

19) The fourth witness statement, dated 10 May 2009, is by Annette Campbell. She states that she is the only niece of the late Ian Adam. She continues:

"2) When I was told of his death, I was also told by Catherine Hughes that he had not left a will and that he was in serious debt. She also told me, repeatedly, that possessions would

have to be sold to accumulate monies for outstanding bills, especially a tax bill. She said she would keep me updated on this.

3) In June 2007 I was informed by Catherine Hughes I would have to come to London to meet with a solicitor because, as next of kin, my presence was required.

4) We met the solicitor at a place called Liphook. In all there were 7 of us there, including my husband and I and Catherine Hughes. At all times Catherine Hughes referred to me as the sole next of kin. I instructed the solicitor that it would be acceptable for Catherine Hughes and Andrew McRobb to settle my uncle's affairs, as long as I was kept informed of any decisions that were made.

5) At one stage Catherine Hughes told me that my uncle had no business. However, she now runs what she states to be my uncle's business and she refers to "The Ian Adam Song Studio" in the letterhead of any correspondence she sends. However, my uncle did not run a business called "Ian Adam Song Studio" and he did not use the term "Ian Adam Song Studio."

20) At exhibit AC1 she provides a copy of a letter from Mr Robert Tozzi, the solicitor she first met in Liphook. The letter states that Mr Adam was a statutory tenant at 15 Ovington St and could not have passed any right to anyone to live or work there. The letter also confirms that Ms Hughes was dealing with Mr Adams affairs under the authority of Mrs Campbell. Mrs Campbell also states that Mr Nash, who gave evidence for the applicant, ceased employment with Mr Adam in 2001 and "had no contact with him from that date".

21) The fifth witness statement, dated 11 May 2009, is by Peter Edney of Peter Edney & Co Chartered Accountants. He states that for fifteen years until 2007 he was Mr Adam's accountant. He states that Mr Adam was not in partnership with anyone during these fifteen years and that when he visited the premises at Ovington St on an almost annual basis he "never met anybody else other than Jane [Ottoway] and the odd male assistant". He states that the tax outstanding at Mr Adam's death has not been paid, nor have his firm's fees. He points out that if a partnership had existed then Ms Hughes would have been in touch with him and she has not contacted him. He also states:

"5) As regards a stamp being shown at exhibit 4 of Catherine Hughes witness statement referring to "Ian Adam Song Studio", I have never heard of that expression before."

22) The sixth witness statement, dated 18 June 2009, is by Bente Zaber. She states that she had never heard of the "Ian Adam Song Studio" before reading the applicant's evidence. She states that Ms Hughes did not have a formal business relationship with Mr Adam, merely standing in for him on occasion. She states that she worked very closely with Mr Adam claiming to have been his assistant from 1985. She states:

"6. To honour Ian Adam and all his exceptional work with many famous s well as beginner pupils and totally unknown pupils all over the world. I would very much like to prevent Cath. Hughes succeeding in what seems to me a degrading struggle in an attempt to take

the monopoly of his name. Nobody should have the right to obtain a trademark on “Ian Adam” after his death.”

23) Lastly, Ms Zaber states that Mr Adam was unaware that Mr Patterson was staying in his house when he was away as Mr Adam never wanted to talk about Mr Patterson. She also states that Mr Nash stopped working for Mr Adam in the late 1990s.

24) That concludes my summary of the evidence filed.

DECISION

25) I shall first consider the ground of opposition under section 3(3)(b) which reads:

“3.(3) A trade mark shall not be registered if it is –

(a)...

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

26) There are few cases where this ground has been considered. One recent case was *Elizabeth Emanuel* case [O-017-04] where the European Court of Justice (ECJ) were asked for a preliminary ruling on the following questions:

“1. Is a trade mark of such a nature as to deceive the public and prohibited from registration under Article 3(1)(g) [Directive] in the following circumstances:

(a) the goodwill associated with the trade mark has been assigned together with the business of making the goods to which the mark relates;

(b) prior to the assignment the trade mark indicated to a significant portion of the relevant public that a particular person was involved in the design or creation of the goods in relation to which it was used;

(c) after the assignment an application was made by the assignee to register the trade mark; and

(d) at the time of the application a significant portion of the relevant public wrongly believed that use of the trade mark indicated that the particular person was still involved in the design or creation of the goods in relation to which the mark was used, and this belief was likely to affect the purchasing behaviour of that part of the public?

2. If the answer to question 1 is not unreservedly yes, what other matters must be taken into consideration in assessing whether a trade mark is of such a nature as to deceive the public and prohibited from registration under Article 3(1)(g) [Directive] and, in particular, is it relevant that the risk of deception is likely to diminish over time?

3. Is a trade mark liable to mislead the public in consequence of the use made of it by the proprietor or with his consent and so liable to revocation under Article 12(2)(b) [Directive] in the following circumstances:

(a) the registered trade mark and the goodwill associated with it have been assigned together with the business of making the goods to which the mark relates;

(b) prior to the assignment the trade mark indicated to a significant proportion of the relevant public that a particular person was involved in the design or creation of the goods in relation to which it is used;

(c) after the assignment an application was made to revoke the registered trade mark; and

(d) at the time of the application a significant portion of the relevant public wrongly believed that use of the trade mark indicated that the particular person was still involved with the design or creation of the goods in relation to which the mark was used, and this belief was likely to affect the purchasing behaviour of part of the public?

4. If the answer to question 3 is not unreservedly yes, what other matters must be taken into consideration in assessing whether a registered trade mark is liable to mislead the public in consequence of the use made of it by the proprietor or with his consent and so liable to revocation under Article 12(2)(b) and, in particular, is it relevant that the risk of deception is likely to diminish over time?

27) The ECJ's answers were reported in the decision of Professor Ruth Annand, acting as the Appointed Person, in the resumed hearing on Elizabeth Emanuel [O-317-06]:

“The first two questions

26. By its first two questions, the Appointed Person essentially seeks to ascertain the circumstances in which a trade mark may be refused registration on the ground that it is of such a nature as to deceive the public, within the meaning of Article 3(1)(g) of Directive 89/104, where the goodwill associated with that trade mark has been assigned together with the business making the goods to which the mark relates and that trade mark, which corresponds to the name of the designer and first manufacturer of those goods, was previously registered in a different graphic form.

...

43. Article 2 of Directive 89/104 contains a list, described as a list of examples in the seventh recital in the preamble to that directive, of signs which may constitute a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings, that is to say to fulfil the trade mark's function as an indicator of origin. That list expressly includes personal names (*Nichols*, paragraph 22).

44. As the Commission pointed out, for the trade mark to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish and maintain, it must offer a guarantee that all the goods or services bearing it have been manufactured or supplied under the control of a single undertaking which is responsible for their quality (see, in particular, *Arsenal Football Club*, paragraph 48).

45. A trade mark such as 'ELIZABETH EMANUEL' may have that function of distinguishing the goods manufactured by an undertaking, particularly where that trade mark has been assigned to that undertaking and the undertaking manufactures the same type of goods as those which initially bore the trade mark in question.

46. However, in the case of a trade mark corresponding to the name of a person, the public interest ground which justifies the prohibition laid down by Article 3(1)(g) of Directive 89/104 to register a trade mark which is liable to deceive the public, namely consumer protection, must raise the question of the risk of confusion which such a trade mark may engender in the mind of the average consumer, especially where the person to whose name the mark corresponds originally personified the goods bearing the mark.

47. Nevertheless, the circumstances for refusing registration referred to in Article 3(1)(g) of Directive 89/104 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (Case C-87/97 *Conorzio per la tutela del fromaggio Gorgonzola* [1999] ECR I-1301).

48. In the present case, even if the average consumer might be influenced in his act of purchasing a garment bearing the trade mark 'ELIZABETH EMANUEL' by imagining that the appellant in the main proceedings was involved in the design of that garment, the characteristics and the qualities of that garment remain guaranteed by the undertaking which owns the trade mark.

49. Consequently, the name Elizabeth Emanuel cannot be regarded in itself as being of such a nature as to deceive the public as to the nature, quality or geographical origin of the product it designates.

50. On the other hand, it would be for the national court to determine whether or not, in the presentation of the trade mark 'ELIZABETH EMANUEL' there is an intention on the part of the undertaking which lodged the application to register that mark to make the consumer believe that Ms Emanuel is still the designer of the goods bearing the mark or that she is involved in their design. In that case there would be conduct which might be held to be fraudulent but which could not be analysed as deception for the purposes of Article 3 of Directive 89/104 and which, for that reason, would not affect the trade mark itself and, consequently, its prospects of being registered.

51. Consequently the answer to the first two questions must be that a trade mark corresponding to the name of the designer and first manufacturer of the goods bearing that mark may not, by reason of that particular feature alone, be refused registration on the ground that it would deceive the public, within the meaning of Article 3(1)(g) of Directive

89/104, in particular where the goodwill associated with that trade mark, previously registered in a different graphic form, has been assigned together with the business making the goods to which the mark relates.

The last two questions

52. By its last two questions, the Appointed Person essentially seeks to ascertain the circumstances in which a trade mark is liable to revocation on the ground that that mark would mislead the public, within the meaning of Article 12(2)(b) of Directive 89/104, where the goodwill associated with that mark has been assigned together with the business making the goods to which the mark relates and that trade mark corresponds to the name of the designer and first manufacturer of those goods.

53. Since the conditions for revocation laid down by Article 12(2)(b) of Directive 89/104 are the same as those for the refusal of registration under Article 3(1)(g) of that directive, analysis of which has formed the subject of the reply to the first two questions, the reply to the last two questions must be that a trade mark corresponding to the name of the designer and first manufacturer of the goods bearing that mark is not, by reason of that particular feature alone, liable to revocation on the ground that the mark would mislead the public, within the meaning of Article 12(2)(b) of Directive 89/104, in particular where the goodwill associated with that mark has been assigned together with the business making the goods to which the mark relates.”

28) I also take into account the comments of Professor Annand in this case (O-317-06) where she said:

“20. As Mr. Hacon remarked the ECJ’s findings must be read together. There is a danger in taking general statements like the one Mr. Hill relies on out of context (*O2 Holdings Limited v. Hutchison 3G Limited* [2006] EWHC 534 (Ch), Lewison J. at para. 145). Adopting that approach (and not intending to substitute my own wording for that of the ECJ):

(a) First, the ECJ confirms its earlier ruling in Case C-404/02 *Nichols* [2004] ECR I-8499 that personal names can constitute trade marks within the meaning of article 2 of the Directive; paragraph 43.

(b) Second, the ECJ states the function of a trade mark to act as a guarantee that all products bearing it have been manufactured or supplied under the control of a single undertaking, which is responsible for their quality (Case C-206/01 *Arsenal Football Club* [2002] ECR I- 10273); paragraph 44.

(c) Third, the ECJ makes clear that ELIZABETH EMANUEL can have that function particularly when it has been assigned and the assignee manufactures the same type of goods as those which initially bore the mark; paragraph 45.

(d) Fourth, the ECJ observes that sight must not be lost of the public interest ground behind article 3(1)(g) namely, consumer protection. A trade mark comprising a personal name, raises the question of the risk of confusion which such a mark may engender in the mind of the average consumer especially where the person to whose name the mark corresponds originally personified the goods bearing the mark; paragraph 46.

(e) Fifth, the ECJ reminds itself by reference to *Gorgonzola* that “deceive” in article 3(1)(g) means actual deceit or a sufficiently serious risk that the consumer will be deceived; paragraph 47.

(f) Sixth, the ECJ holds that even if the consumer buys an ELIZABETH EMANUEL garment in the mistaken belief that Ms. Emanuel was involved in the design of that garment, the characteristics and qualities of the garment remain guaranteed by the undertaking, which owns the trade mark, i.e., the function of the mark is undisturbed. Accordingly, the designation Elizabeth Emanuel is not *per se* deceptive as to the nature, quality or geographical origin of the goods in respect of which it is used; paragraphs 48 and 49.

(g) Seventh, the ECJ raises the issue of fraudulent conduct, which the national tribunal might find to exist where the applicant for registration in its presentation of ELIZABETH EMANUEL (i.e., sales strategy) intends to make the public believe that Ms. Emanuel is still the designer of the goods bearing the mark or that she is involved in their design. Again the mark *per se* is unaffected. Registration is not precluded under article 3(1)(g) because there is no relevant deceit; paragraph 50

(h) Eighth, the ECJ clarifies that it makes no difference to the Court’s findings that the mark was previously registered in a different graphic form; paragraph 51.

(i) Ninth, the ECJ applies the same reasoning to article 12(2)(b) of the Directive. A registered trade mark is not liable to revocation on the ground that it would mislead the public within the meaning of article 12(2)(b) by reason of the fact that: (a) the mark corresponds to the name of the designer and first manufacturer of the goods bearing the mark; and (b) the goodwill associated with the mark is assigned together with the business making the goods to which the mark relates; paragraphs 52 and 53.

21. Mr. Hill fastens on the ECJ’s employment of the word “imagining” at paragraph 48. He submits that the ECJ had in mind something less than actual deceit or a sufficiently serious risk that the consumer would be deceived when ruling that a mark like ELIZABETH EMANUEL did not fall foul of article 3(1)(g) of the Directive particularly following assignment. Likewise, Mr. Hill says that Mr. Kitchin addressed himself to mere confusion rather than deception in arriving at his interim findings. I am unable to accept Mr. Hill’s submissions, which, inter alia, fly in the face of the wording of the provisions under consideration. Mr. Kitchin’s interim findings, his statement of the competing public interest considerations and the terminology of his questions to the ECJ all make clear that the reference for a preliminary ruling was predicated on deception, i.e., that a significant portion of the relevant public bought ELIZABETH EMANUEL garments in the false

belief that Ms. Emanuel was still involved in their design and/or creation (see, the recent discussion in *Phones-4U Ltd v. Phone-4u.co.uk Internet Ltd* [2006] EWCA Civ 244, Jacob L.J., at paras. 16 – 19). Moreover, it is equally clear that the ECJ’s judgment proceeded on the same basis; see, for example, paragraphs 10, 13, 27 and 28, 48 and 50.

22. Mr. Hill’s second argument is that the ECJ’s decision is inapplicable. That is because the ECJ assumes that “Elizabeth Emanuel” is a trade mark whereas, in Mr. Hill’s submission, a significant portion of relevant consumers, especially in relation to bridal wear and outer garments, will take it merely as a reference to the designer and/or head of quality control. In other words, “Elizabeth Emanuel” is purely descriptive. Mr. Hacon responded that no objection to the registration of ELIZABETH EMANUEL had been raised under section 3(1)(c) of the TMA (art. 3(1)(c) Directive).

23. It is well recognised that a trade mark can convey a descriptive or promotional message as well as being indicative of origin (*Case C-64/02, OHIM v. Erpo Möbelwerk GmbH (DAS PRINZIP DER BEQUEMLICHKEIT)* [2005] ETMR 731). Mr. Hill was unable to point me to any example in the evidence of a customer perceiving “Elizabeth Emanuel” in relation to garments solely as a descriptor and not also as an indication of origin. In fact, I fail to see how Mr. Hill’s second argument assists him further. If he is arguing that the descriptive perception of ELIZABETH EMANUEL is no longer true and therefore deceptive, he is back to his main submission.”

29) Ms Szell contends that the *Elizabeth Emanuel* case is not on all fours with the instant case as in that case the goodwill and rights had been assigned, whereas in the instant case she states there was no such assignment or business relationship. I accept that in the instant case the mark was never registered by Mr Adam and that there had been no assignment. However, the principles outlined in the above case do have a bearing even if they have to be carefully utilised and not taken out of context as Professor Annand cautions.

30) In their Skeleton argument the opponents contend that:

“1. The Opponents claim that the application should be refused under this section in that the mark is of such a nature as to deceive the public as to the nature and origin of the services. Due to the reputation of IA[Ian Adam], the consumer would assume that services provided under the mark applied for would be approved either by IA himself or his estate and would be in accordance with the techniques and philosophy developed by IA.”

.....

“8. In the present case, the goodwill surrounding the name IAN ADAM when used in relation to vocal coaching was personal to IA. No part of it belonged to or passed to the Applicant at any time. There was no assignment or transfer of IA’s business to the Applicant. Moreover, the Applicant did not use the same teaching style and techniques as

IA. In no way, therefore, can the name IAN ADAM, in the hands of the Applicant, guarantee the characteristics and qualities of the services offered under them.

9. IA was well known to the relevant public as at the date of application for this registration. Use of the mark by the Applicant is not authorised by IA or his estate and the Applicant does not employ IA's teaching method."

31) I am willing to accept that, amongst the show business community, Ian Adam had a reputation as a voice coach. The opponents state that this public would expect the teaching offered under the mark IAN ADAM to come from the man himself or be approved by him or his estate. Firstly, given his prominence and the number of obituaries written upon his death and also the gala concert in honour of his life, I doubt if many of the relevant consumers are unaware of his death. I also note that for thirty odd years the applicant stood in for Mr Adam when business took him out of the country. The applicant may have been only one of three or four who acted as stand-ins but to my mind this would signify that the applicant, and her teaching method, was approved by Mr Adam. Whilst it was put to me at the hearing that Mr Adam was not a business person, and that he lacked acumen, I cannot believe that someone who is pictured by all witnesses as being passionate about his craft would be willing to have his pupils taught by someone who he did not believe was capable, or who he thought used inappropriate techniques. By leaving the applicant to deal with his pupils he was explicitly approving of the applicant's teaching. As such, in a minor part, some of the goodwill in his business belonged to the stand-ins he used, which would include the applicant. It was stated in the evidence and frequently at the hearing that the applicant does not use Ian Adam's techniques or teaching methods. It was pointed out that this accusation had been made in written statements and not countered by the applicant. I accept that the applicant did not address this point in her evidence directly by stating that she does/does not use the same techniques as Mr Adam. However, the evidence, of Mr Patterson, shows that the applicant was working as a stand-in from the seventies. It was not contained in a witness statement but there is no reason to believe that he was lying and the opponents chose not to challenge the dates. Another letter attached to the applicant's statement, from a Mr Nash, states that as a pianist working for Mr Adam he saw the applicant standing in for Mr Adam for between six and twenty four weeks a year during the period 1991-2007. The only challenge to this evidence is the length of time that Mr Nash worked for Mr Adam, the opponents claim his employment ended in 2001 not 2007. Nor did they seek to cross examine the applicant who states in her witness statement that she began working with Mr Adam in London in early 1970.

32) I am aware that Mr Nash's evidence was not in the form of a witness statement and as such is strictly hearsay. However, he is independent of the parties involved in the case and he has no reason to misrepresent matters.

33) The applicant clearly did use some of Ian Adam's techniques and methods as the comments of the television presenter Clive James at exhibit EC2 (paragraph 5 above) testify. To my mind it is inconceivable that the association would have lasted if Mr Adam had not approved of the teaching techniques used by the applicant. Having taken all of the evidence and submissions into

account it is my opinion that the registration of the mark in suit would not offend against Section 3(3)(b).

34) I next turn to the ground of opposition under Section 3(6) which reads:

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

35) Section 3(6) has its origins in Article 3(2)(d) of the Directive, the Act which implements Council Directive No. 89/104/EEC of 21 December 1988 which states:

“Any Member State may provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that....

(c) the application for registration of the trade mark was made in bad faith by the applicant.”

36) The Privy Council considered earlier authorities in *Barlow Clowes International Ltd (in liquidation) & Others v Eurotrust International Limited & Others*, [2005] UKPC 37. In particular, their Lordships considered a submission from Counsel that an inquiry into the defendant’s views about standards of honesty is required. The following passage from Lord Hoffman’s judgment sets out the position as follows:-

“14...[Counsel for the defendant] relied upon a statement by Lord Hutton in *Twinsectra Ltd v Yardley* [2002] 2 AC 164, 174, with which the majority of their Lordships agreed:

“35. There is, in my opinion, a further consideration which supports the view that for liability as an accessory to arise the defendant must himself appreciate that what he was doing was dishonest by the standards of honest and reasonable men. A finding by a judge that a defendant has been dishonest is a grave finding, and it is particularly grave against a professional man, such as a solicitor. Notwithstanding that the issue arises in equity law and not in a criminal context, I think that it would be less than just for the law to permit a finding that a defendant had been ‘dishonest’ in assisting in a breach of trust where he knew of the facts which created the trust and its breach but had not been aware that what he was doing would be regarded by honest men as being dishonest.

“36. I consider that the courts should continue to apply that test and that your Lordships should state that dishonesty requires knowledge by the defendant that what he was doing would be regarded as dishonest by honest people, although he should not escape a finding of dishonesty because he set his own standards of honesty and does not regard as dishonest what he knows would offend the normally accepted standards of honest conduct.”

15. Their Lordships accept that there is an element of ambiguity in these remarks which may have encouraged a belief, expressed in some academic writing, that *Twinsectra* had

departed from the law as previously understood and invited inquiry not merely into the defendant's mental state about the nature of the transaction in which he was participating but also into his views about generally acceptable standards of honesty. But they do not consider that this is what Lord Hutton meant. The reference to "what he knows would offend normally accepted standards of honest conduct" meant only that his knowledge of the transaction had to be such as to render his participation contrary to normally acceptable standards of honest conduct. It did not require that he should have had reflections about what those normally acceptable standards were.

16. Similarly in the speech of Lord Hoffmann, the statement (in paragraph 20) that a dishonest state of mind meant "consciousness that one is transgressing ordinary standards of honest behaviour" was in their Lordships' view, intended to require consciousness of those elements of the transaction which make participation transgress ordinary standards of honest behaviour. It did not also require him to have thought about those standards were."

37) On the basis of these authorities it is clear that a finding of bad faith may be made in circumstances which do not involve actual dishonesty. Furthermore, it is not necessary for me to reach a view on Ms Hughes' state of mind regarding the transaction if I am satisfied that her action in applying for the mark in the light of all the surrounding circumstances would have been considered contrary to normally accepted standards of honest conduct.

38) In *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ETMR 56 the ECJ said:

"It is also apparent from that provision that the relevant time for determining whether there as bad faith on the part of the applicant is the time of filing the application for registration."

I must therefore consider the position at the date that Ms Hughes applied to register the trade mark i.e. 4 August 2007.

39) I also take into account the comments in Kerly's *Law of Trade Marks and Trade Names* (Fourteenth Edition) which states at 8-295:

"Some people become well-known to the public because they are the source of products which are sold on an extensive scale and are popular – pop musicians are a prime example. Others, such as sports personalities or entertainers, become famous because of what they do – but what they do does not normally involve the provision of any product or service, other than to the very limited extent of providing entertainment. Generally, therefore, only a relatively small proportion of "famous people" have become so because their name or image indicated the trade origin of products or services. For those that have, one would expect appropriate trade marks to have been registered in the normal way. Where trade mark protection is lacking, such persons may be vulnerable to their trade marks being "hi-jacked" but that is not a problem which is confined to well-known persons and bad faith may be established on the normal principles discussed above."

40) I was also referred to the Trade Mark Registry's Work Manual which, under the heading "FAMOUS NAMES" states:

"6. Section 3(6) – Bad Faith

Where third parties apply to register the name of a famous individual or a recently deceased famous individual an objection under section 3(6) of the Act may be appropriate. However, this will depend upon whether the application covers goods and/or services with which the famous individual is associated. For example, an application to register the name of a famous fashion model for "clothing" or "cosmetics" would be liable to an objection because it is an obvious attempt to take unfair advantage of the person's reputation. Conversely, an application to register a name [which corresponded to that] of a famous fashion model for "agricultural machinery" would not, prima facie, be liable to a bad faith objection. However, the application may still be successfully opposed, under section 5(4)(a) of the Act, if it can be proven that use of the mark could be restrained under the law of passing off.

Care should however 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. Applications to register the names of famous musical groups will not normally at the examination stage face an objection. This is because to firmly establish who are the rightful owners of the names of musical groups often requires evidence and is therefore best left to be determined in opposition proceedings. Bad faith objections can be overcome if permission to the registration of the mark is obtained from the individual or his/her legal representative."

41) The opponents also pointed out at paragraph 11 of their skeleton argument:

"11. The issue of "bad faith" in the filing of a trade mark application was considered by the ECJ in its recent answer to questions in the case of *Chocoladefabriken Lindt & Sprungli AG v. Franz Hauswirth GmbH* (Case C529/07). The facts of that case were very different to this one so it is of only limited assistance. However, the ECJ did note that, in order to determine whether there was bad faith, consideration must be given to the Applicant's intention at the time of filing. The Applicant's intention is a subjective factor which must be determined by reference to the objective circumstances of the particular case."

42) The opponents contend:

"13. In this case, it is difficult to see what other reason the Applicant could have had for filing the application other than to trade off the reputation of IA and prevent others using the name IAN ADAM to refer to their work. The Applicant, herself, has offered no

explanation. Her claim to have run a business together with IA called “Ian Adam Song Studio” is clearly false. Her claim to be IA’s next of kin and any claim she may thereby make to have inherited any of IA’s business assets is clearly false.

14. The evidence shows that the Applicant spent some time at IA’s residence after his death and the fact that the application was filed using the address of IA’s residence indicates that the Applicant had, or was trying to obtain, at the date of application, some connection or right to reside in IA’s old residence. This merely supports the view that the Applicant intended to trade off IA’s reputation as she cannot have had the right to reside in IA’s old residence from IA himself. The evidence clearly shows that no right to reside in the residence survived IA’s death.

15. The making up of a stamp giving the name “Ian Adam Song Studio” which was not used by IA or during his lifetime also indicates an intention to trade off IA’s reputation.

16. The circumstances point, therefore, to an intention to trade off IA’s reputation of which the application to register the name IAN ADAM forms a part. As stated in the Trade Mark Registry’s Work Manual: under the heading “FAMOUS NAMES” and subheading “6 Section 3(6) Bad Faith”. “Where third parties apply to register the name of a famous individual or a recently deceased famous individual an objection under section 3(6) of the Act may be appropriate”. The Manual then goes on to give an example of an “obvious attempt” to take unfair advantage of a person’s reputation which is directly analogous to the situation with this application.”

43) I do not understand the accusations that the applicant has falsely claimed to have been the next of kin, inherited business assets and by living at the property previously occupied by Mr Adam was trying to obtain a connection with Mr Adam. Firstly, in her statement the applicant merely stated that she was named as Mr Adam’s next of kin when he went into hospital and this was backed up by documentation. This, in my opinion, was put forward to make the case that she was a close confidant of Mr Adam, as one does not chose a mere acquaintance as your nominated next of kin when going into hospital. As to the issue of inheriting business assets and living at the address once occupied by Mr Adam, this has to be viewed in context. By the opponents own evidence, Ms Hughes was asked to sort out the affairs of Mr Adam, despite the fact that he lived in London and she lived in Scotland. Inevitably, the premises which Mr Adam

occupied at the time of his death contained numerous possessions although the property was in fact rented. Ms Hughes would have required somewhere to live in London whilst sorting the affairs of Mr Adam. In renting the same premises it solved the issue of storage of goods whilst they were disposed of, and allowed her to continue to earn her living as a voice coach as the premises had a studio which she had worked in for decades, and which was familiar to the clients who would have probably been used to her teaching during the occasions when she had covered for Mr Adam. In passing I note that the opponents do not dispute that that Ms Hughes also contributed to the funeral expenses as well as assisting in its' planning.

44) The main thrust of the opposition seems to be the contention that the applicant is seeking to "trade off" the reputation of Mr Adam. I have commented previously in this decision that by acting as a stand in for over thirty years then the applicant would be closely linked by the average consumer with Mr Adam and his reputation. This is confirmed by the views of Clive James. The opponents allege that the applicant was simply one of many who stood in for Mr Adam and seek to imply that she was some way down the pecking order in those he asked to stand in for him. However, none of the other coaches were actually identified or gave evidence as to how often they stood in for Mr Adam. There is evidence that Ms Hughes regularly took on this role for weeks at a time and on a number of occasions a year. It has been alleged that in the last two years she had not undertaken such a role, although there is no evidence of Mr Adam requiring a stand-in. I also note that the applicant is the only other voice coach mentioned in the obituaries printed following the death of Mr Adam.

45) It was contended that Mr Adam was "famous" and so his name should be protected as set out in paragraphs 39 and 40 above. Whilst I accept that Mr Adam had a reputation as a voice coach, I would hesitate to state that he would be regarded as being famous. However, even if I am incorrect in this the instant case does not infringe the principles set out in those paragraphs. This is not an instance of someone unknown to the person who has just died seeking to cash in on their name, such as was seen when Princess Diana, Elvis Presley or Michael Jackson died. In the instant case the application was filed by a person who had frequently stood in for Mr Adam, teaching his pupils on his behalf and indeed recruiting new pupils who were then passed over to Mr Adam on his return. This business relationship lasted for over thirty years. This is not an instance of an opportunist seeking to cash in on the demise of someone they did not know or had never even met, this was someone who was regarded by the consumers as being a business partner, albeit not in the strict legal sense, and close confident of Mr Adam.

46) With regard to the stamp which had the words "Kate Hughes, Ian Adam Song Studio, 15 Ovingdon St" and was said by the applicant to have been used to stamp receipts for clients of the song studio, it has been alleged that this is a falsehood and that Mr Adam never used such a stamp and that the studio was not called the Ian Adam Song Studio. Having very carefully read the evidence it is clear to me that the applicant did not make such a claim. Read in context it seems to me to be stated that this was used by her when she stood in for Mr Adam, why else does it have her name first? It undoubtedly associates her with Mr Adam, but she was already associated with him and had been for many years. I see no reason why any of those who were involved with the finances of Mr Adam would ever have seen receipts with this stamp on them as the stamp would only have been used by Ms Hughes when she was standing in for Mr Adam

and working from his studio. The witness statement was written in a manner that might lead one to leap to injudicious assumptions, but there was, in my view, no falsehood perpetrated.

47) Taking all of the issues into account I find that the application was not made in bad faith. The opposition based upon section 3(6) fails.

COSTS

48) It is unfortunate that this case has generated such personal rancour between a group of individuals who, whilst not close friends, shared a common bond and at one stage, shortly after the death of Mr Adam came together to sort out his affairs.

49) As the applicant has been successful it is entitled to a contribution towards its costs. In making the award I take into account the fact that the opponents filed a great deal of evidence as to the reputation of Mr Adam and Ms Zaber in Scandinavia which had no bearing upon my decision. I order the opponents to pay the applicant the sum of £3,600 (breakdown shown below). This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Preparing a statement and considering the other side's statement	400
Preparing evidence and considering and commenting on the other side's evidence	1000
Preparing for and attending the hearing	2000
Expenses	200
TOTAL	3600

Dated this 14 day of January 2010

**G W Salthouse
For the Registrar
The Comptroller-General**