BL O/0379/23

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 425603

IN THE NAME OF GRAHAM BONNET

TO

TRADE MARK APPLICATION No. 3597907

IN THE NAMES OF DANIEL RICHARD MERTON, JAMES RICHARD WALDO AND GILES ROGER LAVERY

DECISION

1. Graham Bonnet ("the Opponent") appeals against the rejection by the Registrar of Trade Marks of his Opposition filed under number 425603 on 27 May 2021 to Trade Mark Application number 3597907 filed by Daniel Richard Merton, James Richard Waldo and Giles Roger Lavery ("the Applicants") on 19 February 2021.

2. The Opposition was rejected for the reasons given by Ms Rosie Le Breton in a Decision issued on behalf of the Registrar under reference BL O/642/22 on 28 July 2022. She ordered the Opponent to pay £1,450. to the Applicants by way of contribution to their costs of the proceedings in the Registry.

3. The Applicants sought by means of the contested application to register **ALCATRAZZ** and **Alcatrazz** as a series of 2 trade marks for use in relation to the following goods in Class 9:

> Compact discs; Video compact discs; Recorded compact discs; Audio compact discs; Prerecorded music compact discs; Pre-recorded compact discs; Discs (Compact -) [audio-video]; Compact discs [audio-video]; Compact discs featuring music; Prerecorded compact discs featuring music; Pre-recorded video compact discs; DVD discs; Audio discs; Discs (Optical -); Disc records; Video discs; Holographic discs; Laser discs; Sound discs; Recording discs; Optical discs; Digital versatile discs; Digital video discs; Optical disc recordings; Pre-recorded discs; Laser-readable discs; Audio digital discs; Digital video discs [DVDs]; Optical discs featuring music; Recorded discs bearing images; Pre-recorded laser discs; Records [sound recordings]; Pre-recorded phonograph records; Musical recordings; Video recordings; LP records; Phonographic records; Recorded films; Recorded media; Phonograph records; Music recordings; Audiovisual recordings; Recorded film; Digital recordings; Vinyl records; Magnetic recordings; Audio recordings; Sound recordings; Recorded tapes; Sound records; Recorded content; Recorded tape cassettes; Pre-recorded cassettes; Pre-recorded DVDs; Pre-recorded CDs; Recorded video tapes; Audio visual recordings; Musical sound recordings; Downloadable video recordings; Multi-media recordings; Musical video recordings; Pre-recorded videos; Pre-recorded films; Downloadable sound recordings; Downloadable digital music; Digital audio tapes; Audio digital tapes; Digital music downloadable provided from MP3 internet websites; Downloadable digital music provided from MP3 Internet web sites; Digital music downloadable provided from MP3 internet web sites; Digital music [downloadable] provided from mp3 web sites on the internet.

4. The Opponent objected to the application for registration under s.5(4)(a) of the Trade Marks Act 1994 on the basis that he was at the relevant date (19 February 2021) entitled by virtue of the law of passing off to prevent the Applicants from using the trade marks **ALCATRAZZ** / **Alcatrazz** in the United Kingdom for Class 9 goods of the kind listed in the opposed application for registration.

5. His claim to an earlier right was raised for determination with reference to the following figurative mark:

on the basis pleaded in his Form TM7 Notice and Grounds of Opposition in the following terms:

> The above mark confers on Graham, as its beneficiary, the right to prohibit the use. Graham holds rights in the above mark due to his heavy involvement and creation of the band since 1983 as the main singer and front man. The right to the above mark was also acquired prior to the date of opposed UK application — passing off can be satisfied: **1**. Goodwill in the UK is demonstrated: products and services (including but not limited to music, recordings, advertisements, merchandise) containing the mark are known to the UK public as being a product of the band, Alcatrazz, when led by Graham. **2**. Misrepresentation is demonstrated: due to Alcatrazz being shaped by Graham's involvement as the lead singer (notably also highlighting Graham Bonnet as the lead singer in tours and concerts), through using the mark for music without Graham in the band, the mark can mislead the UK public to believe they are buying products or services from Graham. **3**. Potential damage is demonstrated: through use of the mark by the applicant, reputational damage can be caused to Graham due to the Alcatrazz name and logo being used on products and services not created by him.

6. The Applicants pleaded as follows in their Form TM 8 Defence and Counterstatement:

3. The Applicants comprise one of the original and current members of the band Alcatrazz, James Richard Waldo, the band manager Giles Roger Lavery, and the UK business partner for the band's affairs. This is with the agreement of the band members, including Gary Shea who is also a founding and continuing member of the band.

4. The band was formed in 1983 consisting of the Opponent, Gary Shea and Jimmy Waldo. The Opponent was the vocalist only. Most of the song writing was undertaken by the guitarists in collaboration with keyboard player James Waldo. The band went through various other members, and then dissolved in 1987.

5. The Opponent decided in 2007, without discussion with the other band members, to tour as "Alcatrazz featuring Graham Bonnet" suggesting that he was touring alongside Alcatrazz, but instead hired musicians who were not part of the original band. This resulted in a cease and desist letter being sent to the Opponent.

6. In 2020 the Opponent and James Waldo of the Applicants along with Gary Shea reunited as Alcatrazz and released an album with Silver Lining Music. As Silver Lining Music were aware of the Opponents previous unauthorised use of the band name, and not wanting a repeat issue creating confusion in the marketplace, required the band management to sign to confirm that the individual band members could not record or perform as Alcatrazz on their own. Compliance with these obligations was agreed to in an Inducement Letter signed by all the members of the band including the Opponent. Following the departure of the Opponent from the band, the record label recognises the current band line up only as being the official Alcatrazz band.

7. The Applicants are the owners of a number of trade mark registrations and applications, both in the UK, EU, Japan and USA, for the name ALCATRAZZ, and for the logo in which the Opponent claims rights, none of which have ever been the subject of a challenge by the Opponent. It is considered that the Opponents present Opposition is purely to disrupt the Applicant's current recording contract.

8. The name and logo of the Alcatrazz band was devised by bass player Gary Shea, who is the owner of the copyright in the logo in which the Opponent claims passing off rights. Gary Shea remains with the band, has played on every Alcatrazz album and has missed only one tour since the band was formed in 1983. He has authorised the band to use the name and logo, and has

> authorised the current Applicants to apply for trade marks for the band name and logo.
>
> 9. It is in summary denied that the Application would be contrary to Section 5(4)(a) of the Act. It is further contested that the Opponent has any claim to rights in the name Alcatrazz or the logo format included in the Statement of Grounds to this Opposition in relation to the band of the same name.

7. The UK trade mark registration referred to in para. 7 of the Counterstatement was Trade Mark No. 3557956 registered in the names of Giles Roger Lavery and James Richard Waldo on 16 April 2021 with effect from 19 November 2020 (see Exhibit GL5 to the Witness Statement of Giles Lavery dated 21 December 2021). This protected **ALCATRAZZ** and **Alcatrazz** as a series of 2 trade marks for use in relation to the following services in Class 41:

> Music performances; Music recording; Musical performances; Musical entertainment; Live band performances; Live entertainment; Live music performances; Live musical performances; Live performances by a musical band; Live performances by rock groups; Recording of music.

8. The Opponent did not oppose and has not subsequently applied to invalidate that registration. The registration of **ALCATRAZZ** / **Alcatrazz** in Class 41 in the names of Giles Lavery and James Waldo was and continues to be prima facie evidence of the validity of the original registration: s.72 of the 1994 Act. It was not open to the Opponent in the present Opposition proceedings to deny the validity of their registration as proprietors of the trade marks **ALCATRAZZ** and **Alcatrazz** under number 3557056 in Class 41 as of 19 November 2020.

9. That was a complicating factor in the assessment of the Opponent's objection under s.5(4)(a) of the Act:

(i) His objection (set out in para. [5] above) expressly set up his past involvement in the commercialisation of live and recorded performances under and by reference to the name and mark **ALCATRAZZ** as the basis for his claimed earlier right by virtue of the law of passing off to prevent others, including the Applicants, from using that name and mark for interrelated goods of the kind listed in para. [3] above.

(ii) This presupposed that at the relevant date (19 February 2021) he held an extant and enforceable earlier right, built up and acquired through use of the name and mark **ALCATRAZZ** in relation to live and recorded performances within the area of trading activity over which two of the three Applicants by then held an unchallenged trade mark registration in Class 41 entitling them from an earlier date (19 November 2020) to prevent others, including the Opponent, from providing live and recorded performances under and by reference to that name and mark without their consent.

10. Further complications arose when the parties opted for the Opposition to be determined on the basis of the papers on file without recourse to a hearing. At that point they began to suggest and imply in their written submissions that the various different individuals who had in the period 1983 to 2021 performed and recorded together under and by reference to the name and mark **ALCATRAZZ** ought to be regarded as having done so in the course of successively carrying on business in partnership with one another.

11. Neither side had pleaded any case to that effect. Neither side had filed any evidence directed to proving that any partnership agreements or arrangements were made or implemented between or among the individuals from time to time involved in

performing and recording as **ALCATRAZZ** during that period. There was a complete absence of any income and expenditure statements and accounts relating to the performing and recording activities of any of the individuals concerned. The evidence on file indicated that they had not at any relevant time been ordinarily resident in the United Kingdom. There was nothing in the evidence filed to explain why, if any partnership agreements or arrangements had at any relevant time been made or implemented, they should be taken to have been made or implemented subject to the Partnership Act 1890.

12. All of which had a limiting effect on the Registrar's ability to determine the Opponent's pleaded objection to registration under s. 5(4)(a) of the Act from the perspective of the "*Facts agreed on*" and "*Facts in dispute*" identified in para. [26] of the Hearing Officer's Decision (footnotes omitted):

> 26. Before proceeding with my analysis of the evidence keeping in mind the principles and the case law above, I consider the facts that have been agreed on by both parties in these proceedings, in addition to the facts that remain in dispute. These are as follows:
>
> Facts agreed on:
>
> - A band named 'Alcatrazz' was formed in 1983, with the three original members of that band being Mr Bonnet (the opponent), Mr Waldo (one of the joint applicants) and Mr Shea.
> - The band dissolved in 1987.
> - The opponent, Mr Bonnet made some attempt to tour using the name Alcatrazz (as 'Graham Bonnet's Alcatrazz' according to Mr Bonnet, and as 'Alcatrazz featuring Graham Bonnet' according to Mr Waldo) in 2007.
> - Mr Bonnet and others also toured to some extent under a sign including 'Alcatrazz' until at least 2013.
> - There was a reunion tour including the three original band members in Japan in 2017.
> - A new formulation of the band including Mr Bonnet and Mr Waldo from the original line up, in addition to three others, one being Ms Heavenstone, performed some UK tour dates in 2019 under the sign 'Alcatrazz' and the stylised mark relied upon.

- Ms Heavenstone resigned from the formation of the band above in January 2020 and was replaced by Mr Shea. All three original members of the band Alcatrazz were therefore reunited alongside two further band members in 2020 and gained a record deal and released an album that year with Silver Lining.
- Mr Lavery was the band's manager or agent at the time of signing of the deal.
- Mr Lavery sent a resignation email to Mr Bonnet in June 2020.
- Mr Bonnet was no longer part of the band as of Autumn 2020

Facts in Dispute

- The level of involvement each band member had in the original band and the extent of the use of the sign by Mr Bonnet up until the reforming of the band in 2019 and again in 2020.
- The nature of Mr Lavery's resignation (whether or not this was solely in relation to his position as Mr Bonnet's personal manager).
- Whether Mr Bonnet left the band on his own accord and/or wanted no further involvement in the same, whether the other band members resigned, or whether there was a mutual agreement in November 2020 that the band would no longer perform together under Alcatrazz.
- Whether the Licence Agreement signed by Mr Lavery when securing the band's record deal in March 2020 is binding on the opponent,

13. To all intents and purposes, the individuals who performed and recorded together as **ALCATRAZZ** during and after 2017 did so in line of succession to those who had done so before 2017. That gave them *de facto* possession and control of the goodwill and reputation built up and acquired since 1983 in the business of delivering live and recorded performances for commercialisation under and by reference to the name and mark **ALCATRAZZ**.

14. On orthodox principles, it stood to be presumed in the absence of evidence to the contrary that this came about lawfully: (i) the goodwill of a business carried on in the United Kingdom falls to be regarded as an asset territorially situated in the United Kingdom: Starbucks (HK) Ltd v British Sky Broadcasting Group Plc [2015] UKSC 31 at paras. [55] to [60] per Lord Neuberger PSC (with whom Lords Sumption, Carnwath,

Toulson and Hodge JJSC agreed); (ii) no legal formalities are required in order to implement a transfer of the goodwill of a business carried on in the United Kingdom, a *de facto* transfer brings about a succession as and when it is implemented: see Green Smile Ltd v HMRC [2023] UKFTT 15 (TC) at paras [41], [53], [57] to [74] and the case law cited.

15. Succession — when it occurs — is normally recognised in line with the approach to continuing protection of unregistered trade marks and trading names indicated by the House of Lords in Leather Cloth Co. v American Leather Cloth Co. (1865) 11 H.L.C. 523. Lord Cranworth observed at p. 534 with reference to the situation in which an unregistered trade mark consists of the name of a manufacturer of goods:

> When he dies, those who succeed him (grandchildren or married daughters, for instance), though they may not bear the same name, yet ordinarily continue to use the original name as a trade mark, and they would be protected against any infringement of the exclusive right to that mark. They would be so protected, because according to the usages of trade, they would be understood as meaning nothing more by the use of their grandfather's or father's name, than that they were carrying on the manufacture formerly carried on by him. Nor would the case be necessarily different if, instead of passing into other hands by devolution of law, the manufactory were sold and assigned to a purchaser.

and Lord Kingsdown similarly observed at pp. 542, 543:

> …by the usage of trade, the name of a firm is understood not to be confined to those who first adopted it, but to extend to and include persons who have afterwards been introduced as partners, or persons to whom the original partners have transferred their business. The name of the firm continues to be used in many cases long after all the original traders have died or ceased to have any interest in the concern … the use of the old trade mark by the new partners or their successors … is only a statement that the goods are the goods of the firm whose trade mark they bear."

16. This approach can only be taken to have been broadened and strengthened by the modernising Judgment on dealings with trade mark rights delivered by Lord Nicholls of Birkenhead in Scandecor Developments AB v Scandecor Marketing AB [2001] UKHL 21 (see KUROBUTA Trade Mark BL O/590/20 (25 November 2020) at paras [42] to [45]).

17. A new milestone in the history of the band was reached in 2020. Exhibit GL2 to the Witness Statement of Giles Lavery dated 21 December 2021 is an "**Exclusive License Agreement**" that was "*Dated as of March 1st 2020*". The License Agreement set out the terms on which Mr Lavery as Licensor had agreed to license to Silver Lining Music Ltd (a company registered in England under number 10621016) "*certain rights in respect of certain audio visual recordings and audio recordings embodying the performances of the group of artists a/k/a 'Alcatrazz'…*".

18. The "**ARTIST**" was identified in Clause 1 as "*The group of artists a/k/a 'Alcatrazz' consisting of Graham Bonnett (sic), Jimmy Waldo, Joe Stump, Mark Benquechea and Gary Shea (hereinafter individually and collectively referred to as 'Artist')*." Clause 17.3 recorded that "*The Licensor warrants that the Artist will sign the inducement-letter attached to this Agreement as Schedule 2, which shall be part and basis of this Agreement. The parties agree that no advance shall be payable prior to Company's receipt of the inducement-letter signed by the Artist.*"

19. Exhibit GL3 to Mr Lavery's Witness Statement was a copy of *"***Schedule 2: Inducement Letter. Inducement Letter to the Exclusive License Agreement (hereinafter the 'License Agreement') dated as of March 1st, 2020 by and between Licensor: Giles Lavery … Licensee: Silver Lining Music Ltd … regarding the**

Artist 'Alcatrazz' …" bearing the signatures of all 5 of the named individual members of the "**Artist**". I note at this point that Daniel Merton was not identified in the evidence filed on either side as having had any involvement in the activities of **ALCATRAZZ** at any time prior to becoming one of the three Applicants for registration in the present case. In the Opponent's written submissions filed in the Registry on 10 May 2022, it was asserted that Mr Merton "… *is a guitarist who was a member of an opening band that supported Alcatrazz on a handful of tours. He never performed directly with Alcatrazz or the Graham Bonnet Band, and he worked as a so-called roadie (a person employed by a touring band to set up and maintain equipment) on those tours.*" In para. 3 of the Applicants' Counterstatement he is described as "*the UK business partner for the band's affairs.*"

20. The License Agreement and Inducement Letter were drawn up by a firm of German lawyers based in Hamburg. They were written in English and they stipulated in identical terms at Clause 17.9 and Clause 8 respectively: "*This Agreement shall be governed by German law. Exclusive place of fulfilment and place of jurisdiction is Hamburg.*" In the absence of any pleadings or evidence as to German law from either side, both documents fell to be interpreted in the present Opposition proceedings in accordance with English law as "the default rule": Lady Brownlie v FS Cairo (Nile Plaza) LLC [2021] UKSC 45 at paras [113] to [116] per Lord Leggatt JSC (with whom Lord Reed PSC and Lords Lloyd-Jones, Briggs and Burrows JJSC agreed).

21. The Hearing Officer incorrectly adopted the position in para. [43] of her Decision that *"… the question of whether the agreements are or were binding on Mr Bonnet at the relevant date is of little relevance to the decision I must make. The agreements make no reference to the transfer of ownership of any of the goodwill under Alcatrazz or the*

sign relied on. The question of whether Mr Bonnet has or has not breached the terms of the contract is separate to the question whether he holds goodwill under the sign relied upon and may bring proceedings on section 5(4)(a) of the Act in this instance. In any case, the agreements have been explicitly drafted in line with German law, and as such I am not in a position to comment on their legal effects without further information about German contract law. Whilst the agreements therefore provide useful narrative evidence in these proceedings, showing the mindset and the agreement between the band members at a particular date, they are in no way determinative in this matter."

22. Before the relevant date (19 February 2021) the name and mark **ALCATRAZZ** had been used in connection with the commercialisation of the live and recorded performances of the various individuals who at different times worked together as members of the band. The Opponent and Mr Lavery along with Mr Waldo and three more of the continuing members of the band had each in their own way and on their own timelines contributed to and been involved in those activities. They were all parties to the contractual arrangements constituted by the License Agreement and the Inducement Letter dated as of March 1st, 2020 which governed their activities in the area of the Class 9 goods in issue and created legal rights and obligations relating to the use of the marks in issue for such goods in the United Kingdom (and around the world). Mr Lavery and Mr Waldo were also at the relevant date the holders of an unchallenged UK trade mark registration protecting the marks in issue for interrelated services in Class 41.

23. There was no impediment to determining the scope and effect of the contractual arrangements by interpreting the License Agreement and Inducement Letter in accordance with English law as envisaged by "the default rule" affirmed by the

Supreme Court in Brownlie. It was clearly relevant to do so as part of the process of examining the Opponent's pleaded objection to registration under s.5(4)(a). There could at the relevant date be no objection under s.5(4)(a) to the opposed application for registration if in the events which had happened the Opponent was previously not — or had previously ceased to be — entitled by virtue of the law of passing off to prevent use in the United Kingdom of the name and mark **ALCATRAZZ** by or with the consent of the Applicants for Class 9 goods of the kind in issue: see Case C-122/21 X BV v Classic Coach Company vof EU:C:2022:428 at paras [41], [42] and [57] to [64] pointing to the conclusion that: "*In a situation where a right relied on by a third party is no longer protected under the laws of the Member State concerned, it cannot be held that that right constitutes an 'earlier right' recognised by that law …*".

24. The Inducement Letter confirmed that: "*Pursuant to an exclusive recording agreement between Licensor and the Artist (hereinafter referred to as the 'Artist Agreement'), Licensor is entitled to each of Artists exclusive services as a recording artist throughout the World for the production of master recordings (audio and audio-visual) for the manufacture, distribution and sale of records, promotional activities of any kind.*" Proceeding on that basis:

> Clause 4 provided "*that Artist will perform and discharge all the obligations and undertakings contained in the Artist Agreement insofar as the same are required of Artist to enable Licensor to perform the License Agreement.*"

Clause 5 provided "*that Artist subject to the provisions below shall look solely to the Licensor for the payment of all fees and / or royalties and Artist confirms to have no claim against Company in this regard*."

Clause 6 provided "*that (a) in the event the Artist Agreement shall cease for any reason whatsoever during the term of the License Agreement or any extensions or renewals thereof or (b) in the event Licensor shall not fulfil (or shall not be able to do so) his obligations mentioned in the License Agreement for any reasons whatsoever, then Artist shall perform and observe each and all of the terms and conditions of the Artist Agreement directly to Company to secure all outstanding obligations of Licensor with regard to the License Agreement.*"

Clause 7 provided that "*All obligations of the Artist under this Agreement shall be applicable with regard to all members of the Artist jointly and severally.*"

25. The exclusive recording agreement referred to as the "**Artist Agreement**" and the context and manner in which it had been entered into and applied to the 5 named individuals who constituted the "**ARTIST**" clearly appeared to have been relevant for the purposes of the assessment that the Registrar was called upon to make in relation to the contested application for registration of **ALCATRAZZ** for the Class 9 goods listed in para. [3] above.

26. However, neither side provided the Registrar with a copy of it or any evidence as to the context and manner of its implementation in relation to the activities of the members of the band. That again had a limiting effect on the Registrar's ability to determine the

Opponent's pleaded objection to registration under s.5(4)(a) of the Act from the perspective of the "*Facts agreed on*" and "*Facts in dispute*" identified in para. [26] of the Hearing Officer's Decision (see para. [12] above).

27. The License Agreement contained an "**EXCLUSIVITY / RECORDING RESTRICTION**" which provided in Clause 6.1 for "Personal Exclusivity" in the following terms: "*Graham Bonnet and / or the other members of the group of artists shall during the Term not perform under the name Alcatrazz (in any writing and no similar sounding names) or any name containing the name Alcatrazz (in any writing and no similar sounding names) for any person, firm or company other than Company for the purposes of making audio and / or audio visual recordings nor shall Graham Bonnet and / or any other members of the group of artists record any such recordings himself, permit any third [sic] to exploit such recordings and / or exploit such recordings himself. With respect to the release of any solo album of Graham Bonnet and / or any of the other members of the group of artists Licensor shall ensure that such release does not interfere with any release under this agreement. Therefore no such solo album or any tracks therefrom shall be released within a period of six months before or after the release of any album or any tracks therefrom hereunder.*"

28. The Opponent could not claim consistently with the "**EXCLUSIVITY / RECORDING RESTRICTION**" that during the "**TERM**" of the License Agreement he or any other of the members of the band retained any <u>independent and autonomous</u> right of their own to use or authorise others to use the name and mark **ALCATRAZZ** for Class 9 goods of the kind in issue in the present Opposition.

29. The "**TERRITORY**" of the Licence Agreement was identified in Clause 2 as: "*Initial Contract Period and First Optional Contract Period: World and Universe excluding the Excluded Territories. … Second Optional Contract Period: World and Universe.*" The Excluded Territories (which did not include the United Kingdom) were stated to be "*solely excluded because the rights to those countries are already licensed to a third party.*" Neither side provided the Registrar with any documentary or other evidence about the third party licensing arrangements for commercial exploitation of the Artist's recorded performances in those territories.

30. The "**TERM / OPTIONS**" provisions of Clause 3 operated interrelatedly with the "**PRODUCT COMMITMENT**" provisions of Clause 4. The Term of the Licence Agreement was identified in Clause 3.1 as "*the Initial Contract Period and two (2) additional Optional Contract Periods (as defined below).*" Clause 4.1 required one new studio album of at least 12 new tracks to be delivered to the Company for the Initial Contract Period "*at the latest on March 6th, 2020*". The Initial Contract Period was set to "*end with the exercise of the option for the First Optional Contract Period by Company or after expiration of the deadline for the exercise of said option by Company as set out below under sub-clause 3.2.*"

31. The deadline set out in Clause 3.2 for exercise of that option was the latest of: "*12 months after delivery by Licensor and acceptance by Company of the previous Master, or 9* months *after release of the masters to be delivered during the Initial Contract Period as specified below, or 28 days after receipt by Company of the complete demo-recording of the respective upcoming Product to be delivered as specified below.*"

32. The First Optional Contract Period was likewise set to commence with the exercise of the first option by the Company and "*end with the exercise of the option for the Second* Optional *Contract Period by Company or after expiration of the deadline for the exercise of said option by Company as set out below under sub-clause 3.2.*"

33. The Second Optional Contract Period was likewise set to commence with the exercise of the second option by the Company and "*end the later of (i) twelve (12) months after delivery and acceptance of the complete Master and Material and (ii) nine (9) months after release of the complete Master and Material (as defined below) to be delivered for such Optional Contract Period.*"

34. The Licence Agreement and Inducement Letter contained no express provisions for termination by the Licensor, the Licensee or the Artist. And the provisions of the Inducement Letter noted in para. [24] above were designed to ensure that the members of the Artist would remain jointly and severally bound to render their services as recording artists as required for the fulfilment of the obligations of the Licensor with regard to the License Agreement.

35. By the Autumn of 2020, the Opponent had ceased to participate in the implementation of the contractual arrangements put in place by the License Agreement and Inducement Letter. Serena Furlan, the Company Secretary of the Licensee, confirmed in a Witness Statement dated 28 December 2021 that "*so far as Silver Lining Music is concerned, Alcatrazz is an active performing and recording group of Artists which currently is consisting of Jimmy Waldo, Gary Shea, Joe Stump, Doogie White and Mark Benquechea.*"

36. There is no evidence of any legal action having been brought by the Opponent to prevent that from happening. Any such action would likely have been met with the response that he had no right to prevent any of the parties to the License Agreement and Inducement Letter from continuing to implement the contractual arrangements which he and they had put in place.

37. Clause 5 of the License Agreement provided the Licensee with an "**EXPLOITATION PERIOD**" which was set to expire "*90 days following December 31st of the tenth* calendar *year after the commercial release of the last Master to be delivered hereunder by Company in Germany, Austria, Switzerland ('the Exploitation Period')*" subject to the qualification that "*If the Advance(s) paid hereunder and all other recoupable amounts are not recouped at the end of the Exploitation Period, the Exploitation Period shall extend automatically until 90 days after the end of the accounting period in which the Advance(s) and all other unrecouped amounts are recouped*" and subject to the further qualification that "*A non-exclusive sell-off period of six months shall follow the expiration of the (extended) Exploitation Period.*"

38. The "**RIGHTS**" conferred upon the Licensee by Clause 9 of the License Agreement expressly included "*(e) the right to use name, approved likenesses and biography of the Artist in* connection *with the exploitation, marketing and promotion of the Masters including the exclusive right to register domains with the name of the Artist (with all extensions) within the territory; costs for the creation and maintenance of the internet-domain shall be fully recoupable and cross-collateralizable against any and all monies payable to Licensor by Company.*"

39. That was buttressed by Clause 3 of the Inducement Letter which provided that "*Artist assigns to Licensor all rights mentioned in the License Agreement with regard to all media, distribution channels and kinds of releases, with regard to promotional and advertising* use *as well as for commercial exploitation, as well as the right to assign or sub-license all rights to any third party, whether in parts or in total and that Artist agrees to the assignment of all aforesaid rights to Company.*"

40. The Opponent's pleaded objection under s.5(4)(a) was directed to the proposition that the goodwill and reputation built up and acquired through commercialisation of live and recorded performances delivered under and by reference to the name and mark **ALCATRAZZ** could not be exploited by a band of which he was not a member. Why not? Because, on his case, it would give rise to a likelihood of deception and confusion with a concomitant risk of detriment and damage to his proprietary interest in that goodwill and reputation. How so? Because, on his case, the band without him as a member would not be **ALCATRAZZ** truthfully so called according to the beliefs and expectations of consumers of live and recorded performances acquainted with the output of the band of that name. His complaint, shortly stated, was that independent and autonomous use of the name and mark **ALCATRAZZ** by the Applicants in the United Kingdom in connection with the commercialisation of Class 9 goods of the kind listed in para. [3] above would falsely implicate him in business activities he had not authorised, could not control and was not responsible for.

41. The Hearing Officer rejected his objection under s.5(4)(a) on the basis that he had no right by virtue of the law of passing off to claim a proprietary right of his own capable of enabling him to bring or proceed with it in his own name.

42. It can be seen from para. [61] of her Decision that this was the culmination of her reasoning as to the effect of applying the law of partnership to the activities of the various individuals who had at different times worked together as members of the band called **ALCATRAZZ**:

> It has been established that Mr Bonnet was entitled to a share of the goodwill in the partnership at the time that it dissolved in Autumn 2020 and that remained the position at the relevant date. However, it has not been established that he owned the goodwill himself. I note Mr Bonnet has brought these proceedings in his own name, and not in the name of, or on behalf of, the 2020 (or any previous) partnership. This appears to be founded on Mr Bonnet's belief that he owned the band's goodwill because he was the frontman, lead singer and songwriter. It is explained at paragraph 25 of *Byford v Oliver* as previously set out in this decision that in cases such as this one, that where the asset is owned by the partnership, any attempt to sue another party, whether or not those parties contain common members, must be brought in the name of, or on behalf of, the partnership. Therefore, Mr Bonnet has no right to bring passing off proceedings on the basis that he personally owns the goodwill under the sign he relies on. The result of article 2 of the Relative Grounds Order is that an opposition against a trade mark application must also be brought by the proprietor of the earlier right, which is defined in the Act as someone who is entitled to bring proceedings to enforce it. In this case, the proprietor of the earlier right is the autumn 2020 partnership, or failing that, the 1987 or 2019 partnership, and not Mr Bonnet alone. The opposition brought by Mr Bonnet as the supposed owner of the earlier right under section 5(4)(a) of the Act must therefore fail.

43. The Hearing Officer examined the evidence as to whether the Opponent had abandoned his claim to a share in the goodwill attaching to the name and mark **ALCATRAZZ** in paras [48] to [59] of her Decision. She started from the premise that it was "*largely academic*" to do so. In para. [59] she stated: "*I reiterate here that neither side has evidenced a particularly convincing case for its version of events. Other than [the Opponent's] statement, there is nothing to support his assertion that the band mutually agreed not to perform together in November 2020. On the other hand, the Applicants*

have put forward no evidence of [the Opponent] resigning from the partnership and agreeing the others could carry on without him as Alcatrazz."

44. Her conclusion in para. [60] was that "*The evidence provided does, in my view, suggest that [the Opponent] lost interest and contact with the 2020 partnership, and in the end went off to do his own thing. It shows, at the very least, that he had given the impression to the rest of the partnership that he no longer wished to be part of the same. The combination of the statements [the Opponent] is said to have made about hating the band and being replaced, alongside Ms Heavenstone's and Mr Pesinato's statements that he was working on other projects and hiring other musicians, and Ms Furlan's comments that he ceased all communication with Silver Lining and removed all references to previous Alcatrazz material from his Facebook page also indicate that [the Opponent] intended to leave the band and distance himself from the same. ... Considering to the position at the relevant date, I find the evidence does not establish that [the Opponent] acquiesced to the further use of the name by the new 2021 partnership at that stage. Whilst I therefore consider that both sides' evidence could have been clearer, it is my view that the Applicants have not managed to establish from the evidence provided that [the Opponent] abandoned his stake in the goodwill of the partnership at the relevant date.*"

45. The Opponent contends on Appeal that the Hearing Officer's reasoning as to the ownership of goodwill was incorrect and should be set aside. More specifically, he "*does not argue that he is the sole owner of the goodwill but that he continues to own a share of goodwill in the name and an attempt to register the trade mark without his consent and / or inclusion would be sufficient to grant him standing under section 5(4)(a) of the Act. ... as the [Applicants] cannot be said to own the entirety of the*

goodwill in the sign, as the Hearing Officer confirmed in the decision from 28 July 2022, the Opponent still holds a share of goodwill in the sign and the [Applicants] should not legitimately be permitted to obtain registration for the Alcatrazz mark unless it is done on behalf of all members holding goodwill in the sign or at least with their consent."

46. Whilst maintaining that the Hearing Officer correctly rejected the Opponent's objection for lack of standing to raise and pursue it under s.5(4)(a), the Applicants contend that she should in any event have rejected it: (i) on the basis that the actions of the Opponent were "*sufficient to amount to an abandonment of his share of the trading goodwill, and certainly to an abandonment of the ability to use that trading goodwill against the remaining members of the Alcatrazz band and its management, to allow them to be able to continue to operate as Alcatrazz and fulfil ongoing contractual obligations.";* and additionally or alternatively (ii) on the basis that "*the evidence demonstrates that there was no misrepresentation or damage caused by the Applicants.*"

47. In para. [46] of her Decision, the Hearing Officer supported her reasoning to the effect that the Opponent had no right of his own to object to the contested application for registration under s.5(4)(a) with the observation that the Judgment of the Court of Appeal in Thomas v Luv One Luv All Promotions Ltd [2021] EWCA Civ 732 had reinforced the position reached by Laddie J in Byford v Oliver (SAXON Trade Mark) [2003] EWHC 295 (Ch) at para. [19]. It appears to me that she needed to go further than that in the present case in order to take on board what the Court of Appeal had said on the point in issue before it about "the difference between an unincorporated association which is not a partnership and one which is": see [2021] EWCA Civ 732 at

paras [8] to [19], [52] and [58] to [73] per Lewison LJ (with whom Newey and Lewis L.JJ agreed).

48. In Thomas the parties went into the hearing in the Court of Appeal constrained by a binding decision of the Registrar to the effect that they had previously performed together as members of a since dissolved partnership at will. On that basis the goodwill they had built up and acquired in the course of carrying on business together as members of the dissolved partnership fell to be regarded as "partnership property" within the scope of ss. 20 and 39 of the Partnership Act 1890. With the consequence of that being basically the same as in Byford v Oliver (SAXON Trade Mark) [2003] EWHC 295 (Ch) where it was also not in dispute that the individuals concerned had performed together as members of a since dissolved partnership at will. In the latter case, Laddie J determined at para. [19] that the dissolution of the partnership at will had left the erstwhile partners in a situation where "*none of them 'owned' the partnership assets. In particular none of them owned the name SAXON or the goodwill built up under it.*"

49. In Williams v Canaries Seaschool SLU (CLUB SAIL Trade Marks) BL O/074/10 (23 February 2010) a successful claim to proprietorship of a protectable goodwill was made by the members of what I had identified in my Decision as an unincorporated association in the form of an ongoing alliance, the business activities of which had over the years been conducted by a succession of companies and individuals working together in permutations which varied from time to time as different participants came and went (para. [42]). I pointed out in para. [31] that where there is a dispute as to whether and, if so, by whom rights of proprietorship have been held and exercised collectively in relation to the goodwill of a business with plural participants, it will

usually be helpful for the decision taker to be provided with copies of the participants' business accounts and documentary evidence of the exercise of financial control in relation to the relevant income and expenditure. By 'following the money' it ought to be possible to see where control over the operation of the business has actually been located. In that case, as in the present case, there was no evidence of that kind.

50. In para. [71] of his Judgment in Thomas, Lewison LJ made the following points about my Decision in CLUB SAIL Trade Marks:

> There are five points which, at this stage, I should make about Mr Hobbs' decision. First, he was dealing with an ongoing alliance, not one which had come to an end. Second, all the continuing members of the ongoing alliance had opposed the registration. Third, he was not dealing with a partnership. He was, in my judgment, undoubtedly correct to say that in the case of an unincorporated association (not being a partnership) the ownership of property is collectively owned by its members, subject to any contractual restrictions in the rules (if any) of the association. As I have said, the application of partnership assets on a dissolution is governed by the Partnership Act 1890. Fourth, Mr Hobbs cited *Byford* in support of his conclusion, which makes it highly improbable that he disagreed with Laddie J's analysis of the position once a partnership has been dissolved. Fifth,Mr Hobbs did not in terms refer to the 2007 Order. That was because the application for registration in that case was before the 2007 Order came into force. The 2007 Order does not in terms address the question whether one of plural co-owners may oppose registration. But in other contexts, the courts have held that where property is co-owned, the benefit of the legislation may be claimed by one only of the co-owners. Much will depend on the policy underlying the legislation in question. In a case like this, where one co-owner seeks to register a sign as a trade mark which will effectively prevent his co-owner from continuing to use the sign, there is much to be said for the ultimate effect of Mr Hobbs' decision as regards the ability to object under Section 5(4)(a).

51. It is necessary from that perspective to distinguish between unincorporated associations which are not subject to the dissolution provisions of the Partnership Act 1890 and those which are. The regime applicable to the former leaves room for goodwill to

devolve by way of uninterrupted succession from past to present to future members of the association (all the way down the line, if events dictate, to the "last man standing"). Whereas the regime applicable to the latter subjects transmissions of goodwill from past to present to future partners to the punctuating effect of dissolution at each successive step along the way.

52. For clarity: "*What is meant by the 'dissolution' of a partnership is often misunderstood, not only because that word is used in two distinct senses, but also because it has a very different meaning when applied to a company or limited liability partnership. [fn 1. The words 'dissolved' and 'dissolution' are not defined in the Partnership Act 1890.] In the case of a partnership, it invariably refers to the moment of time when the ongoing nature of the partnership relation terminates, even though the partners may continue to be associated together in a new partnership or merely for the purposes of winding up the old firm's affairs. [fn 2. Partnership Act 1890 s.38 …] Indeed, the outward appearance of a partnership immediately prior to and immediately following a dissolution will frequently be unchanged. For a company or LLP, on the other hand, dissolution marks not the commencement of the winding up but its conclusion, i.e the moment of extinction. [fn 3. OMITTED]*": Lindley & Banks on Partnership 21st Edition (2022), para. 24 – 01.

53. As recognised in paras 3.7 to 3.9 of the Joint Report of The Law Commission and The Scottish Law Commission on Partnership Law (Law Com No. 283; Scot Law Com No. 192) published on 18 November 2003 (Cm 6015), there are many successful trading and professional firms which have been informally created as partnerships at will in which it would be contrary to the reasonable expectations of the partners for the partnership simply to be wound up at any time on dissolution at the instigation of any

one partner. It is quite possible in such situations that all concerned may expressly or tacitly agree to or acquiesce in the transmission of goodwill by succession from one partnership grouping to the next without requiring the affairs of the partnership to be wound up in the manner prescribed by the Partnership Act 1890. There is nothing to prevent them from doing so consistently with the principle that winding up on dissolution is the responsibility of the partners themselves, with statutory rights of recourse to the Court being available in the event of disagreement or dissent over the settling of the accounts: Hurst v Bryk [2002] 1 AC 185 (HL) at pp.196 E -197 H (per Lord Millett with whom Lords Browne-Wilkinson, Nicholls of Birkenhead, Hope of Craighead and Clyde agreed).

54. The Partnership Act 1890 proceeds on the basis of the following "Definition of Partnership" contained in s.1(1): "*Partnership is the relation which subsists between persons carrying on business in common with a view of profit.*" A working relationship which does not satisfy those requirements is simply not a partnership for the purposes of that Act.

55. Further guidance as to the requirements of s.1(1) is provided by the "Rules for determining existence of partnership" set out in s.2 of the Act: "*In determining whether a partnership does or does not exist, regard shall be had to the following rules: (1) Joint tenancy, tenancy in common, joint property, common property, or part ownership does not of itself create a partnership as to anything so held or owned, whether the tenants or owners do or do not share any profits made by the use thereof. (2) The sharing of gross returns does not of itself create a partnership, whether the persons sharing such* returns *have or have not a joint or common right or interest in any property from which or from the use of which the returns are derived. (3) The receipt*

by a person of a share of the profits of a business is prima facie evidence that he is a partner in the business, but the receipt of a share, or of a payment contingent on or varying with the profits of a business, does not of itself make him a partner in the business;…"

56. In Lindley & Banks on Partnership (above) it is pointed out at para. 2-02 (with footnotes omitted) that "*before a partnership can be said to exist, three conditions must be satisfied, i.e. there must be: (1) a business, (2) which is carried on by two or more persons in common, (3) with 'a view of profit'. These conditions must also be satisfied following a change in the firm, e.g. when a new partner joins an existing firm, or a* partner *retires, and cannot merely be assumed to be satisfied because they were met by the existing firm.*"

57. It is emphasised in para. 2-16 (with footnotes omitted) that: "*It is also a fundamental condition of the definition* that *the business is carried on by two or more persons 'in common'. In the first place, this necessarily means that there must be a single business, even if that business comprises a number of different and unrelated activities and / or is carried on in a number of separate divisions. In the view of the current editor, this also presupposes that the parties are carrying on that business* ***together*** *for their common benefit and, thus, that they have, as regards the business expressly or impliedly accepted* ***some*** *level of mutual rights and obligations as between themselves….*".

58. The "with a view of profit" requirement is addressed in para. 2-18 (with footnotes omitted): "*In this element of the definition, by 'profit' is traditionally meant the net amount remaining after paying out of the receipts of a business* ***all*** *the expenses incurred in obtaining those receipts; this should be contrasted with 'gross returns', e.g.*

the royalties received by an author. ..."; and in para. 2-19 (with footnotes omitted): "*The intention to make a profit (even if a profit is not actually realised) lies at the very heart of the partnership relation. As Lord Lindley put it: 'An agreement that something shall be attempted with a view to gain, and that the gain shall be shared by the parties to the agreement, is the grand characteristic of every partnership, and is the leading feature of nearly every definition of the term'.*" and in para. 2-24 (with footnotes omitted): "*Even where there is a genuine view of profit, a partnership will only exist if the profits are intended to be realised for the common benefit of the participants.*"

59. It is convenient to refer to paras 2.2, 2.3 and 2.26 of the Joint Report of The Law Commission and The Scottish Law Commission on Partnership Law (above) for two points as to what it means from an English legal perspective to speak in terms of the existence or absence of a "*partnership*" and "*partnership at will*" (with footnotes omitted):

> **A CONTRACTUAL RELATIONSHIP**
>
> 2.2 A partnership depends upon an existing relationship which results from a contract. The contract is, as Jessel MR explained in *Pooley v Driver*:
>
> > A contract for the purpose of carrying on a commercial business - that is, a business bringing profit, and dividing the profit in some shape or another between the partners.
>
> 2.3 A partnership relationship can arise only by mutual consent, which may be express or inferred from parties' conduct. The personal nature of partnership means that a partner has agreed to associate with his co-partners and no-one else: no new partner can be introduced without the consent of all the partners.
>
> …

DURATION OF PARTNERSHIP

> 2.26 A partnership falls into one of two categories namely a partnership at will or a partnership for a fixed term. The default rule is the partnership at will: it exists where the partnership agreement is silent as to the duration of the partnership. A partner in a partnership at will can dissolve the partnership immediately by notice. In absence of agreement between the partners to the contrary, the partnership must then be wound up. Transactions begun but unfinished may be completed, and the partnership's assets distributed.
>
> …

60. The Court of Appeal summarised the relevant characteristics of an ordinary English partnership in Memec Plc v Inland Revenue Commissioners [1998] STC 754 at p. 764 E-F (per Peter Gibson LJ with whom Henry LJ agreed) as being: "(1) the partnership is not a legal entity; (2) the partners carry on the business of the partnership in common with a view to profit (s.1(1) Partnership Act 1890); (3) each does so both as principal and (s.5 ibid) as agent for each other, binding the firm and his partners in all matters within his authority; (4) every partner is liable jointly with the other partners for all debts and obligations of the firm (s.9 ibid); and (5) the partners own the business, having a beneficial interest, in the form of an undivided share, in the partnership assets … including any profits of the business".

61. I have already commented in paras [10] to [12] above on the absence of pleadings and evidence relating to the making or implementation of any partnership agreements or arrangements between or among the individuals from time to time involved in delivering live and recorded performances as members of **ALCATRAZZ**. There was, in particular, nothing to show that in relation to the reunion tour in Japan in 2017 or at any time thereafter there were any agreements or arrangements in place for the

computation or sharing of net profits or losses between or among those individuals. And still less was there any evidence of any of them having acted or been in a position to act as agents with authority to bind the others of them. I cannot accept on reviewing the evidence on file from the viewpoint of the English law of partnership as outlined in paras [52] to [60] above, that it provided any real or sufficient basis for concluding that the individuals concerned worked together at any material time as members of a partnership or partnership at will within the meaning of the 1890 Act.

62. The Opponent's objection to registration could not be determined without considering the impact of and interplay between: (i) the contractual arrangements that had been put in place prior to the relevant date (paras [17] to [20] and [24] to [34] above); (ii) the fact that prior to the relevant date he ceased participating in the implementation of those arrangements in the manner and circumstances described by the Hearing Officer (paras [43], [44] above); and (iii) the unchallenged trade mark registration for **ALCATRAZZ / Alcatrazz** in Class 41 which two of the Applicants had sought and obtained prior to the relevant date (paras [7] to [9] above).

63. I accept that the Opponent's objection under s.5(4)(a) could have succeeded if the contested application for registration had been filed and the Opponent's objection to it had been raised and pursued to a conclusion while the Opponent was continuing to perform as a member of **ALCATRAZZ** in the state of affairs which existed prior to the new milestone reached in 2020.

64. In that state of affairs while it subsisted, the Opponent possessed what appears to me to have been a proprietary interest in the goodwill and reputation built up and acquired by commercialisation of the live and recorded performances which he with other members

of the band had over the years delivered under and by reference to the name and mark **ALCATRAZZ**. On that basis, I accept that it would have been open to him while he remained a member of the band, to invoke the law of passing off with a view to preventing others — including, if necessary, other members of the band — from making independent and autonomous use of the name and mark **ALCATRAZZ** in the United Kingdom in connection with the commercialisation of Class 9 goods of the kind listed in para. [3] above. That, according to my understanding, was the thrust of the objection he sought to pursue under s.5(4)(a): see para. [40] above. However, the problem he faced was that the state of affairs in which that could have been a sustainable objection for him to make had by the relevant date been overtaken by events.

65. The Opponent and the other members of the band "*as of March 1st, 2020*" jointly and severally committed themselves to the extensive obligations imposed by the License Agreement and Inducement Letter with regard to making and exploiting and permitting others to make and exploit audio and / or audio-visual recordings of them performing under the name **ALCATRAZZ** or any name containing the name **ALCATRAZZ**. In doing so, they each contractually ceded to the Licensee (Silver Lining Music Ltd) possession and control of whatever rights they could otherwise have claimed for themselves to use and authorise others to use **ALCATRAZZ** as a name and mark for Class 9 goods of the kind listed in para. [3] above. And they each did so for the duration of the License Agreement and Inducement Letter with no contractual mechanism enabling any of them to unilaterally withdraw from the arrangement or revert to the position they were in before.

66. In parallel, the interrelated right to prevent others from using **ALCATRAZZ** as a name and mark for Class 41 services of the kind listed in para. (7) above came to be vested

in the Licensor (Mr Lavery) and one member of the band (Mr Waldo) by virtue of the registration of UK Trade Mark No. 3557956 they obtained with effect from 19 November 2020. I note that there is nothing in the evidence to suggest that the Licensee (Silver Lining Music Ltd) had any concerns about the rights conferred by that trade mark registration existing and operating concurrently with its rights under the License Agreement and Inducement Letter.

67. When the Opponent left the band and distanced himself from it as found by the Hearing Officer in para. [60] of her Decision, the other members of it carried on without him in the implementation of their obligations under the License Agreement and Inducement Letter. His departure did not dispossess the Licensee (Silver Lining Music Ltd) of the rights which he and they had jointly and severally ceded to it with regard to use of **ALCATRAZZ** as a name and mark for Class 9 goods of the kind listed in para. [3] above.

68. There could have been an implied novation involving the substitution of Doogie White for the Opponent in the contractual arrangements established by the License Agreement and Inducement Letter when Mr White was brought in to replace him as a member of the band. But even assuming that German law allows for implied novation in the same way as English law (as to which see e.g. Musst Holdings Ltd v Astra Asset Management UK Ltd [2023] EWCA Civ 128 at paras [54] to [60] per Falk LJ with whom Peter Jackson and Whipple L.JJ agreed) the evidence on file was not adequate for the purpose of showing that it had, in fact, happened here.

69. Meanwhile the use of **ALCATRAZZ —** solus and without qualification — as a name and mark for live and recorded performances within the coverage of the Class 9 and

Class 41 listings of goods and services set out above continued to represent that such performances were delivered by the members of the band for the time being performing together as such.

70. In the events which had happened, use of the name and mark **ALCATRAZZ** in that context and manner had — before the relevant date — become something which on the one hand:

> the Opponent could not prevent those who were still implementing the contractual arrangements (inferentially with the involvement of Mr Merton) from doing in the United Kingdom, since they would be using the name and mark truthfully in the commercialisation of live and recorded performances delivered by the members for the time being of the still functioning band performing together as such;

and on the other hand:

> those who were still implementing the contractual arrangements (inferentially with the involvement of Mr Merton) could for the protection of their interests prevent the Opponent from doing in the United Kingdom, by invoking the law of passing off and also the unchallenged trade mark registration in Class 41 held by Mr Lavery and Mr Waldo, since he, by ceasing to be a member of the band and becoming an outsider to the implementation of the ongoing contractual arrangements, had put himself in the position of a third party who could not without causing deception and confusion use the name and mark in the commercialisation of live and recorded performances delivered (with or without involving him) by

performers who were not members of the band for the time being performing together as such.

That, in my view, required the Opponent's objection to registration under s.5(4)(a) of the Act to be rejected.

71. For the reasons I have given: [1] the Opponent's Appeal from the Hearing Officer's Decision issued under reference BL O/ 642/22 on 28 July 2022 in Opposition No. 425603 to Trade Mark Application No. 3597907 is dismissed; and [2] the Opponent is directed to pay £1,600. to the Applicants in respect of their costs of the Appeal within 21 days of the date of this Decision (to be paid in addition to the sum of £1,450. awarded by the Hearing Officer in respect of the proceedings in the Registry).

72. I regard £1,600. as a reasonable amount to award by way of costs having regard to what I consider to have been the amount of effort and expenditure that is likely to have been reasonably and productively incurred by the Applicants in resisting the Appeal, adopting the approach to quantification indicated in paras [12] to [14] of my decision in AMARO GAYO COFFEE Trade Mark BL O/257/18 (25 April 2018).

Postscript

73. The Opponent appointed GCS Europe Ltd (which I understand to be a company registered in Bulgaria with an address at what seem to be shared office premises in Sofia) to represent him on this Appeal. The "Address for Service" notified to the Registrar by GCS Europe Ltd for the purposes of Rule 11 of the Trade Marks Rules 2008 was "c/o Stron Legal, The Clubhouse St James, 8 St James's Square, London SW1Y 4JU" which seems to be a serviced accommodation address.

74. The Applicants' professional representative wrote to the Registrar questioning whether the Opponent had provided a valid Address for Service. GCS Europe Ltd informed the Registrar that "GCS Europe Ltd / c/o Stron Legal is an address for service where the IPO has on numerous occasions validly served official letters, that have been delivered and received in good order and further actioned." The Registrar then wrote to the parties confirming that the UK Address for Service requirements had been met.

75. The Applicants have not questioned that decision before me. For the avoidance of doubt, I emphasise that nothing said or done by this Tribunal in relation to the present Appeal should be taken to suggest or imply anything either way as to the conformity of the Opponent's notified Address for Service with the requirements of Rule 11.

Geoffrey Hobbs KC

25 April 2023

Mr Emil Vasilev for GCS Europe Ltd appeared on behalf of the Opponent

Ms Michelle Ward of Indelible IP Ltd appeared on behalf of the Applicants