

O-086-16

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No. 3069320
STANDING IN THE NAME OF
PAUL GILMARTIN**

AND

**IN THE MATTER OF A REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER No.500708
BY PAUL NASH & MAETHELIAH L PILE**

AND

**IN THE MATTER OF APPLICATION Nos. 3083130 & 3083229
BY PAUL NASH
TO REGISTER THE TRADE MARKS:**

THE DANSE SOCIETY

IN CLASS 41

AND

**THE DANSE SOCIETY
IN CLASSES 9, 25 & 41**

**IN THE MATTER OF OPPOSITION
THERETO UNDER No. 404032 AND 404043 BY
PAUL EDWARD GILMARTIN**

BACKGROUND

1) The following trade mark is registered in the name of Mr Paul Gilmartin (hereinafter PG):

Mark	Number	Filing & registration date	Class	Specification
 <p>A series of two trade marks</p>	3069320	20.08.14 21.11.14	41	Live performances by a musical band; Music concert services; Music concerts; Music performances; Music production; Music publishing; Music publishing and music recording services; Performance of music and singing; Performing of music and singing; Production of sound and music recordings; Providing digital music [not downloadable] for the internet; Providing digital music [not downloadable] from MP3 internet web sites; Providing digital music [not downloadable] from MP3 internet websites; Providing digital music [not downloadable] from the internet; Music entertainment services; Arranging of music shows; Band performances (live -); Digital music [not downloadable] provided from mp3 web sites on the internet.

2) By an application dated 16 December 2014 Paul Nash & Maethelyiah L Pile (hereinafter PNMP) applied for a declaration of invalidity in respect of this registration. The grounds are, in summary,

- a) PNMP contends that the name THE DANSE SOCIETY has been used since 1981 by a musical band. The original band consisted of five people, and disbanded in 1986. In 2009 the band reformed with three of the original line-up and a fourth new member. In January 2011 Ms Pile joined the band. PNMP contend that the registered mark was first used by the band in December 2011, although prior to this the 2009 band had used the “crown of thorns” logo and also the name “The Danse Society”. The statement of ground states that “the ‘crown of thorns’ logo was designed by Mr Nash personally”. The statement alleges that Mr Gilmartin left the band voluntarily on 30 January 2014, and that the band has continued to perform and record. It is claimed that it was understood by all band members that if one left the band, the remaining band members would be entitled to continue to use the trade mark in word and/or logo formats and that the exiting band member would not be able to use these trade marks in connection with any activities outside of the band. The mark in suit therefore offends against section 5(4)(a) of the Act.
- b) The “crown of thorns” logo contained within the registered mark was designed by Sam Cairney under instruction by Mr Paul Nash in August 2011. Mr Cairney, it is claimed, licensed the sole usage of the logo to Paul Nash in connection with his band “The Danse Society”. The original “crown of thorns” was designed by Mr Nash. As such the mark in suit offends against Section 5(4)(b) of the Act.

- c) PNMP contend that the mark was applied for in bad faith as PG was aware of the reputation of the band and as mentioned in paragraph (a) above and it is alleged that there was an agreement within the band regarding ownership of the name & logo. It is also contended that PG was aware that the “crown of thorns” logo contained within the registered mark was designed by Sam Cairney under instruction by Mr Paul Nash in August 2011. Mr Cairney, it is claimed, licensed the sole usage of the logo to Paul Nash in connection with his band “The Danse Society”. It is alleged that Mr Gilmartin was aware of this license and so the mark in suit therefore offends against Section 3(6) of the Act.

3) PG provided a counterstatement, dated 27 February 2015, in which he denies the above grounds contending that the band did not enjoy success and in any case performed under the name THE DANSE SOCIETY and not the logo mark registered. He also points out that the mark is registered for services in class 41, and contends that PNMP are confusing trade mark and copyright law.

4) On 25 November 2014, Paul Nash (hereinafter PN) applied to register the trade mark shown on the above page in respect of the following services in Class 41: Live performances by a musical band, Music concert services, Music composition for film radio documentary and television use, Music concerts, Music performances, Music production, Music publishing, Music publishing and music recording services, Performance of music and singing, Performing of music and singing, Production of sound and music recordings, Providing digital music [not downloadable] for the internet, Providing digital music [not downloadable] from MP3 internet web sites, Providing digital music [not downloadable] from MP3 internet websites, Providing digital music [not downloadable] from the internet, Music entertainment services, Arranging of music shows, Digital music [not downloadable] provided from mp3 web sites on the internet.

5) On 26 November 2014 PN applied to register the trade mark THE DANSE SOCIETY in respect of the following goods and services:

In Class 9: Photographic, cinematographic, apparatus for recording, transmission or reproduction of sound or images; recording discs; compact discs, DVDs and other digital recording media; data processing equipment, computers; computer software.

In Class 25: Clothing, footwear, headgear.

In Class 41: Live performances by a musical band, Music concert services, Music composition for film radio documentary and television use, Music concerts, Music performances, Music production, Music publishing, Music publishing and music recording services, Performance of music and singing, Performing of music and singing, Production of sound and music recordings, Providing digital music [not downloadable] for the internet, Providing digital music [not downloadable] from MP3 internet web sites, Providing digital music [not downloadable] from MP3 internet websites, Providing digital music [not downloadable] from the internet, Music entertainment services, Arranging of music shows, Digital music [not downloadable] provided from mp3 web sites on the internet.

6) Both applications were examined and accepted, and subsequently published for opposition purposes on 19 December 2014 in Trade Marks Journal No.2014/052.

7) On 23 March 2015 PG filed a notice of opposition, subsequently amended. The grounds of opposition are in summary:

- a) PG is the proprietor of the trade mark shown at paragraph 1 above. The marks applied for are identical/similar to the registered mark and have been applied for in relation to goods and services which are identical and/or similar to the services for which PG's mark is registered. The marks offend against Section 5(1) & 5(2)(b) of the Act.
- b) PG claims to have used the registered mark since 20 August 2014 and have reputation and goodwill in the mark in the UK under the services in class 41. As such the marks in suit offend against sections 5(3) and 5(4)(a) of the Act.
- c) PG contends that the marks of PN were applied for in bad faith as he was aware of the registration owned by PG and had no right to use the name of the band founded by PG.

8) PN provided counterstatements dated 9 July 2015 (404032) and 12 August 2015 (404043), in which he denies the above grounds. He relies upon the grounds outlined in paragraph 2 above in that he has the copyright to the logo device, PG, it is claimed, resigned from the band and, it is contended, there was an understanding that the remaining members would be entitled to continue to use the trade mark in word and/or logo formats and that the exiting band member would not be able to use these trade marks in connection with any activities outside of the band.

9) The oppositions and invalidity were consolidated on 1 October 2015.

10) Both sides filed evidence. Both seek an award of costs in their favour. The matter came to be heard on 26 January 2016 when Mr Gilmartin represented himself; and Mr Nash represented himself and Ms Pile. Subsequent to the hearing Mr Gilmartin complained that he was unfairly treated by the IPO as he chose to attend via video link in London whilst PNMP attended in person in Newport. Mr Gilmartin was aware of his options, indeed in his email of 9 September 2015 he indicated that he would attend in Newport. It was for him to choose which suited him best and then live with the consequences. I do not accept that he was disadvantaged.

EVIDENCE OF PNMP

11) PNMP filed two witness statements. The first, dated 29 April 2015, is by Mr Nash. He states that since 1981 he has been the lead guitarist in a band called The Danse Society (TDS). From 1981 the band, in whatever formation, performed (apart from a brief time from September 1986 to early 1987) as TDS. In December 2011 the band logo was designed by Sam Cairney at the request of Mr Nash and this is the logo that has been registered by PG under the number UK 3069320. On 18 March 2014 the TDS logo was registered with the UK Copyright Service based in Didcot by PNMP. He provides the following history of the band line ups.

Date	Band members	Albums	Singles
February 1981	Nash, Scarfe, Wright, Gilmartin & Rawlings.	Seduction (September 1982); "Heaven is Waiting" (September 1983).	"Clock/Continent"(March 1981); "No shame in Death" (July 1981); "Woman's Own" (April 1982); "Somewhere" (January 1983); "Wake up" (May 1983); "2000 light years from home" (1984)
1984	Nash, Whitaker, Wright, Gilmartin & Rawlings.	"Looking Through" (August 1986)	"Say it Again" (May 1985); "Hold On" (February 1986)
September 1986	Nash, Whitaker, Wright, Gilmartin & Copson.		

12) Mr Nash states that from September 1986 to early 1987 the band renamed itself "Johnny in the Clouds". In early 1987 the band dissolved only to reform in 2010. The line up since then has been:

Date	Band members	Albums	Singles
2010	Nash, Whitaker, Gilmartin & Rawlings.		
April 2011	Nash, Whitaker, Gilmartin & Pile.	"Change of Skin" (July 2011); "Demo's Vol 1" (November 2011).	
May 2012	Nash, Whitaker, Gilmartin, Roberts & Pile.	"Scary Tales" (February 2013);	
February 2014	Nash, Whitaker* Jones, Hunter & Pile.		
October 2014	Nash, Hunter, Cooper, Bolland & Pile.		"If I were Jesus / Sound of Silence" (December 2014)

*see attachment n.5 to statement of Ms Pile paragraph 26

13) Mr Nash states that the first time the band used the new logo mark was in November 2011 on the album "Demo's Vol 1" which was a collection of recordings from the 1984

sessions of “Heaven is Waiting”. The logo mark was used on all records and promotional items thereafter. Mr Nash states that the band has sold goods bearing either the name TDS or TDS logo including records (including CD’s, digital downloads & vinyl), clothing, posters, badges, photos, videos etc. The band has also used both marks in relation to live performances and on flyers, brochures, reviews, booking venue confirmations etc relating to these performances. He provides the following turnover figures for all the above goods and services in the UK:

Year	UK turnover £
2011	805.32
2012	249.32
2013	1,177.84
2014	307.49
2015	132.94

14) Mr Nash states that the TDS logo which is registered as TM No. 3069320 in the UK by PG was used by the band since 1 December 2011. He states that the “crown of thorns” artwork was first used on the “Seduction” album in 1982 and was designed by Mr Nash and Mr Rawlings. This was also used, in 1983, on the album “Heaven is Waiting”. When the band reformed it was used on “Change of Skin” album in July 2011, as well as “Demo’s Vol 1” in November 2011. Mr Nash states that PG had nothing to do with the original artwork, which was then given to Sam Cairney by Mr Nash to develop. He states that Mr Cairney created the TDS logo which has been registered by PG and which was licensed by Mr Cairney to PNMP and which PNMP copyrighted with the UK Copyright Service in Didcot on 18 March 2014. Mr Nash contends that since resigning from TDS, PG has formed another band which was initially called “Heaven is Waiting” (the title of a song by TDS) in January 2014, which then changed to Danse Society Reincarnated and then simply TDS. It is also alleged that PG has contacted agents and others, and used social media in an attempt to “sabotage” the band of PNMP.

15) Mr Nash states that from the beginning of the band it was always a democracy with all members sharing equally in the royalties no matter who actually wrote the song and similarly all members contributed equally to pay for recording time. Each member of the band took care of a particular function e.g. Mr Whitaker looked after the finances; Ms Pile on-line promotion/merchandising and Mr Nash artwork and negotiating gigs. He supplies the following exhibits:

- PN1: A print out from PG’s Facebook page, dated 30 January 2014, which states “I will call it locked out of your own house” and “the rhythm section has resigned”. In another post on the same day PG refers to “Dave effectively jumping ship” and “Martin and myself feel we can carry on making music ourselves”.
- PN9: A copy of a declaration by Mr Sam Cairney who states that he designed the logo which is the mark registered by PG. It also states that Mr Cairney only licensed it to Mr Nash for use with TDS. This declaration is dated December 2014. A copy of the album cover shows a credit to Mr Cairney in respect of the sleeve design.
- PN11: A copy of the copyright registration of a design for a crown of thorns in the name of PNMP, this is the same design as used in PG’s registered mark.

- PN12: A copy of a document headed “The Danse Society Partnership Agreement. It is undated but as the members of the band are named as Nash, Hunter, Cooper, Bollands & Pile it must refer to the October 2014 line-up. It is therefore of no relevance to the instant case.

16) The second witness statement, dated 29 April 2015, is by Maethelyiah L Pile. Essentially her witness statement is a rehash of most of what Mr Nash set out in his statement, to the extent of commenting and relying upon the exhibits filed with the statement of Mr Nash. She does acknowledge that there was never a written agreement with the line-up which included PG but she maintains that there was a verbal agreement that “any resigning member would be no longer part of the partnership and therefore his rights in the band would cease with the resignation.” Regarding the membership of the band she states that Mr Gilmartin resigned on 30 January 2014, whilst Martin Roberts left to pursue a career with another band, although no date is given for his departure. As to Mr Whitaker she states:

“David Whitaker was particularly inactive due to the starting of his new recording studio he built in Leeds (Czar Studio). He agreed to perform in the Glory or Grace tour but said he was very busy until July 2014. David Whitaker after a few hesitations left the band amicably on the 16 September 2014.”

17) Later she states (at page 4 of her statement):

“Paul Nash and I wrote a band partnership agreement in March 2014 that confirmed the same principles discussed in the reformation meeting. The new partnership agreement never featured the signature of David Whitaker because he left the band before he could have the chance to record new tracks. New members joined in the name of Iain Hunter drummer and Lee Jones on the 27 February 2014. Lee Jones never took part of [sic] any of the writings. He was later replaced by Jack Cooper on 14 July 2014. Mr Whitaker left the band in September 2014 and was replaced by Sam Bollands on 1 November 2014.”

18) Ms Pile states that they began recording a new single in November 2014 with the intention of releasing it in December 2014. She states that this single “re-established The Danse Society as a living entity”.

EVIDENCE OF PG

19) Paul Gilmartin provided a witness statement dated 28 June 2015. He states that he first used the mark in suit in 2010 as part of an interview given to a fanzine and that it was then used on an album cover and at various live performances. He states:

“I am a founder member of the band “The Danse Society” and as such I have rights and title to all aspects of that entity.”

20) He states that the mark in suit was merely a combination of previous logos used by the band. He accepts that Mr Cairney did indeed do the layout of the album sleeve but did not design the new logo. PG also points out that Mr Cairney was working for the band not Mr Nash personally. He states that following the release of the album “Demo’s Vol 1”

in November 2011 the band did not use the logo on subsequent occasions. He provides the following exhibit:

- PN1 he provides a copy of an internet page which shows the mark in suit and also a reference to the band which shows “1980-1987: 2010 - ?” There is no date discernible upon the page. PG states that he amended the photograph on the website to show the arrival of Ms Pile.

ADDITIONAL EVIDENCE OF PNMP

21) PNMP filed a further witness statement, dated 20 August 2015, by Mr Nash who has previously provided evidence in these proceedings. Much of what he says reiterates what was in his earlier statement. I did however note the following:

“Whilst I never claimed paternity on the crown of thorns, it was myself and Steve Rawlings who provided sketches that resulted in the various versions of the crown of thorns we used in our band artworks. The crown of thorns image was incorporated into our various logos and used by the band since 1982 in many different guises and variations – that is the nature of an identifiable logo (e.g. Rolling Stones Lips).”

ADDITIONAL EVIDENCE OF PG

22) Paul Gilmartin provided a further witness statement, dated 5 October 2015, having provided evidence earlier in this case. PG states his view that although the band did not have a written agreement the band’s affairs need to be resolved under the Partnership Act 1890 and the band’s affairs need to be wound up. He states that in 2014 Dave Whitaker withdrew from the band as he was working on a business project. Mr Gilmartin and Martin Roberts decided this was the time to disband the band. He states that he began using the mark in suit for his new band which included Mr Whitaker, and at this point PNMP also began using the same logo mark and sabotaging his work. Throughout his evidence Mr Gilmartin expresses a wish for a settlement possibly after mediation. He accepts that when PNMP contacted promoters stating that his use of the mark was “illegal” he made some intemperate posts on social media sites, which he now regrets. He includes various letters written by people associated with the band over the years. This includes a letter by Dave Johnson who acted as a tour manager and merchandising salesman for the band. He states:

“I was also there when discussions took place about the logo for stage banners and Demos Vol 1 Cds and T-shirts. It was decided at one of these meetings to use the crown of thorns in the “o” of “Society”. It was most definitely not done or thought up by Sam Cairney for the exclusive use of Paul Nash.”

23) A letter from Mr Whittaker, a former band member states that the crown of thorns device as used on the Demos Vol 1 album was “commissioned on behalf of the Danse Society by the partnership of Gilmatin, Whitaker, Nash and Pile. He confirms that he co-produced Mr Gilmartin’s version of The Danse Society’s new album. He also provides his view that all parties should be allowed to use the name “The Danse Society”. He makes no comment regarding any “verbal contract” within the band.

24) A letter from Mr Scarfe, a former band member who confirms that the band split all royalties equally irrespective of who wrote the song and costs were equally paid by each band member. He also confirmed that each member undertook a role in the overall running of the band such as dealing with the media and finances. He states his view that neither party have a strong claim to the name. He makes no comment regarding any “verbal contract” within the band.

FURTHER EVIDENCE OF PNMP

25) PNMP filed a further two witness statements. The first, dated 7 October 2015, is by Mr Nash who has previously provided evidence in these proceedings. Much of his statement is taken up with evidence previously submitted and personal views and comments which I do not find of assistance. He states:

“Mr Gilmartin’s subsequent actions (as he well knows) were blatantly malicious – he had every opportunity to call his band something other than “The Danse Society” as he indeed did at the beginning calling it “Heaven is Waiting” and then months later “Danse Society Reincarnated” but it was only when we requested he changed his name to something less misleading and confusing to the public that he decided to register his trademark, 8 months after he left.”

26) The second witness statement, dated 7 October 2015 is by Ms Pile who has previously provided evidence in these proceedings. She states that it was in April 2014 that Mr Gilmartin formed the band called “Danse Society Reincarnated”. She states that when Mr Gilmartin left 3 of the four members of the band remained, but this seems to ignore Mr Roberts. Most of her statement covers evidence already submitted, personal comments or uncorroborated allegations of what others have said to her, none of which assists me in my decision. She provided the following attachment:

- N5: This is an email dated 8 March 2014 from David Whitaker to Mr Nash and Mr Gilmartin. In it he states: “I just wanted to say again that I won’t be joining either of the TDS offshoots or bands as I don’t have the time to commit to it.”

27) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

28) At the hearing Mr Nash referred to PG employing session musicians, but could not provide the exact reference. I therefore allowed him a week to supply the reference. Unfortunately both sides decided to use this to put forward additional points. I should make it clear that none of these additional comments will be taken into account. The first ground of invalidity is based on section 5(4)(b) which reads:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a)

- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

29) In order for copyright to subsist in an artistic work it must be “original” - Section 1 of the Copyright, Designs and Patents Act 1988 (CDP). In *Bookmakers Afternoon Greyhound Servicers v. Wilf Gilbert (Staffs) Limited* [1994] FSR 723, Mr Justice Aldous (as he then was) said that:

“It is settled law that the word “original” does not require original or inventive thought but only that the work should not be copied and should originate from the author.”

30) There is some confusion as to quite who originated the logo which is said to have been copied by the mark in suit. The mark in suit has a logo device of a crown of thorns integrated with the letter “O” in the word “Society”. In the statement of grounds it is claimed that the words “The Danse Society” with the crown of thorns device in the letter “O” has been copyrighted by PNMP. It is claimed that the creator of this was Mr Cairney who was credited on the album sleeve with the sleeve artwork. He is said to have licensed this work to Mr Nash solely for use with the band known as The Danse Society. However, later in his evidence Mr Nash claims that the crown of thorns device was originally designed by himself with the assistance of another band member, Mr Rawlings, and used on a number of album covers and on posters, flyers etc. albeit underneath or above the name of the band and not incorporated into the letter “O”. It is stated that the original crown of thorns artwork was supplied to Mr Cairney for him to develop for use on the band’s album cover.

31) I take into account the case of *BBC Worldwide Ltd v Pally Screen Printing Ltd* [1998]FSR 665 at 669 where Laddie J. was faced with a claim for copyright infringement based on T-shirts bearing representations of the well known “Teletubbies” characters. He said:

“It is not possible to identify a particular artistic work created by or on behalf of the plaintiffs of which these can be said to be unlicensed reproductions. However, the plaintiffs say that this is effectively a *Popeye* type case, that the artwork on these two T-shirts must have been derived from one or other of those numerous drawings. Therefore substantial reproduction of a copyright work is made out. That is the overall structure of the claim to copyright infringement.

I must say that as far as the second group of garments is concerned, once again it seems to me clear that this artwork is derived directly or indirectly from Teletubby designs and, subject to the other defences raised by the defendants in this action, my view is that there is no reasonable defence to the plaintiff’s claim that this artwork is a substantial reproduction of one or other pieces of artwork which the plaintiffs have generated in designing Teletubby programmes.”

32) It seems clear to me that copyright cannot subsist with Mr Cairney. It appears that the design was created by Mr Nash and Mr Rawlings. Copyright is owned by the author(s) or

their employers if created under a contract of employment. There is no suggestion that either were employed to design the logo and so the design of the crown of thorns logo belongs jointly to Mr Nash and Mr Rawlings. Whilst Ms Pile cannot claim ownership to the copyright, Mr Nash can and he can act independently of Mr Rawlings in seeking to protect his copyright. He is therefore the proprietor of the copyright to the crown of thorns device and as such the ground of opposition under section 5(4)(b) succeeds.

33) I next turn to the ground of opposition under section 5(4)(a) which reads:

“5.4 A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

34) In determining the issue I take into account Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) which at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

35) I must next determine the relevant date. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which

the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.'

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If

there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

36) There is no evidence that PG used the mark prior to his application. I therefore regard the application date, 20 August 2014, as the relevant date.

37) In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

38) However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

39) As the instant case refers to the activities of a band I look to previous cases to set out the relevant test to be applied. I first look to the comments of the Hearing Officer in the *The Original Bucks Fizz* case BL O/296/11 where he set out the law as follows:

“56. The relevant law was considered by Laddie J. in connection with the registration of a trade mark consisting of the name a heavy metal band called Saxon (*Byford v. Oliver* [2003] Fleet Street Reports, 39). The application for registration of Saxon was made by two members of the original group, Messrs Oliver and Dawson. Both had left the group by the time they made their application for registration: Mr Dawson twelve years before, Mr Oliver two years before. Both had been replaced and gone on to work as musicians in other bands. An application was made by another band member, Mr Byford, to invalidate the trade mark. Mr Byford had continued to be a member of various manifestations of the band since the 1970s. The invalidation application was initially rejected by the Registrar on the grounds that each of the band members held a share in the goodwill of the band, which they were entitled to exploit. Consequently, Mr Byford’s claim was no greater than that of Mr Oliver or Mr Dawson. On appeal Laddie J. assessed the situation differently. He said that:

“19. In my view, Mr Foley's views as to ownership of the name SAXON and the goodwill associated with it are not correct. There is no dispute that the group was a partnership at will in the 1980s. The name and goodwill were assets of the partnership. All the partners have or had an interest in those and all other assets of the partnership, but that does not mean that they owned the assets themselves. Absent a special provision in the partnership agreement, the partners had an interest in the realised value of the partnership assets. On dissolution of the original partnership, which is what happened when Mr Dawson departed in 1985, he and all the other partners were entitled to ask for the partnership assets to be realised and divided between them in accordance with their respective partnership shares. But none of them “owned” the partnership assets. In particular, none of them owned the name SAXON or the goodwill built up under it.”

“25. Absent special facts such as existed in *Burchell*, the rights and obligations which arise when a group of musicians, performing in a band as a partnership, split up can be explained as follows. It is convenient to start by considering the position when two, entirely unrelated bands perform under the same name. The first performs from, say, 1990 to 1995 and the second performs from 2000 onwards. Each will generate its own goodwill in the name under which it performs. If, at the time that the second band starts to perform, the reputation and goodwill of the first band still exists and has not evaporated with the passage of time (see *Ad-Lib Club Ltd v Granville* [1972] R.P.C. 673 or been abandoned (see *Star Industrial Co Ltd v Yap Kwee Kor* [1976] F.S.R. 256) it is likely to be able to sue in passing off to prevent the second group from performing under the same name (see *Sutherland v V2 Music* [2002] EWHC 14 (Ch); [2002] E.M.L.R. 28). On the other hand, if the goodwill has disappeared or been abandoned or if the first band acquiesces in the second band's activities, the latter band will be able to continue to perform without interference. Furthermore, whatever the relationship between the first and

second bands, the latter will acquire separate rights in the goodwill it generates which can be used against third parties (see *Dent v Turpin and Parker & Son (Reading) Ltd v Parker* [1965] R.P.C. 323). If the first band is a partnership, the goodwill and rights in the name are owned by the partnership, not the individual members, and if the second band were to be sued, such proceedings would have to be brought by or on behalf of the partnership.

26. The position is no different if the two bands contain common members. If, as here, they are partnerships at will which are dissolved when one or more partners leave, they are two separate legal entities. This is not affected by the fact that some, even a majority, of the partners in the first band become members of the second. A properly advised band could avoid the problem that this might cause by entering into a partnership agreement which expressly provides for the partnership to continue on the departure of one or more members and which expressly confirms the rights of the continuing and expressly limits the rights of departing partners to make use of the partnership name and goodwill. This is now commonplace in the partnership deed for solicitors' practices.”

57. On the facts of the *Saxon* case, the judge decided that Mr Dawson had abandoned his share in the goodwill in the partnership by the time that the application for registration was made, and that Mr Oliver was in much the same position. Consequently, neither was entitled to apply for registration in the face of the goodwill generated by the more recently constituted partnership performing as *Saxon*. Further, the judge was of the view that if Mr Dawson and Mr Oliver started to perform again as *Saxon*, Mr Byford's group would have been entitled to sue them for passing off on the basis of their more recent use of the name and the goodwill associated with it, and that Mr Dawson and Mr Oliver's historical connection to the name would have provided no defence (see paragraphs 33 & 34 of the judgment).

58. In the light of the law expressed in *Saxon* it seems likely on the facts of this case that a new partnership was formed when Shelley Preston left the group in 1989, that another partnership again was formed when Rita Stroud left in 1993 and was replaced by Heidi Manton and Amanda Swarcz, and further partnerships were formed when Mike Nolan left in 1996 and was replaced by David Van Day, and when David Van Day subsequently left in 1997.”

40) I also look to the comments of Mr Geoffrey Hobbs Q.C. acting as the Appointed Person in *The Animals* O/369/13 where he said:

“7. So far as anyone can tell from the evidence on file in the present proceedings, the group was an unincorporated association of individuals with no contractual or other arrangements governing the relationship between and among its members. The evidence omits to explain how the business they carried on together was set up and managed. There is no explanation of the various contractual arrangements that must have been put in place with third parties for commercialisation of their live and recorded performances under and by reference to the name **THE ANIMALS**. The situation with regard to the collection and distribution of recording artist, public performance and music publishing revenues in respect of works in their repertoire is also not explained. The lack of information in relation to all these matters extends

into and through the period in which the goodwill and reputation generated by the group under and by reference to the name **THE ANIMALS** was perpetuated in the various ways mentioned above.

8. The evidence on file does not suggest that there has ever been a realisation or division of assets on dissolution of the group. There is also nothing in the evidence to suggest that the members of the group used the name **THE ANIMALS** with the licence or consent of anyone else. On the assumption that they used it as of right and in the absence of any basis in the evidence on file for either side to claim otherwise it seems to me that the goodwill and reputation built up and acquired by the group operating as **THE ANIMALS** should for the purposes of this dispute between these parties in these proceedings be taken to have belonged to ‘the last men standing’ in 1983: cf *CLUB SAIL Trade Marks* [2010] RPC 32 at paragraphs [26] to [28]. Burdon, Price, Valentine, Steel and Chandler will on that basis have been collectively entitled to control the use of the name **THE ANIMALS** in relation to live and recorded performances going forward from there.

9. The question which then arises in the circumstances of the present case is whether any of them abandoned their rights. The right to prevent others from trading under or by reference to a particular name exists independently of registration both at common law and in equity as explained by Lord Parker of Waddington in *AG Spalding Bros v. AW Gamage Ltd* (1915) 32 RPC 273. Foster J. observed in *British Leyland Motor Corporation v. Armstrong Patents Co. Ltd* [1982] FSR 481 at p.492 ‘*It is extremely difficult in my experience to divest oneself of a legal right*’. The outcome of the *Procol Harum* case *Fisher v. Brooker* [2009] UKHL 41 can be said to confirm the force of that observation. The evidence on file in the present case does not appear to me to establish that any of ‘the last men standing’ abandoned their rights. It basically indicates that none of them took exception to any one or more of the others of them participating in the operation of what I shall for want of a better expression call ‘heritage’ groups. Whether their tolerance led to a devolution or dissipation of the UK goodwill and reputation which belonged to them collectively as members of **THE ANIMALS** in 1983 is a separate question.”

“20. I consider that the gap between the names **THE ANIMALS** and **ANIMALS AND FRIENDS** is small but real enough, if honestly and fairly maintained, to put down a marker that the latter is the name of a ‘heritage’ group, that is to say an offshoot rather than the full successor in line of title to the business of **THE ANIMALS** as recognised and remembered by people who were or had become acquainted with the work of the group originally called by that name. I think the same is just about true of the gap between the names **THE ANIMALS** and **ANIMALS II** on the basis that the latter is apt to connote the opening of a new chapter. However, I do not accept that John Steel’s band has at any time during the period I have referred to above been entitled to hold itself out as being the full successor in line of title to the business of **THE ANIMALS** as would, in my view, have been the effect of his calling it simply **THE ANIMALS**.”

“29. I am satisfied that the Hearing Officer failed to appreciate that ‘cessation of production of goods or provision of services does not necessarily mean that there has been a cessation of business capable of sustaining goodwill, still less a destruction of the existing goodwill’: *Maslyukov v. Diageo Distilling Ltd* [2010] RPC

21 at [80] per Arnold J. That led him to assess the objection under Section 5(4)(a) from an incorrect perspective, with the result that he made no effective determination of the issues relating to goodwill (existence and ownership), misrepresentation and damage presented by John Steel's application to register **THE ANIMALS** as his trade mark for live and recorded performances.

30. I have already explained why I consider that the evidence on file: (1) confirms the existence of a goodwill and reputation accrued and accruing to the persons collectively entitled as 'the last men standing' in 1983 to control the use of the name **THE ANIMALS** in relation to live and recorded performances; (2) fails to show any devolution or dissipation of that goodwill and reputation over the period from 1983 to 2004; and (3) points to simple use of the name **THE ANIMALS** for John Steel's band as constituted since 2001 or thereabouts being apt to give rise to the mistaken belief that it is the full successor in line of title to the business of the group originally called by that name."

And:

"32. John Steel's application for registration envisaged use of **THE ANIMALS** as a trade mark for live and recorded performances provided or produced either by him or with his consent independently of the others of 'the last men standing' and irrespective of the existence or absence of any connection in the course of trade or business between them and the performances thus provided or produced. That was apt to result in misrepresentation to the effect I have indicated above. Misrepresentation to that effect was by its very nature liable to damage the economic value of the UK goodwill and reputation of the business signified by the name **THE ANIMALS**.

33. It was, as I have said, open to the opponent as one of 'the last men standing' to invoke the law of passing off for the protection of the goodwill and reputation to which they were collectively entitled. The fact that the applicant was also one of 'the last men standing' did not enable him to lay claim individually to the whole of the benefit of their goodwill and reputation by registering **THE ANIMALS** as his trade mark for live and recorded performances. The evidence on file does not show that he was free by virtue of devolution or dissipation or on the basis of any relevant authorisation or consent to apply for registration of the trade mark in this own name."

41) In the instant case PNMP put forward a list of the different band line ups over the years. However, the events in early 2014 seem to have been distorted, perhaps by the passage of time. It is accepted by both parties that from May 2012 to the start of January 2014 the band consisted of five members, Gilmartin, Nash, Pile, Roberts and Whitaker. Initially the view of PNMP was that PG had resigned on 30 January 2014 and the rest of the band carried on albeit having to find a replacement for PG. However, it seems relatively certain that Roberts left the band at the same time as Gilmartin. It also seems, contrary to comments by PNMP that Whitaker also left at this point. The email from Mr Whitaker to Mr Nash and Mr Gilmartin is dated 8 March 2014 and is reiterating his view that he will not join either of the offshoots of the band. It therefore seems to me that at the end of January the band split three ways. Gilmartin and Roberts going one way, Nash and Pile another with Mr Whitaker opting out in order to concentrate on his studio business.

42) The activities of Mr Gilmartin after January 2014 seem fairly clear. He first of all started a group named after one of TDS's songs "Heaven is Waiting". There is no evidence that this band actually played any gigs or recorded anything. It was quickly renamed "Danse Society Reincarnated" which also appears to have done little if anything and by August 2014 he changed it to TDS and applied to register the mark. Therefore at the point of the application Mr Gilmartin and his new band members had not accrued any independent goodwill in the name TDS.

43) The activities of PNMP are less clear cut. However, it is clear that whilst maintaining that Mr Whitaker was still part of the line-up Ms Pile states that he was unavailable to tour until July 2014 and that "after a few hesitations" he left the band in September 2014. He was not replaced until November 2014. There were also other comings and goings within the PNMP band (see paragraph 17 above). It was in November 2014 that the new band put together by PNMP began recording a single which was due to be released in December 2014, although it is unclear if this actually occurred. Ms Pile states that this single "re-established The Danse Society as a living entity" which suggests that 2014 had been a year of little or no activity.

44) Given the comments of PNMP that the band was run along democratic lines with all members receiving royalties irrespective of who wrote a song and sharing all income and costs equally I do not understand why in part of their evidence they suddenly write Mr Roberts out of history and claim that only a quarter of the band (PG) left in January 2014 whilst three-quarters (PNMP and Whitaker) remained. The sales figures provided at paragraph 13 apparently include sales of recordings (CDs etc), merchandise and revenue from shows. These figures can best be described as small. Notwithstanding this, the band would have had enough residual goodwill that use of the name eight months after the split would have caused misrepresentation. In my opinion none of the last men standing (Gilmartin, Nash, Pile, Roberts and Whitaker) had abandoned their rights to the name TDS.

45) It therefore follows that Mr Gilmartin's application would cause misrepresentation and **therefore offends against section 5(4)(a) of the Act and the opposition succeeds.**

46) Given the finding in paragraph 44 that Gilmartin, Nash, Pile, Roberts and Whitaker equally had goodwill under the name TDS in respect of sales of recordings (CDs etc), merchandise and live shows obviously impacts upon the two applications of PN. To my mind the goodwill covers all the goods and services applied for under these two marks. As such, the oppositions under Section 5(4)(a) must succeed for the same reasons that the application to invalidate PG's registration succeeded.

47) This finding may at first blush appear strange given my finding earlier in this decision that Mr Nash was the joint owner of the copyright in one of the marks he has sought to register. However, Mr Gilmartin owns a share in another legal right, passing off, which prevents Mr Nash using the mark on his own account in relation to the goods and services at issue.

CONCLUSION

48) The invalidity action under Section 5(4)(a) and 5(4)(b) in respect of trade mark 3069320 was successful. The registration will be deemed to have never been made. The

oppositions to applications 3083130 and 3083229 have also succeeded under section 5(4)(a).

COSTS

49) As PNMP has been successful in respect of the invalidity claim they are entitled to a contribution towards their costs. They have had some legal representation albeit highly limited, for the most part they have represented themselves and so I have taken this into account in awarding costs.

Preparing a statement and considering the other side's statement	£300
Expenses	£200
Preparing evidence	£300
Attendance at a hearing	£300
TOTAL	£1,100

50) I order Paul Gilmartin to pay the sum of £1,100 to Paul Nash and Maethelyiah Pile jointly. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

51) As Paul Gilmartin has been successful in opposing the two applications of Paul Nash he is entitled to a contribution towards his costs.

Preparing a statement and considering the other side's statement x 2	£600
Expenses x 2	£400
Preparing evidence	£300
Attendance at a hearing	£300
TOTAL	£1,600

52) I order Paul Nash to pay the sum of £1,600 to Paul Gilmartin. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17TH day of February 2016

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