

O-144-16

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3016595
BY ANDREW JOHNSTON**

TO REGISTER THE TRADE MARK

PANDEMONIUM DRUMMERS

IN CLASS 41

AND OPPOSITION THERETO

**UNDER NO 401320 BY
THE PANDEMONIUM DRUMMERS ASSOCIATION**

Background and pleadings

1. On 3 August 2013 (“the relevant date”), Andrew Johnston (“the applicant”) applied to register the trade mark PANDEMONIUM DRUMMERS (“the application”). Details of the application are as follows:

Number: 3016595
Publication date: 6 September 2013
Services: Class 41 “Entertainer services; Entertainer services provided by musicians; Entertainment; Entertainment by means of concerts; Entertainment by means of television; Entertainment by means of theatre productions; Entertainment club services; Entertainment, education and instruction services; Entertainment in the form of live musical performances (services providing-); Entertainment in the form of recorded music (services providing-); Entertainment in the nature of beauty pageants; Entertainment in the nature of dance performances; Entertainment in the nature of ethnic festival; Entertainment in the nature of fashion shows; Entertainment in the nature of football games; Entertainment in the nature of laser shows; Entertainment in the nature of light shows; Entertainment in the nature of magic shows; Entertainment provided during intervals of sporting events; Entertainment services; Entertainment services by stage production and cabaret; Entertainment services for children; Entertainment services for producing live shows; Entertainment services in the form of concert performances; Entertainment services in the form of motion pictures; Entertainment services in the form of television programmes; Entertainment services in the nature of an amusement park show; Entertainment services in the nature of live performances of roller skating exhibitions and competitions; Entertainment services in the nature of skating events; Entertainment services performed by a musical group; Entertainment services performed by musicians; Entertainment services provided at a motor racing circuit; Entertainment services provided at a race track; Entertainment services provided at country clubs; Entertainment services provided at discotheques; Entertainment services provided at nightclubs; Entertainment services provided by a music group; Entertainment services provided by a musical group; Entertainment services provided during intervals at sports events; Entertainment services provided for children; Entertainment services relating to quizzes; Entertainment services relating to sport; Entertainment, sporting and cultural activities.

2. On 6 December 2013, The Pandemonium Drummers Association (“the Association”) opposed the trade mark application. Since the opponent is an unincorporated entity it was required to amend its TM7 to an entity to which a costs award could be made and actionable against. Therefore, following a Case Management Conference held on 10 March 2015 (Mr Johnston did not attend since he was out of the country and the opponent was professionally represented by Mr Keith Arrowsmith of Counterculture

Partnership LLP) the opponent was changed to “Howard Kemp as trustee for the members of the Pandemonium Drummers Association” (“hereafter the opponent”). Mr Kemp, a member and vice chair of the Association, filed a witness statement to this effect.

3. The opposition was filed on the basis of Sections 3(6) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). This is on the basis of the opponent’s alleged earlier rights in “The Pandemonium Drummers”. It claims to have been performing under the sign since 27 July 2012 and has acquired goodwill under the sign. Use of the trade mark applied for would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

4. With regard to the section 3(6) claim the opponent argues that applicant was previously a member of the opponent’s Committee then “on 29 July 2013 it was made clear to the Applicant that he had no further responsibility in respect of the Opponent or its activities and was not to represent the Opponent in any way”. The applicant subsequently applied to register the application in the knowledge that he was not entitled to do so.

5. The applicant filed a counterstatement denying the claims made and making the following points:

- The applicant is a member and part of the Association.
- The Association is a not for profit Association with close to 1000 members.
- The Association cannot have any property rights or ownership.
- The applicant states “The Pandemonium Drummers CIC is a non profit company set up to legally represent the members of the Pandemonium Drummers and to be able to allow the Association to legally own property.”
- “There is no one person in ‘The Pandemonium Drummers Association’ that has proprietary rights over another Pandemonium Drummer”
- “Not one drummer has any rights to the name as there is no formal legal entity, all Pandemonium Drummers are equal except the Pandemonium Drummers CIC which is a legal entity with at present a sole Director being myself.”
- “Any drumming activity will be from the core members of the Association and The Pandemonium Drummers CIC will have Directors from the Pandemonium Drummers Committee. All the CIC members will be from the Opening Ceremony.”
- “Accordingly having a formal and legal arrangement protects all its members from any eventuality and it is a better model than a non legal arrangement and the Applicant who has this formal arrangement should be allowed the Trade Mark so it can be used legally and effectively.”

6. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.

7. No hearing was requested and so this decision is taken following a careful consideration of the papers.

EVIDENCE

Opponent's evidence

Witness Statement: Howard Kemp Exhibits HK1-HK8

8. Mr Kemp states that on 1 June 2012 Mr Neil Goulder created a closed Facebook group for those participating in the London Olympic opening ceremony on 27 July 2012. They were originally called "The 51ers". He states that "only verified participators of the Olympic opening ceremony were invited to join the group, since the nature and content of the performance was confidential. By the time of the opening ceremony, approximately 750 drummers had joined the group, and it remains the official means of communicating between the drummers."¹

9. It is clear that the Pandemonium Drummers' biggest performance was at the 2012 London Olympics. He states that the official name of the performance at the London Olympics was known as "Pandemonium" and the soundtrack to the ceremony was released on 28 July 2012, with the CD naming the Pandemonium Drummers as performers.

10. Mr Kemp states that 965 "members" took part in the opening ceremony which was broadcast worldwide. Mr Kemp evidences a copy of the Olympic Opening Ceremony Programme², and a copy of the track listing which refers to the "Pandemonium Drummers".

11. Mr Kemp states that other members of the group registered domain names on behalf of the Association on 26 July 2012. On 27 July 2012 a Twitter account was opened and the first 7 "tweets" have been evidenced at exhibit HK3. Each tweet is dated 27 July 2012 and one makes reference to the website pandemoniumdrummers.co.uk

12. On 8 August 2012 the Association also set up a public Facebook account. A copy of the Facebook front page is evidenced at HK4. It refers to Pandemonium Drummers as being "from 2012 opening ceremony" and includes a picture of the group.

13. Exhibit HK5 to the witness statement consists of a brochure headed "Pandemonium Drummers". The brochure is presented as one single sheet. It is not dated and does not make reference to any individual drummers or members of the Association.

14. Following the London Olympics, Mr Kemp states that the group performed at over 100 events and evidences a list at exhibit HK6. The list includes around 100 events dating from 5 August 2012 to 3 March 2014.

15. Mr Kemp states that on 10 February 2013 he convened a meeting which was attended by 50 members. 14 members were elected to take over management of the group. The first meeting of the management group was on 7 June 2013 and Mr Kemp

¹ Paragraph 3 of the witness statement

² Exhibit HK1

was elected as vice chair. He states that the applicant was selected to the management committee on that date. Mr Kemp claims that as a member of the management committee, the applicant become privy to information about the plans of the group. He does not specifically state the type of information or what impact its disclosure may have.

16. Mr Kemp then states at paragraphs 17 and 18 to his witness statement that:

“The Applicant applied to incorporate The Pandemonium Drummers Limited as a company limited by shares, and to register the trademark that is the subject to my opposition, without reference to the management committee and in breach of his fiduciary duties to the group.

The Applicant’s membership was later suspended, and he resigned. Correspondence dated 29 July 2013 stated that he was suspended “from any responsibilities within the Pandemonium Drummers (for the avoidance of doubt, this includes organising further events as well as representing the Pandemonium Drummers in any other way).”

17. A copy of the referred to correspondence dated 29 July 2013 has not been filed.

18. Mr Kemp claims that the applicant “also held himself out as the Pandemonium Drummers in dealings with the organisers of the 2014 London New Year’s Day Parade”. To evidence this Mr Kemp submits under exhibit HK8 an email from the organiser of the London New Year’s Day parade, Mr Nick Kidd, to the applicant and a copy to Jan Pearson. A copy of the email is below:

From: Nick Kidd [<mailto:nkidd@destinationevents.com>]
Sent: 16 August 2013 10:48
To: Andy Johnston
Cc: Pearson Jan
Subject: RE: LNYDP 2014

Dear Andy and Jan

There seems to be a considerable amount of confusion going on as the who, or what organisation, represents the Pandemonium Drummers.

Whereas we would really like to have the Pandemonium Drummers in The Parade, we can only do this if there is a very clear chain of official responsibility.

We have received statements from you both, but these only confuse the issue even more. Could you please both lets us know exactly what is going on, so that this issue can be resolved as soon as possible.

I do hope that you understand our position at this moment.

Yours

Nick

19. Exhibit HK7 consists of a copy of the incorporation documents of “The Pandemonium Drummers Ltd”. Company no. 8624512. It states that the incorporation date was 25 July 2013 and lists the applicant as Company Secretary and director. It also lists Mr Amonn Al-Mahrouq as another director. It is not clear who Mr Al-Mahrouq is.

Witness Statement of Neil Goulder

20. Mr Goulder is a member and “chair” of the Pandemonium Drummers Association. Mr Goulder’s witness statement is very brief. The two points of note are the following statements:

“4. I confirm that the Association has authorised Howard Kemp to hold all intellectual property relating to its name, and to protect that intellectual property for its members.”

And

“5. I also confirm that the Association has not authorised the Applicant to use or protect “Pandemonium Drummers”.”

Witness statement of Howard Kemp and exhibits HK9 and HK10

21. Mr Kemp’s second statement includes two exhibits, the first being HK9 which consists of a copy of a decision from the Office for Harmonization in the Internal Market (OHIM) dated 16 March 2015. The decision relates to an opposition against European Community Trade Mark (“CTM”) application no. 2273285 for the mark “The Pandemonium Drummers”, filed in the name of Howard Kemp. The opposition was filed by The Pandemonium Drummers Community Interest Company relying on its earlier UK application number 3016595 (the subject to this opposition) under Articles 8(1)(a)³ and 8(5)⁴. In proceedings before OHIM, where an opponent seeks to rely upon an earlier national mark (i.e. its UK application) they are required to prove its existence, validity and scope of protection. Since the opponent failed to substantiate its earlier right it was dismissed without having to consider the Article 8(1)(a) and 8(5) claims. Mr Johnston claims that since the proceedings have not been concluded no conclusions may be drawn from it.

22. Exhibit HK10: consists of statements from 69 members of the Association which Mr Kemp claims to support his opposition to the application. All of the statements are set out as “From: name” followed by a quote which are typically one paragraph long. None of the statements include a statement of truth nor do they confirm who they are and their relationship to the Association (other than being members). This exhibit and the applicant’s submissions on these statements shall be considered later in this decision.

³ Equivalent to section 5(1)(a) of the Act

⁴ Equivalent to section 5(3) of the Act

Applicant's evidence

Witness Statement of Mr Andrew Johnston and exhibits 1 to 17

23. Mr Johnston is director of The Pandemonium Drummers CIC ("CIC"). It is not stated when CIC was set up though he claims that it is intended to own property and on trust for the Association and its members. Mr Johnston is the sole director of CIC.

24. Mr Johnston states that The Pandemonium Drummers was first used in the UK in 2012 by the London Olympic Committee at the opening ceremony, though he claims that the date of first use is irrelevant since it is a not for profit organisation and that it has never been paid for its services.

25. Exhibit 1: this is headed "Comments on Opponents Observations" and consists predominantly of submissions. I shall not summarise these observations here but shall, where necessary, refer to them in the decision

26. Exhibit 2: consists of further commentary on the opponent's evidence. Mr Johnston states that exhibit HK9 (the opposition proceedings before OHIM) to Mr Kemp's witness statement "is still in process" and "is not admissible as evidence until the process has been complete." The second part to the exhibit consists of various submissions which, again, shall not be summarised here but will be referred to where necessary.

27. Exhibit 3 consists of submissions relating to the various purported statements made by various members of the Pandemonium Drummers Association at exhibit HK10. I shall specifically address the statements in Mr Kemp's witness statement and the submissions received from Mr Johnston later in this decision.

28. Exhibits 4: a letter dated 13 September 2012 from the Prime Minister, Mr David Cameron, thanking Mr Johnston for his participation in the opening ceremony of the London 2012 Olympics. Mr Johnston also received a certificate from Danny Boyle, the Artistic Director thanking him for his participation⁵.

29. Exhibit 6: an article headed 2013 "LNYDP London's New Year's Day Parade" dated 5 December 2012. The article includes the following:

"Alongside the games makers are sensational drum crew Pandemonium that wowed the World at The Opening and Closing ceremonies. Spokesman Andy Johnston said "We are terribly excited. There are literally hundreds of us that want to perform in the parade – the reaction from the group has been amazing".

30. Mr Johnston refers to exhibits 8 to 14 as consisting of promotional material prior to 3 August 2013. Brief summaries of these exhibits are as follows:

Exhibit 8: an email dated 30 December 2012 from LYNDP (London's New Years Day Parade) to Mr Johnston which appears to set out details of a Parade. The exhibit also includes information relating to the same parade.

⁵ Exhibit 5 to the witness statement

Exhibit 9: an email exchange between Suzanne Yeates of Henley Festival and Mr Johnston dated 27 February 2013. The emails appear to finalise details for the Pandemonium Drummers to perform at the festival on 10 July to 14 July 2013.

Exhibit 10: an email exchange between Gaye Barber of the Special Olympics Great Britain organisation and Mr Johnston between 26 June and 23 July 2013. It appears to organise a performance from the Pandemonium Drummers. Mr Johnston's email of 1 July 2013 states, *inter alia*, "Can you give me any suggestion of donation as we put all donation funding back into future events and as we are a group of volunteers any funding will be of a great help". Mr Barber responds with, *inter alia*, "maybe £200".

Exhibit 11: an "information pack" relating to the 2012 London Chinatown Chinese New Year Parade which was due to take place on 10 February 2013.

Exhibit 12: briefing pack for parade entries at the London St Patrick's day parade on 17 March 2013.

Exhibit 13: an email from Mr Nick Curtis of the London Evening Standard dated 18 July 2013 about a possible interview. The email is headed "drummers" and Mr Curtis states that he would like to talk about "what the drummers have all been doing".

Exhibit 14: an email from Mr Johnston to Mr Kemp and "Leonie" dated 19 July 2013. The email sets out a potential meeting between them, though Mr Johnston states that the meeting never took place.

Exhibit 15: an email exchange between "Tim" and Sophie or "Join in UK" dated 24 June 2013. The email appears to relate to some form of contract between the Pandemonium Drummers and Join In UK. It also states that Mr Johnston is "our Secretary".

Exhibit 16⁶: a Certificate of Incorporation on a change of name of company number 8624512. It states that "THE PANDEMONIUM DRUMMERS LIMITED having changed its name; is now a Community Interest Company; and is incorporated under the name of: THE PANDEMONIUM DRUMMERS COMMUNITY INTERST COMPANY". The certificate is dated 10 June 2014.

Exhibit 17: a letter from The Join In Trust Ltd to The Pandemonium Drummers c/o Andy Johnston, dated 25 June 2013. The letter is headed "Performance at "Go Local", Queen Elizabeth Park, London". The letter is a contract between the respective parties whereby the Pandemonium Drummers would be paid £3000 to perform at the Queen Elizabeth Olympic Park in London.

⁶ The witness statement refers to the Certificate of Incorporation as being under exhibit 15. However, it is marked ES15 exhibit 16.

31. The rest of exhibit 17 includes a number of emails which appear to organise performances to be conducted by the Pandemonium Drummers.

32. Finally, Mr Johnston states that prior to the filing date of the application, there were no annual sales for any goods and/or services provided by the Association.

Legislation

33. Section 3(6) of the Act states:

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

Summary of the law

34. The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C- 529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined":

see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

35. Exhibit HK10 to Mr Kemp's witness statement comprises a selection of statements by Association members supporting the opposition to the application. The applicant, under exhibit 3 of Mr Johnston's witness statement, provides commentary on these statements. As previously stated they do not include a statement of truth. Therefore, I consider this evidence to be hearsay which is admissible under rule 64(1)(b) of the Trade Marks Rules 2008, but its weight has to be assessed according to the various factors set out in section 4 of the Civil Evidence Act 1995:

Section 4 of the Civil Evidence Act 1995 permits hearsay evidence in civil proceedings but provides the following guidance as to the weight to be accorded to such evidence:

"Considerations relevant to weighing of hearsay evidence.

(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following -

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

(c) whether the evidence involves multiple hearsay;

(d) whether any person involved had any motive to conceal or misrepresent matters;

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight."

36. The filing of a hearsay statement inherently comes with the risk that the tribunal may assess its weight at a lower level than that which the party considers it should carry. An aspect which affects the weight of the particular evidence in this case is that

it has been solicited for the proceedings. The applicant has sought to respond to the content though I did not consider it necessary to outline this in my evidence summary. In my view, the hearsay evidence carries little weight. Since Mr Kemp was able to acquire statements from each person it seems equally practical for original statements to have been provided. Further, it is not clear what the relationship between each party and the opponent is (other than being members) and giving such evidence any weight with the applicant not having the opportunity to cross-examine the statements appears unjust.

Was the application filed in bad faith?

37. I must assess the ground of bad faith at the relevant date and take into consideration what the applicant knew at that point. However, I may also take evidence into account which casts light backwards on the position at the relevant date⁷. In other words what did the applicant know at the date of filing the application, does any subsequent evidence clarify the position and did filing the application fall short of acceptable commercial behaviour.

38. The applicant has repeatedly stated that an association cannot hold any property, nor can any members hold property in trust for that association. The question before me is not whether an association may hold a trade mark application or not. The question is whether Mr Johnston's intentions, upon filing the application, fell short of honest commercial behaviour and was therefore filed in bad faith. However, I should point out that if an application is made on behalf of an unincorporated association, which may not be capable in itself of owning a trade mark, specified persons may be appointed to act as trustees for the association (the UK Trade Marks Registry Work Manual specifically addresses this point).

39. Mr Johnston argues that he set up the Pandemonium Drummers CIC Ltd in order to protect the legal interests of the Association. He claims that the trade marks would therefore be placed into its ownership. However, the trade mark application was filed in Mr Johnston's own name. Further, he is the sole director of Pandemonium Drummers CIC Ltd therefore whether the trade mark remains in his name or is assigned to the aforementioned company, he would have sole control.

40. In BL O/094/11 *Ian Adam*, the Appointed Person (Mr Geoffrey Hobbs QC) said at paragraph 33:

"The line which separates legitimate self-interest from bad faith can only be crossed if the applicant has sought to acquire rights of control over the use of the sign graphically represented in his application for registration in an improper manner or for an improper purpose."

41. In my view, the applicant's actions crossed the line. Mr Johnston was a member of the Association and spent considerable time playing and promoting the drummers' activities. He then applied to incorporate The Pandemonium Drummers Limited as a company limited by shares (25 July 2013) with Mr Johnston being secretary and

⁷ *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41]

director along with Mr Al-Mahrouq. The Association considered Mr Johnston's incorporation of the Association to be a breach of his fiduciary duties and subsequently suspended his membership. On 29 July 2013 the Association wrote to Mr Johnston stating that he was suspended "from any responsibilities within the Pandemonium Drummers (for the avoidance of doubt, this includes organising further events as well as representing the Pandemonium Drummers in any other way)."

42. Shortly afterwards (3 August 2013) Mr Johnston in the knowledge that he was suspended from the Association and not permitted to act on its behalf applied to register the application.

43. Mr Kemp and Mr Goulder, vice-chair and chair of the Association respectively, both state that Mr Johnston was not entitled to act or hold property on behalf of the Association. Mr Johnston was aware of this but nevertheless filed a UK trade mark application, i.e. a UK monopoly to the name "Pandemonium Drummers", for the services of interest to the Association (class 41). Mr Johnston also set up CIC which he claims would be beneficial to the Association, despite no longer being a member (he does suggest that he still is). In my view, applying for the trade mark application in his own name when he knew that he was not entitled to do so was an act of bad faith. Setting up CIC, which he is a sole director, further confirms that his intentions were for him to maintain control over the name Pandemonium Drummers.

44. Further, Mr Johnston subsequently used the trade mark application to oppose CTM application no. 2273285 in the name of Mr Kemp (on behalf of the Pandemonium Drummers Association). Whilst the opposition was filed after the relevant date, it does cast light backwards on the applicant's intentions at the relevant date.⁸

45. The applicant claims that the OHIM decision is inadmissible to these proceedings since the opposition is yet to be concluded. Whether the opposition ultimately succeeds or not is irrelevant to this opposition. The fact remains that the applicant, through CIC, which he is the sole director, objected to Mr Kemp's trade mark application causing disruption to the Association's activities and whilst in the knowledge that he is not the rightful owner.

46. The applicant does argue that Mr Kemp, the vice-chair of the Association, is not entitled to hold property on trust for the Association. However, the chair of the Association, Mr Goulder, states that Mr Kemp has been authorised to hold all intellectual property on behalf of its members. Many Associations and informal groups do not have formal agreements relating to any intellectual property rights but they may elect individuals within the Association or group to hold such rights on its behalf. Whilst this approach may create certain legal difficulties should Mr Kemp decide to behave inappropriately, this is not the case here and is the approach that the Association appears to be content with.

47. It does not appear that the applicant is seeking financial gain, however Mr Johnston clearly seeks to maintain sole control when he is not entitled to do so and disrupt the Association's activities. He has acted in bad faith. **The section 3(6) claim succeeds.**

⁸ *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41]

Section 5(4)(a)

48. Since I have already found the opposition to be successful against the application in its entirety, I am not required to determine this matter under section 5(4)(a).

CONCLUSION

49. The opposition succeeds. Subject to appeal, the application shall be refused in its entirety.

COSTS

50. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1100 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

| | |
|---|--------------|
| Official fee | £200 |
| Preparing a statement and considering the other's statement | £300 |
| Preparing evidence and considering and commenting on the other's evidence | £600 |
| Total | £1100 |

51. I therefore order Andrew Johnston to pay Howard Kemp as trustee for the members of the Pandemonium Drummers Association the sum of £1100. The above sum should 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 March 2016

MARK KING
For the Registrar,
The Comptroller-General