

O-164-04

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2295353
BY PAUL HIGGINS
TO REGISTER THE TRADE MARK
LATCHMERE THEATRE
IN CLASS 41

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 90869
BY CHRIS FISHER

BACKGROUND

1) On 14 March 2002, Paul Higgins of The Latchmere, 503 Battersea Park Road, London, SW11 3BW applied under the Trade Marks Act 1994 for registration of the trade mark LATCHMERE THEATRE in respect of the following services in Class 41: "Production of theatre plays, comedy, film, cabaret and live entertainment".

2) On 24 July 2002 Chris Fisher filed notice of opposition to the application. The grounds of opposition are in summary:

i) The opponent has made substantial and continuous use of the trade marks LATCHMERE and LATCHMERE THEATRE in the UK since 1985 in respect of a theatre venue, and various theatre services such as management, production, tours, hiring of equipment, script development and consultancy. By virtue of this use the opponent has acquired a substantial reputation and goodwill in respect of all the services applied for by the applicant. Registration of the mark is liable to be prevented by the law of passing off and could therefore be contrary to Section 5(4)(a) of the Trade Marks Act 1994.

ii) The applicant was aware of the opponent's prior use of the mark in suit and so the application should be refused under Section 3(6) as it was made in bad faith.

3) The applicant subsequently filed a counterstatement denying all of the grounds of opposition.

4) Both sides ask for an award of costs and both sides filed evidence in these proceedings. The matter came to be heard on 7 April 2004 when the opponent was represented by Mr Edenborough of Counsel instructed by Messrs Abel & Imey. The applicant was represented by Mr Preedy of Messrs Hallmark IP Ltd.

OPPONENT'S EVIDENCE

5) The opponent filed seventeen witness statements. The first, dated 6 February 2003, is by Chris Fisher who describes himself as a "professional theatre practitioner". Mr Fisher states that he has worked continuously in the entertainment industry since 1979.

6) Mr Fisher states that in October 1985 he agreed with the owner of the Latchmere public house in Battersea to run the theatre that was above the pub. Previously known as "The Gate at the Latchmere" Mr Fisher ran the venue on a freelance basis under the name of Latchmere Theatre. He states that a few years later he acquired an independent lease on the venue and operated it autonomously as his own business until it closed in 1992. During the period 1985 - 1992 every visiting company that rented the venue had, on its publicity material, to carry the name of the Latchmere Theatre and also Mr Fisher as theatre director. The publicity had to conform to "the house style". At exhibit CF1 he provides copies of the rental contracts showing this stipulation, and at exhibit CF2 are examples of the publicity materials produced during the period.

7) Mr Fisher states that the business was also a theatre club with branded tickets and club cards which also carried his name. He claims that "in short, for seven years, my business the Latchmere Theatre was unique among all London fringe theatres in respect of its distinctive branding, its clear identity, and a reputation (and club following) linked to one single person, myself".

8) Mr Fisher states that in 1987 he formed the theatre company London Actors Theatre Company (LATC). This became a limited company in May 1988 and is a registered charity. Mr Fisher states that he chose the name carefully so that the acronym would create a link between the producing company's name and the already well-established theatre brand 'Latchmere'. At exhibit CF4 he provides examples of letterhead paper for the Latchmere Theatre, LATC and a joint letterhead.

9) Mr Fisher states:

I have continuously used the Latchmere Theatre letterhead for all my theatre activities since 1987. I have been continuously a director and Company Secretary of London Actors Theatre Company, from incorporation in 1987 to the present day. This limited company and its activities remain inexorably linked to my trading name Latchmere Theatre, the history of the venue under the name Latchmere, and the continuous theatre related activities up to the present day.

10) At exhibit CF5 he provides a number of brochures publicising shows. Mr Fisher states that these show that there was a distinction between the Latchmere Theatre as a venue, his business as producer and LATC as the production company. These documents mention that Mr Fisher was the Director of the Latchmere Theatre in Battersea, and that LATC were based at the theatre. The brochures are not all dated, those that are date from 1986-91.

11) Mr Fisher claims In addition to and separate from LATC and dealing with the period 1995 onwards, my business the Latchmere Theatre has continued to be involved in theatre production. He names a number of plays covering the period 1995-2000. At exhibit CF6 he provides a letter from a Mr Paddy Wilson who confirms that Mr Fisher worked on the plays as claimed. At exhibit CF7 is a piece of publicity material for one of the plays which has Mr Wilson listed as one of the Directors and named as Project Consultant is Chris Fisher for Latchmere Productions. At exhibit CF8 are a number of invoices from Chris Fisher t/a Latchmere Theatre to Paddy Wilson in regard to consultancy work on various shows between March 1998- April 2000.

12) Mr Fisher states that during the period 1998-2001 his business acted as an independent assessor and monitor of Lottery-funded projects. During 1999 he also acted as a consultant to a music promoter. At exhibit CF9 are sample invoices covering the period January 1998- July 2001 which are headed Chris Fisher t/a Latchmere Theatre. These show that Mr Fisher travelled throughout the UK visiting various theatrical groups and schools as part of his consultancy work.

13) Mr Fisher also claims that he has developed theatre, television, radio and film scripts with a number of writers. At exhibit CF10 & CF11 he provides letters from two writers who state that Mr Fisher has assisted in developing work for production. Further letters at exhibit CF13, CF14 and CF15 also show that Mr Fisher has been trading under the name Latchmere Theatre.

14) Mr Fisher states that he registered the trade mark LATCHMERE in August 1993. At exhibit CF18 he provides a copy of the registration certificate. The mark was registered under number 1508557 for:

Provision of entertainment relating to drama, plays, comedy, variety, dance, ballet, mime,

musicals, operas, operettas, burlesques, recitals, poetry, magic and illusions; theatre services; cabaret services; music hall services; music concert services; puppet show services; production of sound and video recordings, radio programmes and television programmes; directing, acting, dancing and choreography services; organisation of conferences, classes, lectures and seminars; hiring out of a theatre for conferences, classes, lectures and seminars; publishing services, all relating to the aforesaid; all included in Class 41@

15) Mr Fisher states that the mark lapsed as he did not realise that he had to renew the mark and as he had not informed the Registry of his change of address he did not receive the reminder letter. Mr Fisher describes, at some length, his dealings with various parties who have tried to use the term **Latchmere Theatre** or even the word **Latchmere** in relation to theatre activities or venues. He states that before surrendering the tenancy of the venue he agreed with the then proprietors, Grand Metropolitan plc, that all rights in the use of the trading name Latchmere were left in his sole possession and that the venue would not be renamed the Latchmere Theatre or any name that might be confused with the Latchmere Theatre. At exhibit CF16 he provides a copy of the agreement.

16) At exhibit CF21 Mr Fisher provides copies of **The Spotlight** from 1986- 2002 each of which has an entry under Latchmere Theatre with Mr Fisher's name underneath. The Spotlight is stated to be a standard reference used by casting professionals used by film, television and theatrical companies.

17) At exhibits CF22, CF23 and CF24 Mr Fisher provides copies from the applicant's website and also brochures which refer to the **relaunch** of the theatre and of celebrating the theatre's 20th anniversary. Mr Fisher states that this shows that the applicant is trading on his goodwill. Mr Fisher states that having become aware that a sign **Latchmere Theatre** had been placed on the Latchmere pub he contacted the applicant. He states that he had numerous conversations with the applicant who attempted to placate him, but as time went on Mr Fisher believed that this was prevarication.

18) Mr Fisher states that he has been contacted by various individuals who assumed that he had returned to his original venue and wanted to either wish him well or to purchase tickets. At exhibits CF25 and CF26 he provides two letters which show that individuals in the theatrical business believed that he was involved in the **new** Latchmere Theatre.

19) Lastly, Mr Fisher states that the applicant implies that **his** management of the venue is a seamless transition from my successful tenure at the venue to his - omitting the ten year intervening period during which the venue was called The Grace. @At exhibit CF22 he provides a copy of the applicant's website. This mentions that the theatre is being re-launched by a new team and restoring its former glory.

20) The second witness statement, dated 4 February 2003, is by Frank Fisher a Director of Fisher M & C Ltd. He is the brother of the opponent and although not involved in any of the opponent's theatre activities he shares an office with him. Mr Frank Fisher states that, since March 2002, he has fielded on average two or three calls a week which relate to the applicant's business.

21) The third witness statement, dated 25 February 2003, is by Mervyn Millar a theatre director and manager. He states:

ASometime early last year, I cannot remember precisely when, I spoke to Paul Higgins about my experience at the Grace Theatre and he explained he was planning to re-name or re-launch the venue as the Latchmere Theatre. I explained to him that I believed that the Latchmere is or was a name that Chris Fisher had a continuing interest in, and suggested he speak with Chris@

22) The opponent also filed witness statements by the following:

- \$ Anwar Akhtar, dated 6 February 2003, Director of Rich Mix, previously Senior Projects Officer at the Arts Council of England.
- \$ Armand Gerrard, dated 11 February 2003, theatre manager.
- \$ Jonathon Cushley, dated 17 February 2003, actor and freelance writer.
- \$ Paddy Wilson, dated 25 February 2003, theatre producer.
- \$ Ron Phillips, dated 27 February 2003, playwright and theatre director.
- \$ Kjartan Poskitt, dated 27 February 2003, writer, playwright, musician and TV presenter.
- \$ David Bidmead, dated 28 February 2003, theatre owner, manager and producer.
- \$ Randhi McWilliams, dated 19 February 2003, writer, director and songwriter.
- \$ Beverly Foster, dated 4 March 2003, actress.
- \$ David McGillivray, dated 4 March 2003, writer, journalist and broadcaster.
- \$ Sebastian Breaks, dated 27 February 2003, theatre producer and actor.
- \$ Leonie Scott-Matthews, dated 6 March 2003, theatre company manager.
- \$ Phil Willmott, dated 27 February 2003, writer and theatre director.
- \$ Edward Rhodes dated 4 March 2003, writer, actor and script editor.

23) All of them confirmed that they associated Chris Fisher with the Latchmere Theatre during the period 1985-1992. Eight of the witnesses state that they have worked with, or know of, Chris Fisher t/a Latchmere Theatre in a variety of theatrical activities subsequent to 1992 and his leaving the venue at Battersea. These activities include producer; theatre, arts and business consultant and as a production company. A few also stated that they assumed that the opponent was connected with the applicant's business as they associate the name Latchmere Theatre with Mr Fisher.

APPLICANT'S EVIDENCE

24) The applicant filed twelve witness statements. The first two, dated 6 June 2003 and 30 July 2003, are by Paul Higgins.

25) Mr Higgins states that in autumn 2001 he noticed the Grace Theatre above the Latchmere pub. He states that it appeared to be slightly run down. He contacted the company who ran the Latchmere pub and came to an agreement with them to take over the theatre and also to change its name to the Latchmere Theatre. Mr Higgins states that he then decided to research the history of the theatre. He found that it had started in 1982 as the Gate Theatre at the Latchmere, during the years 1982 to 1985 it was also referred to as the Latchmere Theatre. Mr Higgins claims that even after the opponent had left the theatre it was still referred to as the Latchmere before becoming the Grace Theatre. At exhibits PH4 - PH6 he provides brochures which show the

progression in names. At exhibit PH7 he provides cuttings which do show that the theatre was, between 1982-1996, referred to as **The Latchmere**, **The Grace at the Latchmere**, **Latchmere** and in July 2000 as the **Latchmere Pub**.

26) Mr Higgins points out that the opponent used letter headed paper which showed a stamp with the legend **Ten years of success 1982 - 1992**. Mr Higgins states that his research at the Theatre Museum shows that the theatre changed its name in 1992 from **Latchmere Theatre** to the **Grace Theatre at the Latchmere**. He states that the museum houses brochures for all productions in the UK and that after 1992 there is no evidence in the museum of any further productions being staged at a theatre called the **Latchmere Theatre** anywhere in the UK.

27) Mr Higgins states that he found no reference to **Latchmere Theatre** in BT Directories, the Yellow Pages, Royal Mail Postal Address Book, The British Theatre Directory, or the British Performing Arts Year Book. He states that he did look in the Contacts book (Spotlight) referred to by the opponent but he looked only in the **Outer London, Fringe, Club, Academy & Venues** and the **Theatre Producers** sections whereas the opponent's evidence shows a listing in the **Theatre-Alternative, Community & Young People's** section. Mr Higgins states that this section lists mainly **educational, student and community theatres** and as a result wasn't an obvious place for me to look. He disputes the opponent's claim to be listed in the BT directory and at exhibit PH9 he provides copies of the relevant pages from the October 2001 BT Phone Book for **London Business & Services**, the October 1998, April 1997 and May 1994 **Phone Book: London Postal Area business and service numbers** and the **Royal Mail Postal Address Book for London for 1995-1996**. Also provided are copies of the relevant pages from the **British Theatre directory** 1998 & 2001, and the **British Performing Arts Yearbook** 1999/00 and 2000/01. None contain a reference to the opponent or the Latchmere Theatre.

28) Mr Higgins states that he has received a number of letters from the opponent in the course of the dispute, one of which is provided at exhibit PH12. He states that the letter head shows a phone number which begins 071 when the code for London changed on 16 April 1995 to 0171. This change is verified at exhibit PH11 by a print out from the BT website. Mr Higgins states that this shows that the opponent is using paper which is eight years old and that very little use of such headed note paper has been made since the opponent vacated the premises above the Latchmere pub in 1992. At exhibit PH13 Mr Higgins provides a business card which was attached to correspondence received from the opponent. This card shows the name **Fisher M & C Ltd** and has no reference to Latchmere Theatre.

29) Mr Higgins then details at considerable length all of the organisations he has contacted since December 2001 **spreading the word to the theatre industry of my plans**. These included Writernet, various literary managers and writers, Wandsworth Business Advice Centre, and East Battersea Discussion Group. He states that no-one commented on the proposed name change of the theatre.

30) Mr Higgins states that in February 2002 he spoke to Neil McPherson who alerted him to the potential interest of the opponent in the mark in suit. Mr McPherson provided the applicant with Mr Fisher's phone number and address and suggested that Mr Higgins contact him. Mr Higgins checked the Trade Mark Register via its website and found that the trade mark registered by Mr Fisher had lapsed. However, he did try, on 25 February 2002 to contact the opponent, leaving a

message with Mr Fisher's brother. He spoke with the opponent on 12 March 2002 when Mr Fisher informed him that the name of the theatre would have to be changed. Mr Higgins agrees that he spoke to the opponent on a number of occasions but was not prevaricating, rather he was trying to find out more regarding trade marks.

31) Mr Higgins states that the Latchmere Theatre was being referred to in the press and building a reputation prior to the involvement of Mr Fisher in 1985. He also states that he has found no evidence of use of the mark by the opponent since 1992 in the press, theatre programmes or in various directories. Mr Higgins states that he began using the mark in suit on 13 December 2001. Mr Higgins agrees that the London Actors Theatre Company (LATC) has been involved in several plays recently but he has been unable to find any evidence of use of Latchmere Theatre by the opponent despite further research. He searched specifically with regard to certain plays that Mr Fisher stated that he was involved in but there was no reference in the programmes of Latchmere Theatre.

32) Mr Higgins comments that in the alleged agreement referred to by the opponent with Grand Metropolitan plc, the agreement shows at paragraph 9 that use of the word "Latchmere" in the title of the theatre has to be distinguishable from "The Latchmere Theatre" for five years. Mr Higgins states that this condition was met by use of "The Grace Theatre at the Latchmere" from 1992 to 1999. He points out that the agreement provided in evidence is not signed by both parties and that he could not have been aware of such an agreement. He also criticises other aspects of the opponent's evidence, which I have not detailed as I have dealt with the issues raised in my summary of the opponents evidence above.

33) Mr Higgins refutes the claim that the theatre above the Latchmere pub began to fail when Mr Fisher left. At exhibit PH46 he provides press cuttings which show that certain critics were impressed by plays staged at the venue. These cuttings are dated June 1993- January 2001. The venue was referred to as one of the following: "The Grace Theatre", "Grace Theatre at the Latchmere Pub", "Grace Theatre at the Latchmere".

34) Lastly, Mr Higgins states that to succeed in a passing off case the opponent needs to show that damage has been caused, and he claims that the reviews he has received have been very good and could not have damaged the opponent.

35) The applicant also filed witness statements from the following:

- \$ Mervyn Millar, dated 2 June 2003, Professional Theatre Director.
- \$ Phil Willmott, dated 4 June 2003, Writer and Theatre Director.
- \$ Neil McPherson, dated 23 July 2003, Artistic Director.
- \$ Paul Millar, dated 30 July 2003, Theatre Director.
- \$ Sarah Dickenson, dated 28 July 2003, freelance Information and Research Officer at Writernet.
- \$ Jonathan Meth, dated 5 August 2003, employed by Writernet.

36) All the above state that they know of the opponent. They also state that they are not aware of the name "Latchmere Theatre" being used as the name of a theatre or anything connected to the theatre business after 1992/3.

37) The applicant also filed witness statements from:

- \$ Jack Bradley. Undated, the Literary Manager of the Royal National Theatre. He states that he only ever associated the name **Latchmere** with the venue above the Latchmere Pub.
- \$ Graham Allan Feakins, dated 4 August 2003, a Patent Attorney. He confirms that in 1999 he carried out a search for a friend and found that the name Latchmere was registered as a trade mark. He therefore advised his friend to choose another name.
- \$ Andrew Connolly, dated 4 August 2003, the Executive Director of New End Theatre. He confirms that he wanted to change the name of the Grace Theatre to the Latchmere Theatre in 1999, but did not do so following the advice of Mr Feakins.

38) The applicant also filed a witness statement, dated 6 August 2003, by Francis Preedy the applicant's Trade Mark Attorney. Mr Preedy states that he received a letter from the opponent which showed an address and phone number for the opponent which were incorrect, also parts had been amended by hand. Mr Preedy states that the use of very old paper shows that there has been no real attempt to protect the name for some considerable time.

39) Mr Preedy details efforts made by his company and the applicant to settle the dispute amicably. He states that he also carried out research into the use of the name Latchmere but could find no trace of any use. He also states that the Internet site for YELL.COM (Yellow pages) was first searched in July 2002 when it showed no reference for **Latchmere**. When this site was searched in February 2003 there was a reference under Latchmere relating to the opponent. Mr Preedy states that the confusion referred to by the opponent probably arose from this recent addition to the directory.

40) Mr Preedy states that he contacted Mr Grace the owner of the theatre immediately after Mr Fisher and also the partnership which took over the venue from Mr Grace. These parties confirmed that the reason for not using the name **Latchmere** was not based upon the recognition of any goodwill attached to the name as claimed by the opponent. Mr Grace changed the name to honour his father whilst the partnership did not use the name **Latchmere** as there was a current trade mark registration.

OPPONENT'S EVIDENCE IN REPLY

41) The opponent filed two witness statements in reply. Both are by Mr Fisher who has provided evidence earlier. The statements are dated 6 November 2003 and 18 December 2003.

42) Mr Fisher states that he is not surprised that the applicant should not know of his (Mr Fisher's) recent work under the **Latchmere Theatre** name as this work has been with prestigious theatre groups not minor fringe theatre groups. He states that:

It is a remarkable fact that my business Latchmere Theatre is remembered in the business for over a decade after it left the theatre in Battersea.

43) Mr Fisher states that he now deals with a relatively small circle of elite theatre producers, producing venues, regional theatres, and blue-chip clients such as Arts Council England. This explains his absence from various directories as he does not wish to be inundated with unsolicited calls and correspondence. At exhibit CF28 he provides copies of phone bills for the period August 1993- October 2000 which are addressed to Chris Fisher T/A Latchmere Theatre.

44) At exhibit CF27 Mr Fisher provides copies of programmes and press cuttings which show that in the period April 1992 - Feb 2001 the venue was referred to in the following ways: Grace, Grace Theatre, Grace Theatre at the Latchmere, Grace Theatre at the Latchmere Pub, The Grace Theatre, The Latchmere and Grace Theatre (formerly The Latchmere).

45) Mr Fisher states that he still uses the old headed paper as it is uneconomical to have it reprinted, especially when most of his paper work is computer generated and so he has little need for printed letter headed paper. He states that he has five e-mail aliases which all come to a single server in his office. He states that his reputation is not built on public recognition but on that of his fellow professionals.

46) Mr Fisher points out that Mr Grace renamed the venue to the Grace Theatre in February 1992, over five months before Mr Fisher filed his trade mark application.

47) At exhibit CF34 Mr Fisher provides two pieces of correspondence intended for him but delivered to the applicant. The items were invitations to productions which Mr Fisher received after the date of the performance. He states that these could have been business opportunities for him and that these are clear evidence of damage being caused to his business.

48) That concludes my review of the evidence. I now turn to the decision.

DECISION

49) I turn first to the ground of opposition under Section 5(4)(a) which states:

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

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.

50) In deciding whether the mark in question LATCHMERE THEATRE offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] 14 RPC 455. In that decision Mr Hobbs stated that:

The question raised by the Grounds of Opposition is whether normal and fair use of the

designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd - v - Borden Inc* [1990] RPC 341 and *Even Warnik BV - v - J. Townend & Sons (Hull) Ltd* [1979] AC 731 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.-@

51) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been ~~acquired~~ acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed....@ The relevant date is therefore 14 March 2002, the date of the application.

52) With these considerations in mind I turn to assess the evidence filed on the behalf of the parties in the present proceedings as set out earlier in this decision, and the arguments put forward at the hearing.

53) The opponent has shown that in 1985 he took over a theatre venue and changed its name to Latchmere Theatre. He ensured that the name was used on all publicity and by 1992 had built up a considerable reputation in the mark. In addition to identifying the venue the mark was also used during this period as his personal trade mark when acting as a producer. Indeed, in August 1993 he registered the mark in the UK for a range of entertainment linked activities (see paragraph 14). Upon his departure from the actual theatre in Battersea he ensured that the name changed in order to protect his intellectual property rights. In the ensuing years he has shown that he has

worked as a consultant on a number of successful productions. He has also provided a large number of invoices which show that during the period January 1998 - July 2001 he worked throughout the UK as a consultant for the Arts Council of England. He visited various theatres and schools which had received lottery funding. The invoices also show work carried out for a music promoter. All the invoices bear the legend "Chris Fisher t/a Latchmere Theatre". He has also provided copies between 1986 - 2002 of a trade guide, "Spotlight", which shows an entry for Latchmere Theatre with Mr Fisher's name below together with copies of telephone bills which show him to have traded as "Latchmere Theatre" between August 1993 and October 2000.

54) The opponent also filed a considerable number of witness statements from individuals within the entertainment industry. These all stated that they were aware of Chris Fisher and his work in the Battersea venue during the period 1985-1992. Two of the deponents also provided statements for the applicant. Their statements are contradictory, and in the absence of cross-examination, I attach no weight to the statements of Mervyn Millar or Phil Willmott. However, even discounting the statements of these two individuals, seven of the witnesses state that they have worked with, or know of, Chris Fisher t/a Latchmere Theatre in a variety of theatrical activities subsequent to his leaving the Battersea venue in 1992.

55) The applicant contended that the deponents knew of the opponent's activity in the Battersea venue in the period 1985-1992, and were automatically linking the opponent to his halcyon days. I do not accept this contention as, whilst clearly acknowledging the opponent's time at the Battersea venue, the seven deponents refer also to recent work by Latchmere Theatre. Most also make a clear reference to the opponent leaving the Battersea venue in 1992.

56) Further, the applicant contended that the opponent has a very narrow band of clients, and that the opponent had not shown goodwill amongst the general public. This is based in part on the opponent's own description of his activities. Mr Fisher stated that his recent work had been with a relatively small circle of elite theatre producers, producing venues, regional theatres and blue-chip clients such as the Arts Council of England. The opponent made this statement in response to claims that his name was not in many standard directories which the applicant had studied prior to making the application in suit.

57) I was referred to the decision by the Registry, reference BL 0-048-04 (*Barney's*). In that decision the Hearing Officer stated at paragraphs 45 & 46:

45. In my view the opponents' evidence provides no more than a suggestion that they may have a reputation and/or goodwill within the UK. In the *Radio Taxicabs (London) Limited v Owner Drivers Radio Taxi Services Limited* [2001] WL 1135216, Mr John Randall Q.C. sitting as a Deputy Judge of the High Court, considered a passing off claim on the basis of goodwill in the name RADIO CABS, making various comments, inter alia, that he was faced with "the total absence of evidence from members of the wider public". The judge went on to find that the burden of proving reputation with the general public lay on the claimant, stating at paragraph 96 of his decision:

I consider it possible that the claimant may have built up a sufficient reputation in the ways relied upon but I cannot conscientiously put it any higher in the claimant's favour than that.....Thus, one is left to speculate. Speculation is not

enough. At the end of the day the burden of proving on the balance of probabilities, the requisite reputation with the general public in the name **ARadio Taxis** lies on the claimant and I find that the claimant has not discharged it.

46. Where Mr Randall QC refers to the **Awider** or **Ageneral** public, I believe it is appropriate to read **Athe relevant consumer of the goods in question**.

58) I whole heartedly adopt the above position. However, in these cases both before the Registry and the High Court the claimants had filed no evidence at all of trade within the UK. Whereas in this case the opponent has provided evidence of use by way of invoices, telephone bills, directory entries and by independent trade witnesses. Thus, they are not on all fours with the instant case.

59) The Hearing Officer in the above case stated that it is the relevant consumer of the services in question that must be considered. Mr Preedy, for the applicant, contended that the general public were the relevant consumers since it was they who went to see the productions. I do not accept this contention. The opponent has been working as a consultant to producers, theatres, theatre companies and smaller fringe theatre groups. He has also worked for the arts establishment in the guise of the Arts Council for England. Clearly his clients are the theatrical industry and not the general public. In my view the general public will decide to see a show or a film based on either the title/subject matter, the star involved or the composer. Whereas the latest Stephen Spielberg blockbuster or Andrew Lloyd-Webber show will cause interest, I doubt that many will be aware of the producer of any given film, play or show. Within the relevant consumers the opponent has shown that he enjoys considerable goodwill under the trade name Latchmere Theatre.

60) The applicant seeks registration for the following specification: **AProduction of theatre plays, comedy, film, cabaret and live entertainment**. Clearly, in my opinion, this specification is similar to, and overlaps in part with, the activities carried out by the opponent. The evidence shows clearly that there has already been some confusion with the opponent receiving communications intended for the applicant.

61) Taking all of the above into consideration it is my opinion that the opponent has shown that he has reputation and goodwill, amongst the relevant public, in the name **ALatchmere Theatre** in relation to a variety of theatrical activities and services. Further, I am persuaded that if the applicant were to use the mark in suit that there would be misrepresentation with the relevant public believing that the services of the applicant were from or connected in trade with the opponent. Clearly, the opponent would suffer damage from such misrepresentation. The opposition under Section 5(4)(a) therefore succeeds.

62) I now turn to the ground of opposition based on Section 3(6), which reads:

A3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

63) The Act does not define the meaning of **Abad faith**. Subsequent case law has avoided explicit definition, but has not shirked from indicating its characteristics. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J stated at page 379:

AI shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes 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. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.®

64) In the Privy Council judgement *Royal Brunei Airlines Sdn Bhd v Tan* [1995] 2 AC 378, Nicholls LJ described dishonesty as A..to be equated with conscious impropriety®. This was in the context of accessory liability in the misapplication of trust assets to the detriment of a beneficiary. However, I think the same general principles would apply in trade mark law. He added:

AIIn most situations there is little difficulty in identifying how an honest person would behave. Honest people do not intentionally deceive others to their detriment. Honest people do not knowingly take others=property..... The individual is expected to attain the standard which would be observed by an honest person in those circumstances. It is impossible to be more specific. Knox J captured the flavour of this, in a case with a commercial setting, when he referred to a person who is AgUILTY of commercially unacceptable conduct in the particular context involved®. see *Cowan de Groot Properties Ltd v Eagle Trust Plc* [1992] 4 All ER 700 at 761. Acting in reckless disregard of others=rights or possible rights can be a tell-tale sign of dishonesty. An honest person would have regard to the circumstances known to him, including the nature and importance of the proposed transaction, the nature and importance of his role, the ordinary course of business, the degree of doubtUltimately, in most cases, an honest person should have little difficulty in knowing whether a proposed transaction, or his participation in it, would offend the normally accepted standards of honest conduct.®

65) Thus, dishonest behaviour is characterised by intention and/or recklessness. Such conduct would clearly be bad faith. It is also obvious, however, from the *Gromax* judgement, that bad faith also describes business dealings which, though not actually dishonest, still fall short of the standards of acceptable commercial behaviour. This includes conduct that is not knowingly fraudulent or illegal, but may be regarded as unacceptable or less than moral in a particular business context and on a particular set of facts. In *Demon Ale Trade Mark* [2000] RPC 355, the Appointed Person said:

AI do not think that Section 3(6) requires applicants to submit to an open-ended assessment of their commercial morality. However, the observations of Lord Nicholls on the subject of dishonesty in *Royal Brunei Airlines Sdn Bhd v Phillip Tan* [1995] 2 AC 378 (PC) at page 389 do seem to me to provide strong support for the view that a finding of bad faith may be fully justified even in a case where the applicant sees nothing wrong in his own behaviour.®

66) I also take into account the comments by Mr Simon Thorley Q.C. acting as the Appointed Person in *R. v. Royal Enfield Trade Marks* [2002] RPC 24 at paragraph 31 where he said:

An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning M.R. in *Associated Leisure v Associated Newspapers* [1970] 2 Q.B. 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v. Garrett* (1877-78) L.R. 7Ch.D 473 at 489). In my judgement precisely the same considerations apply to an allegation of lack of good faith made under section 3(6). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference.@

67) The relevant facts before me are as follows:

- \$ Mr Higgins carried out searches of various directories without finding any reference to the opponent. He also searched in the Theatre Museum but found no trace of any use of the mark in suit. The directory ASpotlight@ which does have a listing for the opponent was amongst those searched but it has numerous sections and Mr Higgins missed the one entry for the opponent.
- \$ Mr Higgins was informed by a third party of the opponent's interest in the mark and two days prior to filing the application he had a telephone conversation with the opponent, during which the opponent made clear his residing interest in the mark.
- \$ In his first statement the applicant claims that the theatre appeared slightly run down. However, when a number of deponents for the opponent stated that the theatre fell into decline following the departure of the opponent in 1992, Mr Higgins claims that the theatre was a critical success during the period 1992- 2001.
- \$ Mr Higgins states that on the number of occasions that he spoke to the opponent he was not prevaricating but was trying to find out more regarding trade marks. However, these further conversations took place after he had filed his trade mark application.
- \$ Mr Higgins was aware that the opponent had registered the trade mark and that it had lapsed, prior to filing his application.

68) If the venue was the critical success that Mr Higgins claimed in his last statement then his decision to change the name of the theatre is puzzling. As someone just starting up in the business it would surely have been logical to retain the existing name and any goodwill or reputation that existed. He claimed to be trying to find out more about trade marks, yet he had already searched the Trade Mark Registry and found that the opponent's mark had lapsed. He had also carried out a number of searches albeit without success. These appear to be the actions of someone with a reasonable knowledge of trade mark matters.

69) Having been informed that the opponent might still have an interest in the mark by a third party he conversed with the opponent and was informed that the mark had been in continual use and that the opponent traded under mark in suit. Yet two days later he filed his application.

70) Taking all of the above into consideration I have come to the conclusion that Mr Higgins acted in bad faith when applying for the trade mark. He was aware of the opponent's business under these marks in the UK and his behaviour falls short of the standards of acceptable commercial behaviour. The ground of opposition under Section 3(6) succeeds.

71) The opposition having succeeded the opponent is entitled to a contribution towards costs. I therefore order the applicant to pay the opponent the sum of , 3000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of June 2004

George W Salthouse
For the Registrar
The Comptroller-General