

O-165-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2366551 BY
STEPHEN JAMES DENHAM TO REGISTER THE
TRADE MARK TIGERTAILZ IN CLASSES 9 & 25**

AND

**IN THE MATTER OF OPPOSITION NO 92906 BY
JUSTIN SMITH (AKA PEPSI TATE) JOHN PEPPER
(AKA JAY PEPPER) & ANDREW JONES (AKA KIM HOOKER)**

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(aka Jay Pepper) & Andrew Jones (aka Kim Hooker)**

BACKGROUND

1. On 24 June 2004 Phillip Slack applied to register the mark TIGERTAILZ for the following goods in Classes 9 and 25 of the International System for the classification of goods and services:

Recording discs, apparatus for the transmission or reproduction of sound or images, photographic apparatus and instruments, cinematographic apparatus and instruments, digital music downloadable from the Internet, compact discs.

Clothing, footwear and headgear.

2. The application is numbered 2366551. The application has since been assigned to Stephen James Denham.

3. On 26 October 2004 Justin Smith (aka Pepsi Tate), John Pepper (aka Jay Pepper) and Andrew Jones (aka Kim Hooker) filed notice of opposition against this application.

4. There are three grounds of opposition:

Section 3(6) – on the following bases:

“It is believed that the registration of the ‘Tigertailz’ trade mark has been made in bad faith by Mr Phillip Slack as it is believed he is acting as an ‘agent’ for former members of the group ‘Tigertailz’.

It is believed that the registration of the name ‘Tigertailz’ has been done with the sole intention of stopping members of the group Mr Justin Smith (aka Pepsi Tate), Mr John Pepper (aka Jay Pepper) and Mr Andrew Jones (aka Kim Hooker) from releasing future music product under the band name ‘Tigertailz’ of which two of them are founder members.”

Section 5(4)(a) – the opponents do not further specify the objection but it is possible to infer from the following that the objection is under the law of passing off.

“The Tigertailz name and logo was first used in 1984 on our demonstration and Vinyl music products. It has since been used on all our commercial music product releases throughout the world. These include, music CD’s, video’s, T-shirts and other clothing items, music cassette’s, music Vinyl, musical instruments, Internet digital music for download etc.”

Section 5(4)(b) – the opponents allege misuse of the TIGERTAILZ logo that is depicted on the accompanying letterhead and sample album covers.

5. The applicant filed a counterstatement that in terms denies the above claims and offer the following observations in relation to each of the grounds:

“Section 3(6)

We deny that this application was made in bad faith. Both Mr Denham and Mr Finchum are (as previously stated) original members of the group Tigertailz. They only applied for these trade marks knowing that at the time they were the only original members of the group working under the name.

Sections 5(4)(a) & (b)

The opponent states that the logo etc was first used in 1984, this is untrue, the logo (design) and name in its current guise was only used in early 1986 when both Mr Finchum and Mr Denham were members. We have proof of earlier demonstration covers that can verify this if needed.

The goods and services that are objected to are not in direct conflict, the groups audience are very aware of the line-ups of the band. Since 2003 we have toured the UK, sold merchandise (t-shirts etc ...) and released a music cd. Both Mr Finchum and Mr Denham are known worldwide as original members of the group.

We had applied for the trade mark completely unaware of the opponents view to working under the name again, in fact via phone conversations between Mr Finchum and Mr Pepper (opponents), they were very much aware of what was going on, and at the time (june/july 2003) were not interested in reforming the group. So to state that we have applied for these trademarks to prevent other members from working is untrue.

We would also like to state that we do not use the logo that the opponent mentions.”

6. Both sides have filed evidence. The matter came to be heard on 30 May 2006 when the parties appeared in person.

Opponents’ Evidence

7. Mr Justin Smith, one of the joint opponents, has filed a witness statement which sets out the history of the band TIGERTAILZ as follows:-

“2. Mr Stephen Denham was a member of Tigertailz for a comparatively short amount of time from 1985 to March 1988 (3 years). During this period, Tigertailz released ‘two’ official music recording products, the single ‘Shoot to Kill’ in 1986 and the album ‘Young & Crazy’ which was released in November 1987. Less than 4 months after the release of this album I asked Mr Stephen Denham to leave the group due to musical and personal differences.

3. I refer to the ‘**Tigertailz – Band Member Time In Group Chart**’ marked exhibit **JS01** which clearly shows the amount of time myself and my colleagues, Mr Pepper and Mr Jones have spent in the group Tigertailz. It can be clearly seen from this chart that Mr Stephen Denham has spent the least amount of time in the group compared to all other members (including myself) and has not contributed to its goodwill for over 17 years, and yet now he claims to own the name of the group which I completely refute.

See attached Exhibit JS01

4. As a group, Tigertailz has never officially split up. Although pursuing other careers, there was never any press release issued to say that we had even finished conducting business or producing music products as Tigertailz. In fact, Tigertailz music products continued to be sold all over the world throughout the late 1990’s and into 2000+.

5. Even throughout this period of inactivity, Tigertailz fans all around the world still recognised the group for our most successful album and video ‘Bezerk’ and the members of the group at that time. Those were, Mr Andrew Jones (Kim Hooker), Mr John Pepper (aka Jay Pepper), Mr Stephen Finchum (aka Ace Finchum) and myself Justin Smith (aka Pepsi Tate).

6. Although pursuing other careers, myself, Mr John Pepper and Mr Andrew Jones have kept in contact with each other over the years and had discussed releasing future Tigertailz product as and when the music climate felt right. In 2002 with the music scene becoming more Rock orientated again, Mr Jones and Mr Pepper started writing and recording songs together for a new Tigertailz album and I joined Mr Pepper and Mr Jones in 2003.

7. Just prior to me joining up with Mr Pepper and Mr Jones in 2003, Mr Denham contacted Mr John Pepper and explained that he had received an offer from a record company to reform the ‘Young & Crazy’ version of Tigertailz (the one Tigertailz album that had featured Mr Denham). Mr Denham asked if Mr Pepper would be interested in joining him in this project but Mr Pepper declined the offer preferring to work with Mr Jones and myself. I was never contacted by Mr Denham about his project and had no idea that he intended to use the Tigertailz name or branding.

8. I would also like to state that at no time since being asked to leave the group in March 1988 has Mr Stephen Denham ever made any claim to the Tigertailz name or trade mark. In fact, after being asked to leave Tigertailz, Mr Stephen

Denham went on to form various other bands from 1998 until present day releasing records under the name 'St Jaimz', 'Jaimz Gang' or 'Steevi Jaimz'.

9. Not once in over 15 years has Mr Stephen Denham ever shown any interest in using the Tigertailz name or brand, nor made any claim to its ownership or goodwill. This includes during the years 1989 to 1991 which were categorically the most commercially successful period for Tigertailz with the band having a UK Top 40 hit in 1990 with our 'Bezerk' album, a Top 5 video with our 'Bezerk Live' video along with other UK and European Chart hits during this time. If Mr Stephen Denham had felt he had any claim on the Tigertailz name there seems to be no logical reason why he would wait over 15 years to make his claim.

10. Also, the Tigertailz Trade Mark registration was made by a 'Mr Phillip Slack' who is/was acting as an associate of Mr Stephen Denham. I only received notice of this registration when a friend of Mr Phillip Slack's contacted my manager (Dave Tedder) to inform him of Mr Slack's and Mr Denham's intentions which were to take legal proceedings against Mr Pepper, Mr Jones and myself when we released our new Tigertailz album Bezerk 2.0 later this year."

8. He goes on to rely on the High Court judgment in *Saxon* ([2003] FSR 39) as supporting his position (exhibited at JS02 is what appears to be a summary or report of the case).

9. He goes on to present details of 'official music products' offered under the name TIGERTAILZ. The record titles with release dates are:-

Shoot to Kill (Single)	1986
Young & Crazy (Album)	1987
Living Without You (Single)	1988
Love Bomb Baby (Single)	1989
Bezerk (Album)	1990 & 2005
Noise Level Critical (Single)	1990
Bezerk Live (Music Video)	1990
Heaven (Single)	1990
Banzai (Album)	1991 & 2005
Video Frenzy (Music Video)	1992
Wazbones (Album)	1995
Belly of the Beast (1) (Single)	1995
Belly of the Beast (2) Single	1995
You Lookin' At Me? (Album)	1996

10. I note that the Wazbones album is not attributed to the TIGERTAILZ band. Various album and video covers are exhibited (JS03) in support of the above claims including that of breach of copyright.

11. In support of this Mr Smith exhibits:

- JS04 - an advertising poster which it is claimed shows that Mr Denham and his associates have used the TIGERTAILZ logo without permission.
- JS05 - an example of the 'Tigertailz Official Logo and Branding'.
- JS06 - material relating to the spelling of TIGERTAILZ involving the substitution of the 's' with a 'z'.
- JS07 - material showing the various incarnations of the brand including before the time that Mr Denham joined.
- JS08 - promotion sheets from Sanctuary Records in connection with re-issue of the bands two most successful albums.
- JS09 - a poster showing the band's involvement with a major rock festival in 2005.

These latter two exhibits are offered as evidence that major music promoters recognise the opponents as the group TIGERTAILZ.

Applicant's Evidence

12. Mr Denham has filed a witness statement. Much of this consists of counter assertions but with little evidential support. The main points are that:

- the application was filed because Mr Denham (and a Mr Finchum) claim to be the only TIGERTAILZ members performing at present.
- he considers that he was effective in raising the profile of the band.
- he claims that the name TIGERTAILZ was 'registered' by the Music for Nations record label but does not say what he means by this or provide evidential support.
- he claims by reference to a South Wales Echo article that Messrs Smith, Pepper and Jones did not reunite until 2004.
- he denies that legal action against the opponents was contemplated.

13. The remainder of the witness statement deals in the main with matters that are likely to be peripheral to the issues at the heart of this case. I do not propose to summarise them but bear them in mind.

Opponents' Evidence in Reply

14. This consists largely of comments on Mr Denham's witness statement and counter assertions. No additional documentary evidence is introduced. Again I confirm that I have read this witness statement but do not propose to summarise its contents.

DECISION

15. The statement of grounds included an objection based on Section 5(4)(b) and the law of copyright having regard to a logo version of the name TIGERTAILZ which featured consistently on the various albums and singles released by the group. I indicated at the hearing that I considered this objection to be unsustainable as the mark applied for is the word TIGERTAILZ and not the particular form of presentation employed in the past by the group (see *Karo Step Trade Mark* [1977] R.P.C. 255 as confirming that there can be no copyright in a word or words as such). This case primarily falls to be decided under the provisions of Section 5(4)(a) and in particular the law of passing off.

Section 5(4)(a)

16. This 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”.

17. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' 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 applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

18. The material date for passing-off is the date of the behaviour complained of (see *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] R.P.C. 429 and *Inter Lotto (UK) Ltd v Camelot Group Plc* [2004] R.P.C. 8 and 9). Section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 of December 21, 1998 which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark”.

19. There is a suggestion in Mr Denham’s evidence that he and his associates were active under the mark TIGERTAILZ in 2003, that is to say prior to the filing date of the application on 24 June 2004. However, there is insufficient evidence before me to establish with reasonable certainty any particular date in 2003. I propose, therefore, to take the application filing date as the material date for the opponents’ case under Section 5(4)(a). If I am wrong in that then a date in 2003 would apply.

20. Mr Smith’s evidence has referred me to *Saxon Trade Mark* [2003] F.S.R. 39 as providing similarities with the current case. There may be certain similarities but, as might be expected, that case was decided on its own facts and in that respect at least cannot provide a template for my decision. *Saxon* is, however, of relevance in approaching the matter of ownership of goodwill and the legal position of groups where membership changes or successor groups came into being.

21. Laddie J came to a different view to the Registry hearing officer in relation to the issue of ownership of the name *SAXON* and the goodwill associated with it:

“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. The position would be very different if all the members of the original group had been performing together, not as partners, but as independent traders. In such a case, each may well have acquired a discrete interest in the name and reputation which he could use against third parties but not against the other owners. An example of this is *Dent v Turpin* (1861) 2 J&H 139. Similarly, when Mr Oliver left in 1995, the then partnership dissolved. He had an interest in the realisation of that partnership’s assets, but he did not own in whole or in part the partnership name and goodwill.”

22. He dealt with the position that existed when a band splits up as follows:-

“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 for 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.”

23. On the basis of the evidence before me, in particular Exhibits JS01 and 3 the group enjoyed a continuous existence between 1983 and 1996 though the line-up changed a number of times over that period. It appears to have been settled from 1990 onwards save for Mr Pepper’s temporary departure. There is no evidence that members of the group in its various incarnations were performing as independent traders with the consequences set out by Laddie J in paragraph 19 of Saxon. I infer, therefore, that these various incarnations of the group were partnerships at will and that the opponents are entitled to bring this action on behalf of the successive partnerships.

24. Mr Denham does not, I think, dispute that the partnership that existed in 1996/7 enjoyed goodwill under the name TIGERTAILZ. Mr Smith had been a member of the group throughout the period to 1996 and Mr Pepper and Mr Jones for slightly lesser

periods. Mr Smith and Mr Pepper, for instance had been involved in all but one of the Tigertailz albums/singles. By 1996 the group had in total released four albums, five singles and two music videos. I have not included that the Wazbones album. Nor have I included the two Belly of the Beast singles in the tally because there was disagreement at the hearing as to whether these were Tigertailz or Wazbones singles. I am unable to resolve this point satisfactorily from the material before me though if the article from the South Wales Echo (Exhibit SJD01 to Mr Denham's evidence) is to be believed these would appear to be TIGERTAILZ releases. Although individual album/single sales are not given, worldwide record sales of approximately 250,000 confirms that the group enjoyed a significant following for its particular type of music, glamrock.

25. That then was the position in 1996. But it is also common ground that there followed a period of about six or seven years when the group was not in the public eye. In fact Mr Smith's reply evidence suggests that, after the brief appearance as Wazbones (1995), TIGERTAILZ "continued touring and recording for a number of years afterwards". That might suggest activity beyond 1996 (the year of the 'You Lookin' At Me' album) but I can see no evidence to support that claim. This appears to have led Mr Denham to consider that it was now open to him to reactivate and use the name TIGERTAILZ. He suggests in his witness statement that he contacted Mr Pepper and Mr Smith about reforming the group and using the name. This is not accepted by the opponents. There is no documentary evidence about such an approach.

26. The issues that arise for consideration are, therefore, firstly whether the opponents can be said to have abandoned their business and the goodwill associated with it and secondly, even if the goodwill was not abandoned, had it evaporated over time and in particular by the filing date of the application (or sometime in 2003 if that is taken to be the date of the act first complained of)?

27. The leading authorities on these issues are those referred to in paragraph 25 of the *Saxon* judgment. Was the business abandoned? Mr Smith says that Tigertailz never officially split up and that even during the period of inactivity the opponents kept in contact with one another. He acknowledges in his reply evidence that "At a point in the late Nineteen Nineties demand for the genre of music in which the band specialised had diminished to the point where releasing records and touring had become unrealistic, and the band continued writing and demoing new material while seeking income from other unrelated areas." When the climate was again more conducive to Tigertailz music, it is said that the members of the group started writing again. That was in 2002. Recording of songs is said to have resumed in 2003.

28. Music groups do not necessarily behave like conventional businesses. It is in the nature of such enterprises that the demand for their type of music may ebb and flow and with it the fortunes of the group. It does not strike me as at all unusual for groups to survive fallow years and have the intention to resume their former activities. In *Star Industrial* (see above) the evidence showed that the plaintiff had no intention of resuming its former trade in Singapore and accordingly was held to have abandoned that part of its business. The company was accordingly held to have ceased to have any proprietary right in Singapore that was capable of protection in an action for passing off in that country. The same cannot be said here. I accept that the point may

be difficult for the applicant to prove but given Mr Smith's clear statement and the nature of the business there is no basis for saying that there was anything more than a temporary cessation of business rather than abandonment.

29. The more difficult question is whether the goodwill that existed in 1996, when the group as then constituted ceased its activities, can be said to have survived until 2003/4. *Sutherland v V2 Music Ltd* [2002] E.M.L.R. 28 was a case involving successive bands using the name Liberty. One of the issues before the judge was whether the first band enjoyed a residual goodwill some five or six years after it ceased to have an active public profile.

30. The judge conceded that he found it a borderline decision but concluded that sufficient reputation remained to found an action of passing off. The case was, of course, decided on its own facts but it does demonstrate that even modest amounts of goodwill (the first band had only released three records and made a few thousand sales, paragraph 32 of the judgment) can survive a period of five or six years of low level activity/awareness.

31. What is the opponents' position here? As I have already noted there is no breakdown of record sales but equally the claimed sales figure of 250,000 has not been disputed. There was a steady stream of albums/singles/music videos between 1986 and 1996. It is also said, and again not seriously challenged, that music products continued to be sold throughout the late 1990s and up to 2000+. I bear in mind too that the group operate in a specialist area of the rock music business, namely glamrock, and are likely to enjoy recognition amongst devotees of that kind of music even if not more widespread appeal.

32. In the *Sutherland v V2* case Laddie J accepted that reputation amongst people in the music industry, as well as the public, must be taken into account. I regard it as significant that two of the group's most popular albums were re-released in 2005. Record labels are likely to take a commercially-driven view on whether to re-release albums. They are unlikely to do so unless they consider there is a reasonable prospect of success. In the case of a re-release that also points to a belief that there was some residual reputation that was capable of generating sales. It is true that the re-releases came after the material date but in this context it can be said that if a reputation existed at that later date, then the case for a reputation in 2003/4 must if anything be stronger.

33. Exhibited at JS08 are promotional sheets put out by Castle Music supporting the re-release of Bezerk and Banzai. I note the following which fleshes out the opponents' own evidence as to the group's past activities:

“Their '87 Music for Nations debut album, **Young & Crazy** gained them a groundswell of support in both the UK & Europe and saw the band playing double sell out shows at London's legendary Marquee and Astoria venues. Extensive touring with their wild stage show gained them many new fans resulting in their second album, **Bezerk** (1990) reaching the UK top 40 taking the band to a whole new level, capturing the imagination of teenagers and resulting in a loyal following that remains to this day. Party anthems like 'Love Bomb baby' and 'Call of the wild' became instantly recognisable

showing that **Tigertailz** had a flavour far beyond their rival bubblegum trash acts.”

34. Allowance must be made for promotional hyperbole but I regard the above as supporting the claim that past activities were on a sufficient scale to suggest a continuing reputation. Indeed there is also some support for these claims in the second paragraph of Mr Denham’s evidence.

35. There are weaknesses in the opponents’ evidence as well. There is very limited information on performances and individual album sales (as opposed to the collective sales figure). Apart from the (uncontradicted) assertion of continuing record sales during the following years there is little indication as to how public awareness was maintained (eg by a fan club or other means).

36. As a result I have not found it an easy matter to determine whether sufficient residual goodwill exists for the purpose of this action. The ability of goodwill to withstand a period of cessation of trade must, I think, be proportionate to the nature and extent of the goodwill that existed in the first place. A large reputation is more likely to persist than a modest one though *Sutherland v V2* suggests that in relation to music groups even moderate reputations can survive a reasonable passage of time. I have concluded that the opponents have done just enough to persuade me that they still had a goodwill capable of protection in 2003/4. The first element of the test for passing off is accordingly in place.

37. The remaining issues are misrepresentation and damage. Neither requires extensive consideration. Once it is established that the opponents have the necessary goodwill under the name TIGERTAILZ it follows that use of an highly distinctive and identical name (or at least one that differs only in the precise form of presentation) in relation to the same sort of business must involve a misrepresentation with consequential damage to the opponents’ goodwill. Mr Denham’s historical connection with the band is not a defence against such a finding (see paragraph 33 of *Saxon*). Mr Denham says in his evidence that promoters have approached him or his band and that they are also recognised as Tigertailz in the eyes of these promoters. None of these promoters has been identified or cross-examined so it is difficult to know what their beliefs are and why they hold those views. It does not seem to me to show more than the fact that some people are aware of Mr Denham’s historical connection with the band and have not enquired into the matters that have needed to be addressed in this case. It may also point to confusion being absolute. In all the circumstances the opposition succeeds under Section 5(4)(a).

Section 3(6)

38. This provides that a trade mark shall not be registered if or to the extent that the application is made in bad faith. In the light of the opponents’ success under Section 5(4)(a) I need only deal with it briefly. In *Saxon* Laddie J took as his starting point the following passage from *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] R.P.C. 367 where Lindsay J said:

“I 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”.

39. Laddie J held on the facts of *Saxon*:

“38 As indicated above, I disagree with Mr Foley’s conclusion that Mr Oliver and Mr Dawson had a right to claim to be owners of the mark. Furthermore, inherent in the statement that Mr Oliver “got there first”, is the recognition that ownership of the mark gave the proprietors the right to interfere with the use of the same mark by others in relation to the same goods and services. That Mr Oliver and Mr Dawson could use it to interfere, not just with other former partners in the original band, but also with the current band. As a result of the letter of March 2001 and email referred to above, it can be seen that the ability to interfere is not a hypothetical possibility.

39 As Lindsay J said, each case must be decided on its own facts. Here the proprietors have obtained registration of SAXON simpliciter even though they have no existing title to it and have done so for the purpose of interfering with the rights of others who do and have consistently used the mark In my view this is bad faith within the meaning of the section.”

40. Whilst I accept that it may not be Mr Denham’s immediate intention to use any resulting registration against the opponents he would nevertheless be putting himself in a position where he could do so. That points to a finding in the opponents’ favour under Section 3(6) as well.

COSTS

41. Neither the statement of grounds nor the counterstatement made any mention of costs but it must be borne in mind that the parties have not been professionally represented in this action and might normally have been entitled to a suitable award based on the published scale.

42. Although the issues raised by this case have inevitably created some ill-feeling between individuals who were formerly part of the same group, the hearing itself was conducted without rancour and with proper respect for their respective past contributions to the group. Consistent with the spirit in which the hearing was conducted the parties agreed that no costs aware would be pressed at least in respect of the proceedings before the Registry (and without prejudice to the position on costs in the event of an appeal). Accordingly I make no award.

Dated this 20th day of June 2006

M REYNOLDS
For the Assistant Registrar
The Comptroller-General