

TRADE MARKS ACT 1994

IN THE MATTER OF Application No: 2113079

by Christopher Victor Palmer-Jeffery

for the registration of a trade mark in Class 41

AND IN THE MATTER OF Opposition thereto

under No: 47565 by The British Broadcasting Corporation

Background and Pleadings

1. On 17 October 1996, Christopher Victor Palmer-Jeffery of Gable House, Braybrooke, Market Harborough, England, applied for registration of the trade mark shown below in Class 41:

CATHCART PROMS

2. Following examination the application was subsequently accepted and published for opposition purposes in respect of the following services:

“Organisation and presentation of music concerts and music festivals; arranging and conducting of conferences; organisation of entertainment, competitions, musical competitions; musical entertainment services; presentation of live performances; orchestra services; production of shows; concert services; publication of books, texts, printed matter, pamphlets, leaflets, magazines and programmes; corporate hospitality services involving the provision of any of the aforesaid services.

3. The application is opposed by the British Broadcasting Corporation, which is a large and well known entertainment and broadcasting organisation with extensive interests in the fields of entertainment and education, including two national television channels, five national radio stations, the provision of musical entertainment, live shows and concerts.

4. The opponent claims to have used the words PROMS and THE PROMS for many decades in connection with the organisation and presentation of musical concerts, including those presented each year at the Royal Albert Hall.

5. These concerts are said to have developed from concerts held at a different venue and inspired and conducted by Sir Henry Wood at the end of the 19th century and the beginning of the 20th. The opponent first became involved in presenting these concerts in 1927. This was initially on national radio but later on television. As a result of this use it is claimed that the words “Proms” and “The Proms” in relation to concerts are “synonymous” with the opponent.

6. The specific grounds of opposition (insofar as they were pursued before me) are:

i) Under Section 5(4)(a) of the Act because the opponent claims that use of the mark applied for in the United Kingdom is liable to be prevented by the law of passing off. To the extent that it may be argued that the name “Cathcart” was associated with Henry Wood’s concerts prior to 1927, the opponent says that this increases the likelihood of association with the opponent.

ii) Under Sections 3(3)(b) because in the opponent’s view use of the mark applied for without the opponent’s authority and consent would be deceptive, given the opponent’s own use and reputation in the mark PROMS.

iii) Under Section 3(6) of the Act, as the mark was applied for in bad faith. The opponents say that the applicant knew, or should have known, that use of the mark CATHCART PROMS would be deceptive, because it would lead to an association with the opponent. It is said that the applicant was aware of the opponent’s concerns at the time the application was made, and had offered to disclaim any connection with the BBC’s concerts in large text in their marketing literature. The opponent has since held two concerts at the Albert Hall without such disclaimer. Further, the opponent has used misleading images associated with the opponent’s concerts and featured some of the same music as the opponent’s “Last Night of the Proms” concerts.

7. The applicant filed a counterstatement denying the grounds of opposition. While the applicant makes a number of general concessions which relate to the opponent's size and general trading activities, the main thrust of their counterstatement is that the word PROMS is an entirely descriptive or generic word which any party is entitled to use in relation to promenade concerts. To support this view, they point to a number of dictionary references, together with the existence of a number of registered marks (not owned by the opponent) which include the word PROM or PROMS as an element, and which are registered for similar services to the current application. The applicant points out that the mark was in use at the date of the application. It denies using misleading imagery and says that its offer to disclaim any association with the BBC is an indication of its good faith rather than the reverse. It denies that this offer amounts to an admission that confusion would otherwise arise.

8. Both sides ask for an award of costs in their favour. The matter came to be heard on 4 May 2000. The applicant was represented by Mr A Porteous of Grant Spencer Caisley and Porteous; the opponent was represented by Ms M Bleahene of Stephenson Harwood.

The Opponent's Evidence-in-Chief

9. I have considered all the evidence that has been filed and admitted into the proceedings. The following summary is sufficient to set out the principal facts upon which the parties rely.

10. The opponent's evidence consists of a statutory declaration dated 9 April 1998 by Steven David Maddock, who is employed by the BBC as Administrator BBC PROMS.

11. Mr Maddock explains that in the Spring of 1894 Robert Newman manager of the Queen's Hall in London asked the conductor Henry Wood if he felt that the idea of holding "Promenade Concerts" in the Queens Hall was feasible. Mr Wood felt that it was, and the first Promenade Concert was performed in August 1895. Even at that time the idea of informal, cheap standing concerts was not novel, having already taken place for a number of years in London's music halls and theatres. It appears from the copy of "The Proms: A Living Tradition" in exhibit SDM1 to Mr Maddock's declaration that these earlier concerts were also

known as ‘promenade concerts’. Funds to support the first series of concerts conducted by Henry Wood were provided by Dr George Cathcart an eminent ear and throat specialist, who set two conditions. The first was that the “new” or continental pitch should be used at all these concerts, and the second, that no other conductor other than Henry Wood should direct them. These concerts continued to be held at the Queens Hall in London, but in 1927 the music publishers Chappell & Co (who at that time held the lease to the Queens Hall) felt that they could no longer support them. So it was that in 1927 the BBC agreed to take over the running of the concerts.

12. Mr Maddock explains that although the concerts are formally known as the Henry Wood Promenade Concerts, they had become “affectionately known as the proms” as early as 1927. Given that this term did not have any wider meaning in 1927, and in view of the BBC’s use of the mark, Mr Maddock concludes that the word cannot be generic. Mr Maddock acknowledges the references to “Proms” as meaning “promenade concerts” in the dictionary definitions referred to by the applicant, and the existence of registered marks by others for the same or similar services which include the word Proms as an element. Mr Maddock states that the BBC does not believe that the use of “School Proms” or “Welsh Proms” will, in practice, cause any confusion with “the proms” organised by the BBC. Mr Maddock concludes that, despite the dictionary definitions and the existence of the registrations referred to by the applicant, the “Proms” concerts are closely associated with the BBC by a substantial proportion of the public in the United Kingdom. Indeed Mr Maddock asserts that “the Proms” is exclusively associated with the BBC.

13. The Royal Albert Hall was first used to stage the Proms in 1941. Since the death of Henry Wood in 1944, the BBC has been wholly responsible for the organisation, management etc of the concerts. Shortly before his death, Henry Wood expressed his wish that the BBC should carry on his promenade concerts. He wrote to the BBC on 26 May 1944 granting the BBC the exclusive right to the name “The Henry Wood Promenade Concerts” on the understanding that if, at some future time, the BBC was not prepared to carry on presenting the concerts, Mr Wood or his personal representatives could authorise some other person or body to carry on the concerts. The BBC wrote back on 30 May 1944 accepting the offer and agreeing to give

the necessary notice in the event of a decision to discontinue presentation of the Promenade Concerts. A copy of the correspondence is in exhibit SDM3 to Mr Maddock's first declaration.

14. Mr Maddock says that a typical eight week season will run from the middle of July to the middle of September, and will comprise around 70 concerts. Typical audiences (per season) are in the order of 200,000 people. Recent estimates are that the total television audience for the whole of The Proms is approximately fifteen million viewers, with The Last Night of the Proms attracting seven million viewers. There is also a large radio audience. In recent years the opponent has organised further concerts known as "Proms in the Park."

15. The exhibits to Mr Maddock's declaration show how the opponent has promoted its concerts and provide examples of the public's reaction to them. These are said to support the opponent's claim to distinctiveness. I will address these in more detail later.

16. Mr Maddock states that as Dr Cathcart was involved when the Proms were originally conceived, then association with the opponent is inevitable. Mr Maddock also doubts that the mark was chosen in good faith, and questions why the applicant feels it has the right to use the name Cathcart Proms, given what was (in the opponent's view) the very minor role Dr Cathcart played in the creation of the original Proms.

17. Mr Maddock refers to copies of the applicant's Cathcart Proms programmes and promotional literature (dated 1996/97). He argues that the choice of venue (the Royal Albert Hall), the presenter (Richard Baker who until 1995 presented the Last Night of the Proms for the BBC) the music and the order of its playing, together with the way the audience are dressed, and the props they are using (flags and balloons essentially), are all evocative of the opponent's Proms. Indeed Mr Maddock goes as far as to say that he believes that the photograph used by the applicant was taken at the opponent's Proms concert. He adds that in the 1997 promotional literature, reference is made to "the last night of the Cathcart proms". As this was a one off event, he queries why such a reference was made if not to infer an association with the opponent. While he is not able to refer to specific instances of confusion,

he says that this is not surprising as errors of this sort would most likely have occurred by telephone and no records would have been kept.

The Applicant's Evidence-in-Chief

18. This consists of a statutory declaration dated 6 July 1998 by the applicant Christopher Victor Palmer-Jeffery. Mr Palmer-Jeffery explains that he is the founder of the Cathcart Proms which he says is currently marketed as the Cathcart Spring Proms. The following information emerges from Mr Palmer-Jeffery's declaration:

19. Having adopted the contents of an earlier declaration he filed with the Registrar prior to acceptance of the application, (as exhibit CVPJ 2.1), Mr Palmer-Jeffery explains that in 1994 following discussions with the great-niece of the late Dr George Cathcart, he decided to produce a Proms concert in honour of Dr Cathcart's contribution to British music. At this stage Mr Palmer-Jeffery did not believe that any organisation could claim a monopoly in the word Proms.

20. The Cathcart Proms and the Cathcart Spring Proms which followed them, have been held annually since 1996 and have been successful. Examples of the programmes from 1996, 1997 and 1998 are exhibited at CVPJ-2.2. The numbers attending these one-off concerts has fluctuated, but have been in the region of 4,000 people (the majority being corporate customers). During this period, Mr Palmer-Jeffery comments that not one instance of confusion has been brought to his attention, and notes that this concurs with the views of Mr Maddock for the opponent.

21. Mr Palmer-Jeffery disputes that the Henry Wood Promenade Concerts are universally known as "The Proms". He adds that people will refer to the BBC Proms or The BBC London Proms. He accepts that the BBC are amongst Proms concerts probably the most famous, but says that the word "Proms" does not exclusively indicate the BBC's Proms. To support this contention, Mr Palmer-Jeffery exhibits (as CVPJ-2.3) a selection of press cuttings. All of these cuttings are after the material date, but do show what appears to be

widespread, mostly local, descriptive usage of the word Proms in relation to musical concerts.

22. Mr Palmer-Jeffery says that he cannot understand how the BBC can claim exclusivity in the word “Proms” on the one hand, and be a supporter of School Proms organised by Music For Youth (which is as far as he is aware unrelated to the BBC). Exhibit CVPJ-2.4 is a copy of the School Proms brochure of November 1995, in which a reference is made to BBC Radio 2 both as a broadcaster, and as a friend of Music for Youth.

Opponent’s Evidence-in-Reply

23. This consists of a further statutory declaration dated 7 October 1998 by the same Steven Maddock mentioned above. The main points to emerge from Mr Maddock’s Evidence-in-Reply are that:

- i) the letters BBC have been used with the word Proms, but this use has often been separated from the word Proms and/or has been written in a different size or style;
- ii) that the newspaper cuttings at CVPJ 2.3 are all after the material date, and appear to relate to one off local events appearing in local publications;
- iii) where the BBC becomes aware of another party using the word Proms in relation to a small, local, one-off musical concert or where such use is accompanied by another distinguishing feature, the BBC may not take action;
- iv) the BBC may not have objected to some of the events identified in the applicant’s evidence (particularly, “RSNO Proms” and “Ulster Proms”) even if it had been aware of them;
- v) where conflicting use has come to the BBC’s attention, action has been taken - exhibit SDM21 contains examples of letters where the BBC has raised concerns (all of which are after the material date and relate to use of “Last Night of the Proms” or

“Proms in the Park”).

24. There is also a statutory declaration dated 6 November 1998 by Andrew Peter Ayres. Mr Ayres works for “an international production services company” called Mantaplan Limited. He does not say whether there is a business relationship between his company and the BBC, but I note that his company is mentioned in a copy of a letter from the BBC dated 1 October 1997 in exhibit SDM16 to Mr Maddock’s first declaration. It appears that Mantaplan Limited manage the BBC’s “Proms in the Park” event. Mr Ayres says that he is aware of a series of annual concerts held in the Albert Hall called the “Proms” and that the final concert of the series is called “Last Night of the Proms.” He says “I understand the titles of these concerts to be names which belong to and are strongly associated with the BBC.” He further says that he was surprised when, in May of 1998, he came across someone else using the name “Last Night of the Proms”. He sent a fax to the BBC at that time, a copy of which is included in the evidence.

Decision

25. I will first consider the ground of opposition under Section 5(4)(a) of the Act, which is reproduced below.

(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

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.

26. The only potential “earlier right” which the opponent has identified arises under the common law of passing off. Geoffrey Hobbs QC, acting as the ‘Appointed Person’, summed

up the law under Section 5(4)(a) of the Act in the WILD CHILD case (1998 14 RPC 455). He 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 Erven 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.”

27. The applicant’s position is straightforward. He says that although the BBC’s Proms are probably the most famous, the word “Proms” is descriptive and was not distinctive of the concerts of any one undertaking at the relevant date. Consequently, his use of “Cathcart Proms” is not a misrepresentation.

28. The opponent’s position appears more complex. The BBC says that, at the relevant date, “Proms” meant the BBC concerts at the Albert Hall to a “very substantial number of people” and that “the Proms” is exclusively associated with these concerts and the BBC.

29. The word “Proms” appears in the Concise Oxford Dictionary (8th Edition) and the Shorter Oxford Dictionary (3rd Edition) as meaning “promenade concert.” This is defined as “a concert at which the audience, or part of it, can stand, sit on the floor, or move about.” At the hearing, Ms Bleahene handed me a further extract from The New Shorter Oxford dictionary which defines “Prom” as “A promenade concert; *esp* any of the BBC Promenade Concerts. Also Prom concert.” I do not think this is inconsistent with the references upon which the applicant relies. It suggests that “Prom” means “promenade concert”, not necessarily the BBC

promenade concert. This is consistent with the evidence, which shows that the word “Prom” is in relatively common use in relation to musical concerts. Most of the use shown is local and after the relevant date. However, in view of the long history of promenade concerts and the extent of the use shown after the relevant date, it would be surprising if the position before the relevant date was much different. It is common ground that the marks “School Proms” and “Welsh Proms” have been in use for many years. Ms Bleahene was constrained to accept that the BBC could not claim any monopoly in the use of the word “Proms”.

30. The opponent has not presented any evidence from which it could be concluded that the dictionary entries to which I have referred are inaccurate or out of date. On the contrary, the evidence indicates that “Prom” still has the descriptive meaning recorded in the dictionaries.

31. As far as I am able to understand it, the opponent’s position appears to be that the word is no longer *merely* descriptive and that, by the relevant date, “Proms”, or at least “the Proms”, had, without further indication, come to mean the BBC’s musical concerts as a result of the BBC’s use of those names.

32. The evidence contained in exhibits SDM2, 5, 6, 14 & 15 to Mr Maddock’s declaration shows that the opponent has issued a considerable volume of promotional material and concert guides over the years, many of which prominently feature the word “Proms” (often in conjunction with a year). Most of this material also contains source identifiers such as “Henry Wood Promenade Concerts” and “BBC”. It is noticeable that, since about 1990, the BBC name has been given increased prominence. In *British Sugar Plc v James Robertson & Sons Limited 1996 RPC, at page 286 (lines 38-42)*, Jacob J. stated that:-

“Mere evidence of use of a highly descriptive or laudatory word will not suffice, without more, to prove that it is distinctive of one particular trader - is taken as a badge of origin. This is all the more so when use has been accompanied by what is undoubtedly a distinctive and well recognised trade mark.”

33. I have already found that the word “Prom” is descriptive of promenade concerts. The BBC

musical concerts appear to correspond precisely with the descriptions of a promenade concert to be found in the dictionaries. On the face of it, the opponent's use of "Proms" is descriptive. The opponent's longstanding use of the word is not therefore sufficient, without more, to establish that the word has become distinctive of the BBC's concerts.

34. The opponent relies upon copies of letters from the public addressed to the BBC about its concerts. These are contained in exhibit SDM16 to Mr Maddock's declaration. I do not find these letters of much assistance in answering the question of distinctiveness. The letters in question have been written by people who attended the opponent's concerts (or in one case wanted to). All they show is that the persons concerned knew who had organised the Proms they had attended. That is not surprising given that the BBC promotes its own name as the organiser. Indeed, even though they are written to the BBC and one might therefore think it unnecessary, some of the letters refer to the "*BBC Proms*"(my emphasis).

35. Apart from Mr Ayres evidence, the opponent has not filed any direct evidence from the public or the trade. Mr Ayres says that he "understands" that "Proms" is a title which "belongs" to the BBC and that he was surprised to find another party using the title "Last Night of the Proms." He does not say that he was confused by this use. This may be because Mr Ayres' company appears to have a fairly close working relationship with the BBC. I do not believe that Mr Ayres' evidence assists me greatly in assessing whether the ordinary concert going public regards "Proms" as really distinctive of the BBC .

36. As Lord Russell said in *The Canadian Shredded Wheat Co. Ltd v Kellogg Co. of Canada* (1938) 55 RPC 125 at 145:

"A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else."

37. On the evidence, the opponent could not say that of the word "Proms" at the relevant date. Ms Bleahene suggested that the concurrent use of "Proms" by others such as "Schools Proms" and "Welsh Proms", might be a case of shared goodwill under the name "Proms." There can

be cases of shared goodwill identified by a distinctive sign, but I am not aware of any authority which would support the proposition that a number of traders can claim an actionable goodwill under a descriptive name to the exclusion of other parties who wish to use the name in respect of the goods or services it describes. The opponent says that the applicant's use is not truly descriptive. This is because the audience are seated at the applicant's concerts. Indeed the opponent originally took a further objection to the application under s3(3)(b) of the Act on the basis that:

“use of the mark would be deceptive if used in relation to entertainment or concerts which do not provide substantial areas without seating where the audience can stand and move around.”

38. Ms Bleahene didn't pursue that ground before me. I believe she was right not to do so. Only a purist would say that the absence of designated standing areas deprives an informal musical concert of the right to describe itself as a promenade concert. In any event the point is academic unless the opponent can show that its own use of "Proms" is material and not merely descriptive.

39. It is theoretically possible that "the Proms"(my emphasis) was distinctive of the opponent's musical concerts at the relevant date, even if "Proms" alone was not. But bearing in mind the descriptive nature of the word "Proms" a finding of distinctiveness based upon the addition of the definite article would only be possible on the clearest evidence, particularly as the opponent's own promotional material does not consistently refer to its concerts as *the* Proms (as opposed to just "Proms").

40. The opponent has also filed (as exhibit SDM8) copies of press cuttings about its musical concerts. Although a number of these stories refer to the "BBC Proms" , "The Henry Wood Promenade Concerts" or, in one case, "The London Proms", it is fair to say that a number of stories do refer to the concerts held in the Royal Albert Hall as simply "the Proms". But in the absence of evidence from the public and/or independent evidence from the trade, I do not regard this use by journalists as sufficient, by itself, to establish that "the Proms" was

distinctive of the opponent's concerts at the relevant date.

41. In this connection I bear in mind the point made by Whitford J. in *Imperial Group plc v Philip Morris Limited 1984 RPC293* that being "the best known of many" does not mean that a sign is distinctive. Journalistic use of "the Proms" may simply reflect the undisputed fact that the opponent's Proms are the best known. As the opponent has not shown that its concerts are distinguished by the words "Proms" or "the Proms", its case is bound to fail. For if all the opponent can show is that it owns a goodwill identified by the name "BBC Proms" and/or "Henry Wood Promenade Concerts", it faces the difficulty that neither of these names is liable to be confused with "Cathcart Proms" in circumstances where "Proms" is descriptive.

42. In case I am subsequently found to be wrong on my findings so far, I will go on and consider what the position would be if "the Proms" was distinctive of the opponent's musical concerts at the relevant date. This does not mean that the opponent would be entitled to a common law monopoly in the descriptive word "Proms". But the law would then require the applicant to do enough to avoid confusion and deception with "the Proms". See, for example, Templeton L.J.'s remarks in *McCain International Ltd v Country Fair Foods Ltd and Another 1981 RPC 69, at page 76 lines 16-19*.

43. Would the applicant's use of "Cathcart Proms" amount to a misrepresentation in these circumstances?. The opponent says that because Dr Cathcart was involved in the 1890s in setting up the promenade concerts with Henry Wood as their Director, and which are carried on by the opponent, the name "Cathcart" is in inadequate means of distinguishing the source of the applicant's services from those of the BBC.

44. There is no evidence that the opponent has ever used the name "Cathcart Proms". Nor do they appear to have made much of Dr Cathcart's early involvement with the "Henry Wood Promenade Concerts". The most the BBC can do is point to a couple of passing references to Dr Cathcart's contribution in a couple of publications (in exhibit SDM1 to Mr Maddock's declaration) setting out the historical background to their Proms concerts. The publication Ms Bleahene relied upon at the hearing (*The Story of the Proms*) dates from 1955.

45. Not surprisingly the applicant's promotional material plays heavily on the contribution of Dr Cathcart to British music and promenade concerts in particular. The 1996 promotional brochure describes him as "The Founder of the Promenade Concerts." It may be that the applicant adopted the Cathcart name (apparently with his great niece's consent) at least in part to gain a little "heritage" for his concerts. However, it seems to me that, at most, the use of this name does no more than to suggest that the applicant's concerts have some sort of historical connection with the early promenade concerts held at the end of the 19th century. In these circumstances it seems unlikely that a significant proportion of the opponent's customers (or potential customers) would, once they knew of Cathcart's role in the 19th century, make a series of associations leading them to expect promenade concerts held under that name a century later to be connected in trade with the BBC.

46. The opponent complains that the applicant uses the same venue for its concerts and some of the same music, orchestras and imagery. The applicant's event is billed as "An evening of Great British Classical Music" and the musical programme reflects this, starting with the national anthem. In this context I cannot see that the public would be likely to suppose that the use of the union flag in promotional material etc was suggestive of any trade connection with the opponent. Mr Porteous accepted that "normal and fair" use of the applicant's mark would include use of "Cathcart Proms" in relation to concerts held in the Albert Hall. In the light of the applicant's evidence he could scarcely have done otherwise. This is a venue used for the opponent's promenade concerts since 1941. It is clear from the applicant's evidence that he presents his concerts as being of significant stature and probably sees himself in competition with the opponent. His choice of the same prestigious venue is not entirely surprising in that context. In my experience the public rely primarily on the trade name to identify the trade origin of services. I do not believe that the shared venue greatly increases the likelihood of confusion and deception.

47. I am fortified in this view by the fact that, despite the applicant having held three major concerts at the Albert Hall under the names "Cathcart Proms" or "Cathcart Spring Proms", neither side is able to point to any evidence of confusion. The opponent suggests that there may have been confusion and deception but that it has not come to their attention. The

opponent says that he is not aware of a single instance of confusion.

48. Mr Maddock's second declaration provides (as exhibit SDM22) a copy of a letter dated 25 September 1998 from a Sharon Clayton-Pearson addressed to Mr Maddock. The letter describes how Ms Clayton-Pearson approached European Hospitality & Events Ltd (which is one of Mr Palmer-Jeffery's companies) for tickets to "the BBC's Last Night of the Proms." She complains that she was continually asked if he would not rather have tickets to the "Cathcart Proms" which were said to be equally good and far cheaper. Ms Clayton-Pearson says that she had never heard of this event and refused the offer insisting she wanted tickets for the BBC's Last Night of the Proms.

49. The circumstances which lead Ms Clayton-Pearson to approach European Hospitality & Events Ltd for tickets to the BBC's event are not explained. What is clear is that Ms Clayton-Pearson was not confused or deceived by the names of these events into thinking that the one was (or connected in trade with) the other. Nor is there any suggestion that the applicant's company tried to pass its event off as being connected with the BBC. On the contrary it is clear from Ms Clayton-Pearson's letter that the applicant's event was presented as a cheaper alternative. That is not passing off.

50. In my experience concert goers are a relatively sophisticated public who know what they want. They are unlikely to be easily confused or deceived, and likely to complain if they do not get what they expect. I am therefore doubtful about the opponent's speculation about significant unreported confusion.

51. For the reasons given above the opposition under s5(4)(a) fails because the opponent has not discharged the burden which is upon it to show that "Proms" or "the Proms" is distinctive of its services, or that the applicant's use of "Cathcart Proms" is a misrepresentation. In the light of these findings there is no need for me to consider the question of damage.

52. The grounds of opposition under s3(6) and 3(3)(b) appear to cover elements of the opponent's case under s5(4)(a). It is said that the use of the name "Cathcart" is likely to

deceive the public into believing there to be some connection between the applicant's events and those originally staged by Sir Robert Newman, and carried on by the BBC since 1927. I believe this to be a relative grounds matter which I have already considered under s5(4)(a). However, if I have misunderstood the objection and the charge is that the applicant is deceiving the public as to the kind or nature of its services by falsely using the "Cathcart" name, I reject that objection. There is no evidence that Dr Cathcart ever held concerts under his own name. I cannot therefore see what characteristics of the services in question the public would expect to be present by virtue of the "Cathcart" name. Ms Bleahene could not explain that at the hearing and the opponent's evidence is silent on this point. I regard this objection as too ambiguous to constitute a valid ground of opposition under s3(3)(b).

53. Nor do I consider that the evidence establishes that the application was made in bad faith. The opponent says that the applicant has sought to exploit the similarity between his concerts and those of the BBC and that such activity would not be regarded as honest and bona fide by business people generally. Although "bad faith" may extend to matters which fall short of outright dishonesty - see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* 1999 RPC 367, at page 379 - I do not believe that s3(6) requires the applicant to submit to a peer group assessment of his commercial morality (not that the opponent has filed evidence from such a group). I find support for this view in the decision of Mr Geoffrey Hobbs QC as Appointed Person in the case of *Demon Ale Trade Mark* 2000 RPC 345 at page 356, lines 13 & 14. Similarity is not, of itself, objectionable. Most competition is based upon similarity of products or services. *Deceptive* similarity is objectionable, all the more so when it is intentional. However, I do not believe that the evidence supports such a finding. The fatal weaknesses in the applicant's case are that 1) "Proms" is descriptive and therefore capable of honest application to another traders services, and 2) there is no evidence that the adoption of the name "Cathcart" was intended to be (or has in practice been) taken as an indication of a trade connection with the BBC or the promenade concerts it organises each year. The s3(6) ground also fails.

54. The opposition having failed the applicant is entitled to a contribution towards his costs. I order the opponent to pay the applicant the sum of £1100 to be paid within 7 days of the end

of the period allowed for appeal or, in the event of an unsuccessful appeal, within 7 days of the final determination of this matter.

Dated this 18 Day of May 2000

Allan James

For the Registrar

The Comptroller General