

O/189/20

TRADE MARKS ACT 1994 (AS AMENDED)

TRADE MARK REGISTRATION No. 3334181

IN THE NAME OF MR MARK LEE

AND

APPLICATION 502385

BY MR ANDREW BAGNALL

FOR A DECLARATION OF INVALIDITY

Background and pleadings

1. This is an application filed on 8th January 2019 by Mr Andrew Bagnall (“the applicant”) for a declaration that trade mark registration No.3334181 in the name of Mr Mark Lee (“the proprietor”) is invalid.

2. The contested mark is **The UB40 Experience**. The proprietor’s application to register the trade mark was filed on 3rd September 2018 (“the relevant date”). The mark was subsequently registered on 16th November 2018. The registration covers a wide range of entertainment services in class 41. The full list of services is shown at Annex A. It is sufficient for present purposes to note that it includes *arranging and conducting of live entertainment events* and *musical group entertainment services*.

3. For a period of time in 2017/18, the applicant and the proprietor played together in a tribute band (to the well-known UB40) called ‘The UB40 Experience’. The main issue in this case is whether the proprietor was entitled to register the mark having regard to the applicant’s claim to have acquired common law rights under the name as a result of its use in relation to live entertainment services since 27th November 2013. According to the applicant, the proprietor was aware that he and others were using the mark and registered it to prevent such use continuing. The applicant says that the trade mark application was, therefore, also made in bad faith.

4. The proprietor denies the applicant’s claims. The proprietor does not dispute that the applicant used the mark alongside other band members. These were Dave Linton (who was the keyboard player), Dave Lewie Linton (drums) and Anthony Porter (bass player), all of whom he says were original members, as well as Jeff Ball (original guitarist), Craig Spence (who replaced Mr Ball) and the proprietor himself (who replaced Mr Porter). However, the proprietor puts the applicant to proof of his use of the mark since 2013. The proprietor says that he joined the band in August 2017 and continues to perform with it. He claims that Anthony Porter left the band voluntarily in July 2017 and Mr Bagnall was “sacked” from the band in late August 2018. The proprietor considers the band established shortly after that by Mr Bagnall, Mr Porter and others, to be a new band using the same name as his band. He therefore rejects the applicant’s claims that, at the date of his trade mark application,

his band's use of the contested mark could have been prevented under the common law of passing off, or that he filed the trade mark application in bad faith.

The relevant statutory provisions

5. The relevant parts of the Trade Marks Act 1994 (as amended) ("the Act") are shown below:

"47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) -

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

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"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, where the condition in subsection (4A) is met,

(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."

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"3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

Representation

6. Neither party is legally represented. The applicant has nominated Mr Anthony Porter as his representative.

The evidence

7. The applicant's evidence consists of witness statements by Andrew Bagnall, Anthony Porter and James Horton, all of whom have been, at one time or another, members of a tribute band called The UB40 Experience.

8. The proprietor's evidence consists of witness statements by Mark Lee, Dave Linton, Craig Spence, Dave (Lewie) Linton & Jeffrey Ball, all of whom have also been, at one time of another, members of a tribute band called The UB40 Experience.

9. I have read all the evidence. The following appears to be common ground:

- Andrew Bagnall (lead vocalist) and Anthony Porter (bass player) were members of The UB40 Experience from the beginning, which appears to have been around November 2013;
- Anthony Porter registered a number of domain names including the words 'the ub40 experience', the earliest of which was registered in September 2013;
- Dave Linton (keyboards) was in the band by December 2013 and included in the band's initial photoshoot;
- Dave Lewie Linton (Drummer) was in the band by January 2014;
- Andrew Stevenson was the original saxophone player;
- Jeff Ball was the original lead guitar player;
- Kevin Cunningham was the original trumpet player;
- Mr Ball left the band in September 2014 and was replaced by Craig Spence;
- Mr Cunningham left the band in May 2016 and was replaced by James Horton;

- Mr Porter stopped performing with the band in July 2017, citing family reasons;
- Mr Lee took over from Mr Porter as bass player from August 2017;
- None of the band members had contracts;
- There was no written agreements between them;
- Mr Bagnall signed contracts with venues for performances of The UB40 Experience;
- On 17th August 2018, Mr Porter returned to the band to perform at Tribfest 2018;
- On or around the 25th August 2018, the Lintons, Mr Spence and Mr Lee confronted Mr Bagnall about the way the band was being run, particularly about the way the money from performances was being divided;
- Mr Bagnall was told that he was being sacked and replaced by a new lead vocalist;
- Mr Stevenson and Mr Horton left the band at this point;
- Mr Bagnall and Mr Porter resolved to carry on as The UB40 Experience, replacing the Lintons, Mr Spence and Mr Lee with new musicians and persuading Mr Horton to carry on with them at an already scheduled booking at the Diamond Club, Sutton in Ashfield, on 15th September 2018;
- The Lintons, Mr Spence, Mr Lee and others, have also gone on to perform as The UB40 Experience.

Disputed facts

10. I will limit my examination of the disputed facts to those matters which are relevant to the legal grounds for the application for invalidation. There are numerous irrelevant disputes. For example, there is a dispute about who was involved in the process of choosing the name. However, creation of a name *per se* provides no legal rights to use it, or to exclude others from using it. Consequently, it does not matter whether Mr Porter/Mr Bagnall came up with the band's name between them, as they

claim, or whether others were also involved in the process¹. Similarly, ownership of domain names or Facebook accounts provides no legal right to the use of a name. It follows that Mr Porter does not own the name of the band simply because he registered various online accounts including the band's name. There is no legal right in an unregistered trade mark as such. Rather, the law of passing off protects the goodwill generated by a business. In order to do so, it prevents others from misrepresenting themselves as that business, whether by mis-using the name of the business, or otherwise. The business in this case is the musical entertainment service provided by the band.

11. As explained below, in the absence of an agreement or contracts, the goodwill generated by a band of regular performers is normally owned by the band collectively, rather than by individual members of it. It follows that being a founding member of a band does not necessarily mean that you have greater rights to any goodwill created under its name than members who joined later. In the circumstances of this case, I do not think it is important whether Mr Porter and Mr Bagnall were the only founding members (as they claim) or whether the Lintons (or anyone else) also qualify as founding members. And for the reasons explained below, it is also irrelevant whether the majority of the members of The UB40 Experience as at 25th August 2018 were, or were not, justified in "sacking" Mr Bagnall because of alleged discrepancies in the way he divided performance fees.

12. Events that occurred after Mr Lee filed the contested trade mark application are also irrelevant, except to the extent that they shed light backwards on the position at the relevant date. There is, therefore, no need to go into the parties' complaints about each other's use of social media or threats of legal action. All these things show is that, unsurprisingly, neither side was content with there being two bands called The UB40 Experience, and both sides in this dispute consider themselves to be the true band of that name.

¹ In any event, given that the 'creation' at issue involved no more than adding the definite article and the description 'Experience' to the name of an existing band, it barely counts as any kind of creative work.

The relationship between the band members

13. According to the applicant, Mr Bagnall and Mr Porter managed the band (Mr Bagnall alone after Mr Porter stood down), the other members being merely freelance musicians. Mr Bagnall provides a copy of a bank record showing payments made to Messrs Spence, Stevenson and Linton in 2015². The name of the bank account is not clearly shown, so I cannot tell whether it was in the name of the band or Mr Bagnall. According to Mr Bagnall, up to 20 freelance musicians performed with the band since 2013.

14. According to Mr Dave Linton, the band had no management structure; all seven members took on additional musical or administrative roles. Mr Bagnall and Mr Porter shared responsibility for managing contracts with venues whereas he, for example, managed some of the advertising. Mr Lee says that when he joined the band in 2017 it was on the understanding that all members of the band were on an equal footing. In this connection, he provides a copy of an electronic message he received from Mr Bagnall in 2017 in response to his applied to join³. It says that “*we split any fees 7 ways no egos no one earns more than anyone else!*” I note that the same electronic message stated that “*time off isn’t a problem with notice as we have deps [deputies].*”

15. Mr Cunningham’s evidence is that there was never a set fee for performing, as would usually be the case if the members of the band were freelance performers. The payments he received varied from £20 to £300, depending on the performance fee paid to the band.

16. I reject the applicant’s claim that the other members of the band (apart from Mr Porter) were freelance musicians. Rather, the evidence points to the band being comprised of a succession of partnerships-at-will. I do not doubt Mr Bagnall’s evidence that up to 20 musicians performed in the band at one time or another, but the evidence suggests that the band usually had seven members who worked together

² See exhibit AB12 to Mr Bagnall’s statement

³ See exhibit ML3 to Mr Lee’s statement

as a partnership. Others acted whias their deputies when they were not available. This accords with the evidence of Mr Horton on behalf of the applicant, who says that the band had a stable membership of seven performers between May 2016, when he joined, and July 2017 when Anthony Porter announced that he was stepping back from the band.

Was Mr Lee a permanent member?

17. According to Mr Bagnall, Mr Porter and Mr Horton, Mr Porter had an open-ended invitation to return to the band, if he wished. Therefore, Mr Lee was only a temporary band member. In support of their claim that Mr Porter was just taking a break, they rely on the fact that Mr Porter returned to play with the band at Tribfest in August 2018.

18. This is disputed by Mr Lee and the other band members who have given evidence in support of his case. They say that Mr Lee became a permanent replacement for Mr Porter after the latter decided to leave the band. This accords with an electronic message Mr Porter sent the other band members in June 2017 in which he told them that: *"I have decided to hang up my bass and retire"* and *"I will be available to dep (deputise) occasionally, if needed etc."*⁴ I also note that the message Mr Bagnall sent to Mr Lee in June 2017⁵ stated that *"...we are looking for a permanent bass player..."*. The post on The UB40 Experience social media account on 17th August 2018 indicated that Mr Porter was back *"for one night only.."*⁶. This accords with an email sent by Mr Bagnall (it is not clear to whom) on 12th August 2018 in which he stated that: *"Andy here from the ub40 experience unfortunately we have 2 changes to our line up on Friday."*⁷ The line-up listed in that email included Mr Porter on bass and a Mr Forrester on saxophone, instead of Mr Lee and Mr Stevenson. I conclude that Mr Porter was deputising for Mr Lee at Tribfest on 17th August 2018. Indeed, the evidence indicates that Mr Lee returned to the band for their next performance on 25th August 2018, after which Mr Bagnall was "sacked."

⁴ See exhibit ML1

⁵ See exhibit ML3

⁶ See ML43

⁷ See AB19

19. I accept Mr Lee's evidence that he was recruited as a permanent member of the band. I find that Mr Porter left the band unconditionally in July 2017 and returned once, as Mr Lee's deputy, prior to the relevant date.

The applicant's claim to own an earlier right based on passing-off rights

The relevant law

20. The essential requirements of the law of passing off are well established. They are set out in *Reckitt & Colman Product v Borden*⁸. They are (i) the existence of goodwill under a name or sign, (ii) a misrepresentation by the defendant to the public that deceives or is likely to deceive, and (iii) resulting damage to the goodwill of the business, typically through diversion of sales.

21. The issue in this case is complicated by the fact that both Mr Bagnall and Mr Lee were members of the band called The UB40 Experience. The real issue is who owned the goodwill generated by the band at the relevant date. Similar problems have arisen many times before. One of the best-known examples is *Saxon Trade Mark*⁹. The late Laddie J. considered the ownership of goodwill generated by bands with changing membership and explained that, absent a contract or agreement, the members of a band who perform for consideration are likely to constitute a partnership-at-will. This means that the assets of the band, including its goodwill (and therefore rights to its name), are partnership assets to which each member is normally entitled to an undivided share. Addressing the position where members leave the band, Laddie J. said this:

"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

⁸ [1990] 1 WLR 491 HL, [1990] RPC 341

⁹ [2003] FSR 39

and the second performs from 2000 onwards. Each will generate its own goodwill in the name under which it performs. If, at the time that the second band starts to perform, the reputation and goodwill of the first band still exists and has not evaporated with the passage of time (see Ad-Lib Club Ltd v Granville [1972] R.P.C. 673) or been abandoned (see Star Industrial Co Ltd v Yap Kwee Kor [1976] F.S.R. 256) it is likely to be able to sue in passing off to prevent the second group from performing under the same name (see Sutherland v V2 Music [2002] EWHC 14 (Ch); [2002] E.M.L.R. 28). On the other hand, if the goodwill has disappeared or been abandoned or if the first band acquiesces in the second band's activities, the latter band will be able to continue to perform without interference. Furthermore, whatever the relationship between the first and second bands, the latter will acquire separate rights in the goodwill it generates which can be used against third parties (see Dent v Turpin and Parker & Son (Reading) Ltd v Parker [1965] R.P.C. 323). If the first band is a partnership, the goodwill and rights in the name are owned by the partnership, not the individual members, and if the second band were to be sued, such proceedings would have to be brought by or on behalf of the partnership.

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

22. Considering the position up until June 2017 when Mr Porter left, the band was, in the eyes of the law, operating as a partnership-at-will made up of Messrs Porter, Bagnall, Linton, (Lewie) Linton, Horton, Spence & Stevenson. By leaving the band

and acquiescing to it carrying on without them, past members of the band had almost certainly abandoned any claim they may have had to a share in the goodwill created in earlier years.

23. The same applies to Mr Porter after he left the band in June 2017 and agreed to the band continuing without him.

24. Therefore, as at 24th August 2018, the goodwill generated by the band then performing as The UB40 Experience was owned by the partnership consisting of Messrs Bagnall, Linton, (Lewie) Linton, Horton, Spence, Stevenson and Lee.

25. There being no agreement or contractual relationship between the partners, the majority of the members of the band were in no position to “sack” Mr Bagnall¹⁰. The applicant claims that the consequence of their decision to carry on without him was that they resigned from the partnership, leaving him as the sole owner of its assets. I reject that submission. The proprietor, the Lintons, and Mr Spence clearly didn’t intend to resign from the band or, more importantly, abandon their interest in the goodwill created it. Rather, the effect of them giving Mr Bagnall notice that he would no longer be allowed to perform with them was to dissolve the partnership described in the previous paragraph¹¹. The effect of the decision of Messrs Linton, (Lewie) Linton, Spence and Lee to carry on together, but without Mr Bagnall, Mr Stevenson or Mr Horton, was to create a new partnership-at-will comprised of themselves (and possibly others).

26. However, the goodwill generated and owned by the previous partnership would not have dissipated by the relevant date, which was only 9 days after the new partnership was formed.

27. Further, it is abundantly clear that Mr Bagnall did not consent to the new partnership carrying on without him, or abandon his interest in the goodwill

¹⁰ See s.25 of the Partnerships Act 1890

¹¹ Per s.32(c) of the Partnerships Act 1890

generated under the band's name by the immediately previous partnership, or by the earlier partnerships, of which he had also been a member.

28. There is, therefore, little doubt in my mind that if the applicant had brought the invalidation application on behalf of the partnership of which he had been a member, the first requirement in establishing a passing-off right, i.e. the acquisition of a relevant goodwill, would have been satisfied. This is also necessary to satisfy the requirements of The Trade Marks (Relative Grounds) Order 2007, according to which only the owner of an earlier right is entitled to bring invalidation proceedings based on that right.

29. Mr Bagnall is not legally represented. I doubt very much whether he understood the position under partnership law when he decided to bring proceedings in his name alone¹². In appropriate circumstances, the registrar has the power to order joinder or substitution of applicants for invalidation¹³. If the application is otherwise successful, I am minded to invite and entertain an application from Mr Bagnall, if he wishes, to substitute the applicant as himself *on behalf of the partnership that existed at 24th August 2018 and traded as The UB40 Experience*¹⁴ as the applicant in these proceedings.

30. Similar ambiguity surrounds the ownership of the contested trade mark. It is registered in the name of Mr Lee alone and yet his case depends on the long-term involvement in the band of the Lintons and Mr Spence. All three of these give evidence to the effect that Mr Lee registered the trade mark with their consent and/or on their behalf. That also appears to be the gist of Mr Lee's case. In deciding whether use of the mark by the proprietor would have constituted a misrepresentation to the public at the relevant date, I will therefore assume that Mr Lee is holding the trade mark on trust for the benefit of the partnership-at-will comprised of himself, the Lintons, Mr Spence, and possibly others.

¹² It appears from his submissions that he now understands the position.

¹³ See, by analogy, the decision of Professor Ruth Annand, as the Appointed Person, in opposition proceedings in *Tao Asian Bistro*, BL O/004/11, at paragraphs 28 – 33.

¹⁴ That is to say, Messrs Bagnall, Linton, (Lewie) Linton, Horton, Spence, Stevenson and Lee.

31. Looked at like this it is clear that the position at the relevant date falls squarely within the scenario described in paragraphs 25 and 26 of the judgment of Laddie J. in *Saxon*. At the relevant date, a partnership-at-will, which included Messrs Bagnall, Horton and Stevenson, owned the goodwill generated up to 25th August 2018. The new partnership would not have acquired any independent goodwill between 25th August 2018 and 3rd September 2018. At least one of the members of the previous partnership (Mr Bagnall) did not consent to the new partnership's use of the same name for its new version of the band. The use of the same name in relation to the same services was bound to damage the previous partnership's goodwill, most obviously by diverting bookings. In these circumstances, the previous partnership had the right to sue the new partnership for passing off. And as Laddie J. explained in *Saxon*, the fact that the new partnership included members of the previous partnership makes no difference. This is because the new partnership is legally distinct from the previous partnership.

32. The position is even more stark if the question is narrowed to whether the previous partnership could have prevented the proprietor, i.e. Mr Lee alone, from using the trade mark at the relevant date. The answer is clearly 'yes', at least in relation to musical performances.

33. It is true that the registration covers a wider range of entertainment services. However, most of these cover, or could include, musical entertainment. Having regard to Mr Lee's evidence, it is clear that the list of services is meant to cover the services intended to be provided by the band in which he plays. In these circumstances, I do not intend to distinguish between musical entertainment services as such and the wider range of services covered by the registration.

34. Subject to the identity of the applicant being satisfactorily clarified and amended, as above, I find that the ground for invalidation under s.47(2)/s.5(4)(a) of the Act succeeds.

The bad faith ground

35. In *Sky v Skykick*¹⁵ the Court of Justice of the EU recently provided further clarification about the purpose and scope of article 3(2)(d) of the Trade Marks Directive (which is given effect in the UK by s.3(6) of the Act). This is as follows:

“74. The Court has held that in addition to the fact that, in accordance with its usual meaning in everyday language, the concept of ‘bad faith’ presupposes the presence of a dishonest state of mind or intention, regard must be had, for the purposes of interpreting that concept, to the specific context of trade mark law, which is that of the course of trade. In that regard, the EU rules on trade marks are aimed, in particular, at contributing to the system of undistorted competition in the European Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin (judgment of 12 September 2019, Koton Mağazacılık Tekstil Sanayi ve Ticaret v EUIPO, C-104/18 P, EU:C:2019:724, paragraph 45 and the case-law cited).

75. Consequently, the absolute ground for invalidity referred to in Article 51(1)(b) of Regulation No 40/94 and Article 3(2)(d) of First Directive 89/104 applies where it is apparent from relevant and consistent indicia that the proprietor of a trade mark has filed the application for registration of that mark not with the aim of engaging fairly in competition but with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties.”

36. Therefore, making a trade mark application with the intention of undermining, in a manner inconsistent with honest practices, the interests of a third party, amounts to an act of bad faith. Further, it is apparent from earlier case law¹⁶ that:

¹⁵ Case C-371/18

¹⁶ See *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) and the case law cited in that judgment.

- (i) The matter must be judged at the relevant date taking account of all relevant factors;
- (ii) The applicant's intention is a subjective factor which must be determined by reference to the objective circumstances of case;
- (iii) It is necessary to ascertain what the applicant knew at the relevant date;
- (iv) Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date;
- (v) An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability);
- (vi) The applicant's behaviour must be judged against honest commercial practices in the relevant trade (as opposed to the applicant's own perception of honest behaviour);
- (vii) Filing an application with the intention of preventing a third party from marketing a product or service may, in certain circumstances, be an element of bad faith on the part of the applicant;
- (viii) However, it does not constitute an act of bad faith to make an application with the intention of protecting, or testing, a reasonable belief to have acquired legal rights in the mark in the UK.

37. The facts in this case are clear. Mr Lee clearly knew that 3 members of the band he had joined in 2017 had recently left the band when he filed the trade mark application on 3rd September 2018. He considered that Mr Bagnall had been "sacked" as a result of a decision of a majority of the band. He therefore knew that Mr Bagnall had not voluntarily surrendered any rights he may have had.

38. I accept that Mr Lee reasonably believed that the members of the band who had not been sacked, or left voluntarily, consented to his application.

39. Given the nature of Mr Bagnall's departure, I consider it safe to infer that Mr Lee was aware of the probability of Mr Bagnall, and possibly Mr Porter, contesting the new group's entitlement to the name The UB40 Experience.

40. And given that the band had existing bookings when the split occurred, I also think it safe to infer that Mr Lee and the other members of the new band were aware that this might quickly become a live issue for them.

41. I find that the application was filed for the purposes of (1) preventing Mr Bagnall alone, or with Mr Porter, from performing under the mark, and (2) making it harder for Mr Bagnall to contest the claim to the mark made by the majority of the band prior to the split.

42. I do not doubt that, with the support of the Lintons, and Mr Spence, Mr Lee honestly believed that he was entitled to make the application on behalf of the majority of the members of the band he joined in 2017. On my findings, he was wrong about that. However, the critical question under this heading is not whether he was right or wrong, but whether his intentions in making the application would have been considered less than honest when judged against the normal standard of commercial behaviour observed by those in the music trade. In deciding on that matter I have borne in mind that the effect of partnership law does not appear to be widely understood by those working together in bands. The sheer number of disputes about band names involving ex-members is testament to this¹⁷. It appears that Mr Lee sought legal advice from the Musicians Union on the position of the new band. However, this only appears to have happened after the receipt of a letter from Mr Bagnall's solicitor in November 2018¹⁸, i.e. after the relevant date. It could be argued that he should have sought such advice before making the application. However, I do not think that failing to take legal advice before making the application is sufficient, alone or in combination with the other relevant factors, to constitute bad faith in this case.

43. Having given the matter careful consideration, I am unwilling to characterise Mr Lee's application as an act of bad faith. Assuming an awareness of the facts in this case, I doubt whether the average person in the music business would have been any clearer than the parties to these proceedings as to who was entitled to the rights

¹⁷ See, for example, *Burdon v Steel*, BL O/369/13, (The Animals) and *Andrew Powell v Martin Robert Turner (Wishbourne Ash Case)* [2013] EWHC 3242

¹⁸ See exhibit ML11

in, or under, The UB40 Experience at the relevant date. In my view, Mr Lee took reasonable steps to protect his continuing interests in the name of the band, and to test his claim, and that of the Lintons and Mr Spence, to the contested trade mark. I therefore find that the application was filed as part of a genuine commercial dispute, but not in bad faith. The ground for invalidation based on s.3(6) of the Act fails accordingly.

Overall outcome

44. The applicant has 2 months from the date of this decision to make an application to substitute the name of the applicant in the terms set out in paragraph 29 above. He may also apply in such alternative terms that he considers appropriate, provided that this gives effect to my direction that he may (only) apply to substitute for his name alone, the name of the partnership-at-will that existed as at 24th August 2018.

45. If no such application is made, I will issue a final decision rejecting the application for invalidation.

46. If such an application is made, I will give the proprietor one month to provide written submissions as to whether it should be allowed in the terms sought, or at all.

Preliminary decision

47. This outcome means that this is a preliminary decision. Consequently, the issue of costs will be covered in my final decision.

48. The period for appeal will also run from the date of my final decision.

Dated 24th of March 2020

**Allan James
For the Registrar**

Annex A

Arranging and conducting of entertainment events for charitable purposes; Arranging and conducting of live entertainment events; Arranging and conducting of live entertainment events for charitable purposes; Arranging of conferences relating to entertainment; Arranging of conventions for entertainment purposes; Arranging of entertainment shows; Arranging of exhibitions for entertainment purposes; Arranging of festivals for entertainment purposes; Arranging of musical entertainment; Arranging of presentations for entertainment purposes; Arranging of seminars relating to entertainment; Arranging of visual and musical entertainment; Booking of entertainment; Camp services (Holiday -) [entertainment]; Club entertainment services; Club services [entertainment or education]; Club services [entertainment]; Conducting of conventions for entertainment purposes; Conducting of entertainment activities; Conducting of entertainment events; Conducting of exhibitions for entertainment purposes; Conducting of live entertainment events; Consultancy services in the field of entertainment; Consultancy services in the field of entertainment provided via the Internet; Corporate entertainment services; Corporate hospitality (entertainment); Cruise ship entertainment services; Cultural, educational or entertainment services provided by art galleries; Digital video, audio and multimedia entertainment publishing services; Education and training in the field of music and entertainment; Education, entertainment and sport services; Education, entertainment and sports; Exhibition services for entertainment purposes; Fan club services (entertainment); Fashion shows for entertainment purposes (Organization of -); Festivals (Organisation of -) for entertainment purposes; Fetes (Organisation of -) for entertainment purposes; Film production for entertainment purposes; Gaming machine entertainment services; Gaming services for entertainment purposes; Holiday camp services [entertainment]; Holiday centre entertainment services; Hospitality services (entertainment); Hypnotist shows [entertainment]; Information (Entertainment -); Information about entertainment and entertainment events provided via online networks and the Internet; Information and advisory services relating to entertainment; Information relating to computer gaming entertainment provided online from a computer database or a global communication network; Information relating to entertainment, provided on-line from a computer database or the internet; Information services relating to entertainment; Interactive entertainment; Interactive entertainment services; Internet radio entertainment services; Interviewing of contemporary figures for entertainment purposes; Jazz music entertainment services; Kindergarten services [education or entertainment]; Laser show services [entertainment]; Lighting productions for entertainment purposes; Live demonstrations for entertainment; Live entertainment; Live entertainment production services; Live entertainment services; Multimedia entertainment software publishing services; Music entertainment services; Musical entertainment; Musical entertainment services; Musical group entertainment services; Night club services [entertainment]; Nightclub services [entertainment]; On-line entertainment; On-line ticket agency services for entertainment purposes; Online entertainment services; Online interactive entertainment; Organisation of competitions (education or entertainment); Organisation of competitions [education and/or entertainment]; Organisation of competitions [education or entertainment]; Organisation of competitions for education or entertainment; Organisation of conferences related to entertainment; Organisation of entertainment activities for summer camps; Organisation of entertainment and cultural events; Organisation of entertainment

competitions; Organisation of entertainment events; Organisation of entertainment for birthday parties; Organisation of entertainment services; Organisation of events for cultural, entertainment and sporting purposes; Organisation of fashion shows for entertainment purposes; Organisation of musical entertainment; Organisation of outings for entertainment; Organising events for entertainment purposes; Organising of competitions [entertainment] by telephone; Organising of competitions for entertainment; Organising of entertainment; Organising of entertainment competitions; Organising of exhibitions for entertainment purposes; Organising of meetings in the field of entertainment; Organising of shows for entertainment purposes; Organization of competitions [education or entertainment]; Organization of competitions for education or entertainment; Organization of cosplay entertainment events; Organization of entertainment competitions; Organization of fashion parades for entertainment purposes; Organization of fashion shows for entertainment purposes; Organizing and arranging exhibitions for entertainment purposes; Organizing and presenting displays of entertainment relating to style and fashion; Party planning [entertainment]; Planning (Party -) [entertainment]; Planning and conducting of parties [entertainment]; Play schemes [entertainment/education]; Popular entertainment services; Preparation of entertainment programmes for broadcasting; Preparation of entertainment programmes for the cinema; Preparation of special effects for entertainment purposes; Presentation of live entertainment events; Presentation of live entertainment performances; Production of audio entertainment; Production of audio tapes for entertainment purposes; Production of entertainment in the form of a television series; Production of entertainment in the form of sound recordings; Production of entertainment in the form of television programmes; Production of entertainment in the form of video tapes; Production of entertainment shows featuring dancers; Production of entertainment shows featuring dancers and singers; Production of entertainment shows featuring instrumentalists; Production of entertainment shows featuring singers; Production of films for entertainment purposes; Production of live entertainment; Production of live entertainment events; Production of live entertainment features; Production of live television programmes for entertainment; Production of television entertainment features; Production of television entertainment programmes; Providing educational entertainment services for children in after-school centers; Providing entertainment in the nature of film clips via a website; Providing entertainment information; Providing entertainment information via a website ;Providing facilities for entertainment; Providing information in the field of entertainment by means of a global computer network; Providing information on entertainment through computer networks; Providing multi-media entertainment via a website; Providing on-line information in the field of computer gaming entertainment; Providing online entertainment in the nature of fantasy sports leagues; Providing online entertainment in the nature of game shows; Providing online entertainment in the nature of game tournaments; Providing online newsletters in the fields of sports entertainment; Providing sports entertainment via a website; Providing video entertainment via a website; Providing will-call ticket services for entertainment, sporting and cultural events; Provision of club entertainment services; Provision of educational entertainment services for children in after school centers; Provision of entertainment; Provision of entertainment by telephone; Provision of entertainment facilities; Provision of entertainment facilities in hotels; Provision of entertainment information; Provision of entertainment information by electronic means; Provision of entertainment information via television,

broadband, wireless and on-line services; Provision of entertainment information via the Internet; Provision of entertainment services for children; Provision of entertainment services through the media of audio tapes; Provision of entertainment services through the media of cine-films; Provision of entertainment services through the media of publications; Provision of entertainment services through the media of television ;Provision of entertainment services through the media of video-films; Provision of entertainment via podcast; Provision of information relating to entertainment; Provision of information relating to entertainment online from a computer database of the Internet; Provision of live entertainment; Provision of multimedia entertainment programs by television, broadband, wireless and on-line services; Provision of musical entertainment; Provision of on-line entertainment; Provision of online information in the field of computer games entertainment; Provision of radio and television entertainment services; Provision of rooms adapted for entertainment; Provision of rooms for entertainment; Publication of books relating to entertainment; Publication of online reviews in the field of entertainment; Radio and television entertainment; Radio and television entertainment services; Radio entertainment; Radio entertainment production ;Radio entertainment services; Rendering of musical entertainment by instrumental groups; Rendering of musical entertainment by vocal groups; Rental of recorded data carriers for entertainment purposes; Rental of recorded entertainment; Road shows being entertainment services; Services for the production of entertainment in the form of film; Services for the production of entertainment in the form of television; Services for the production of entertainment in the form of video; Services in the production of animated motion picture entertainment; Services providing entertainment in the form of live musical performances; Showing of prerecorded entertainment; Social club services for entertainment purposes; Sound recording and video entertainment services; Sports entertainment services; Staged light entertainment services; Staging of light entertainment productions; Summer camps [entertainment and education];Symposiums relating to entertainment; Telephone conversation services for entertainment purposes; Telephone information services relating to entertainment; Television and radio entertainment; Television and radio entertainment services; Television entertainment; Entertainment; Entertainment agency services; Entertainment booking services; Entertainment by IP-TV; Entertainment by film; Entertainment by means of concerts; Entertainment by means of radio; Entertainment by means of roadshows; Entertainment by means of telephone; Entertainment by means of television; Entertainment by means of theatre productions; Entertainment by means of wireless television broadcasts; Entertainment club services; Entertainment in the form of live musical performances (Services providing -);Entertainment in the form of recorded music (Services providing -);Entertainment in the form of television programmes (Services providing -);Entertainment in the nature of a water park and amusement center; Entertainment in the nature of air shows; Entertainment in the nature of an amusement park ride; Entertainment in the nature of automobile races; Entertainment in the nature of ballet performances; Entertainment in the nature of baseball games; Entertainment in the nature of basketball games; Entertainment in the nature of beauty pageants; Entertainment in the nature of boxing contests; Entertainment in the nature of circuses; Entertainment in the nature of competitions in the field of spelling; Entertainment in the nature of dance performances; Entertainment in the nature of dinner theater productions; Entertainment in the nature of ethnic festival; Entertainment in the nature of fashion shows; Entertainment in the nature of

fireworks displays; Entertainment in the nature of football games; Entertainment in the nature of golf tournaments; Entertainment in the nature of gymnastic performances; Entertainment in the nature of hockey games; Entertainment in the nature of ice hockey games; Entertainment in the nature of laser shows; Entertainment in the nature of light shows; Entertainment in the nature of live dance performances; Entertainment in the nature of live performances and personal appearances by a costumed character; Entertainment in the nature of live performances by musical bands; Entertainment in the nature of live performances by rock groups; Entertainment in the nature of magic shows; Entertainment in the nature of mobile phone television; Entertainment in the nature of on-going television programs in the field of variety; Entertainment in the nature of ongoing game shows; Entertainment in the nature of ongoing television programs in the field of variety; Entertainment in the nature of orchestra performances; Television entertainment services; Theatre entertainment; Ticket agency services [entertainment]; Ticket information services for entertainment events; Ticket procurement services for entertainment events; Ticket reservation and booking services for entertainment events; Tv entertainment services; Video entertainment services; Video game entertainment services; Wedding celebrations (Organisation of entertainment for -); Wine tastings [entertainment services].