

TRADE MARKS ACT 1994

IN THE MATTER OF A TRADE MARK APPLICATION 2510559

IN THE NAME OF JOHN ROSSALL IN RESPECT OF THE TRADE MARK “THE GLITTER BAND FEATURING JOHN ROSSALL” IN CLASS 41 AND THE OPPOSITION THERETO (NO 99336) BY PETER PHIPPS

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**DECISION**

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**Introduction**

1. This is an appeal from the Decision of Ms Judi Pike for the Registrar dated 10 June 2011 whereby she upheld an opposition to an application made on 9 March 2009 to register the mark

**THE GLITTER BAND FEATURING JOHN ROSSALL**

in respect of certain services in class 41 on the grounds that it was confusingly similar to an earlier CTM 7176019 of the opponent (“the earlier CTM”):



2. The Decision was based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Two other prior marks were cited but neither was relied on by the Hearing Officer in her Decision because the opponent’s strongest case was based on the earlier CTM. Other grounds of opposition were also held in abeyance.

3. The Hearing Officer held that the requirements of s.5(2)(b) were satisfied in that the mark proposed to be registered was similar to the earlier CTM, was proposed to be registered for goods or services identical with or similar to those for which the earlier trade mark was protected and that there was therefore a likelihood of confusion on the part of the public within the meaning of that concept, as explained by the Court of Justice of the EU in the well-known cases to which the Hearing Officer referred<sup>1</sup>.

4. This dispute has arisen in the context of a long running battle between the applicant on the one hand and the opponent and his partners on the other over the right to use the name “The Glitter Band”. Both the applicant and the opponent were, for different periods, members of the original band known as the “The Glitter Band” which, at the height of its fame, backed the 1970s glam-rock singer known as Gary Glitter. The subsequent differences between the parties include litigation in the mid-1980s, which culminated in an injunction obtained at the suit, *inter alia*, of the opponent, restraining the applicant from using the name “The Glitter Band” or any other name incorporating the word “Glitter” in the title of any band in which the applicant played. There were subsequent proceedings for contempt of court in 1997. This resulted in an order for committal against the applicant, which was suspended upon terms.

5. There have been allegations in some of the materials from the opponent that the applicant is in contempt of court. It should be made clear at the outset that nothing said here should be taken as having any bearing on that question, which is irrelevant to the issue of whether the applicant’s mark can lawfully be registered. I must also make clear, in the light of certain submissions from the applicant, that nothing here decides whether the applicant is or was free to use any given name for a band, in the light of the opponent’s rights or any previous order of the court. If that remains in issue between the parties, it would need to be considered elsewhere. Nor do these proceedings determine whether the opponent’s original registration of the CTM (or any

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<sup>1</sup> The Hearing Officer correctly and comprehensively summarised the principles in paragraphs 12 to 13 of the Decision. They are derived principally from *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04*, *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)* and *British Sugar plc v. James Robinson & Sons Limited (TREAT)* [1996] RPC 281 (as regards similarity between goods and services). She referred, again correctly, to a number of additional authorities on the approach to determining whether goods and services were identical in para.14 of the Decision, including Case T-133/05 *Gérard Meric v Office for Harmonization in the Internal Market (OHIM)* (General Court).

other similar marks) was made in bad faith having regard to the various claims of members of the original band to use of the term “The Glitter Band”. There is a faint suggestion of this in the evidence but such a point is not made in the grounds of appeal to me and it would not be open to me to consider it.

### **The Decision**

6. Neither side asked for a hearing below, both being content for a decision on this appeal to be made on the papers. I made a Procedural Direction on 19 October 2010 concerning certain new material sought to be adduced by the applicant on appeal and, in the light of that decision and a subsequent direction, the parties have agreed that this appeal may also be dealt with on paper without a hearing. This is a sensible course and I have taken account of all of the parties’ submissions (in so far as admissible) including the most recent documents submitted on both sides. However, I have not found it necessary to refer to all of them in detail.

7. Before turning to the grounds of appeal, it is convenient to outline how the Hearing Officer’s Decision considered the four matters relevant to a determination under section 5(2)(b) of the Act and whether these disclose and prima facie errors. Those matters are as follows: (i) the characteristics of the average consumer (ii) whether the goods/services were identical or similar (iii) whether the respective marks were identical or similar and (iv) whether there was a likelihood of confusion.

#### **(i) The average consumer**

8. The Hearing Officer held, at para. 15 of the Decision, that the average consumer was the general public and that an entertainment service, particularly musical entertainment, was an audio/visual experience. She went on to say that the average consumer would encounter the marks both visually and aurally and that these were both important when considering the manner in which the marks are perceived. She considered that the level of attention would be no greater and not less than is the norm for the purchase for entertainment services.

9. In my judgment, her approach and conclusion on this issue were impossible to fault. She considered the relevant law and applied it rationally.

#### **(ii) Identity/similarity of services**

10. The applicant's mark was applied for in class 41 for "Providing musical entertainment by way of live shows and tours played in public and private venues and by appearances on television; recording and publishing." The earlier CTM was registered, inter alia, in class 41 in respect of "Education; providing of training; entertainment; sporting and cultural activities".

11. The Hearing Officer dealt with the issue of similarity and identity of services in paras. 13-14 of the Decision. She held:

"Mr Phipps' term entertainment is a wider term than the Mr Rossall's providing musical entertainment by way of shows and tours playing in public and private venues and by appearances on television; Mr Rossall's term therefore falls within the ambit of Mr Phipps' entertainment and so these services of the respective parties are considered to be identical with one another. Entertainment includes live and recorded performances; recorded performances could be a studio recording of a band or artist's musical work or recordings of their live performances. The purpose of the entertainment service is to listen to music; the purpose of recording and publishing the music is so that consumers can listen to it. Although their nature is not the same, the purpose of each is the same or, at the very least, nearly identical. The service of recording and publishing music is inextricably linked to the result: the recorded musical performance itself. Recording and publishing of music is complementary to the entertainment/performance, whether live or in a studio; there can be no recording without a performance. Mr Rossall's recording and publishing of music is highly similar to Mr Phipps' entertainment services."

12. There is no flaw in the Decision in this respect that I have been able to identify, either as to approach or as to result.

### **(iii) Similarity of marks**

13. The Hearing Officer considered the similarity of the respective marks at paras. 16-21 of the Decision. She took account of the distinctive character but held that the evidence did not support a claim to enhanced distinctiveness.

14. The Hearing Officer found that the distinctive and dominant component of the earlier CTM was the phrase "The Glitter Band" and that the earlier CTM was distinctive to a good degree. The Hearing Officer was, again, in my view plainly right.

15. She held that both marks shared the same dominant distinctive component, namely the words "The Glitter Band". Having considered a wide range of factors at para. 20, she held that

the degree of similarity between the marks was “reasonably high”. That approach and reasoning cannot be faulted.

**(iv) Likelihood of confusion**

16. Finally, the Hearing Officer came to the issue of likelihood of confusion, having regard to the principles articulated in the *Canon* case. Having found a similarity or identity of the services, a good degree of distinctiveness of the prior mark and that the mark proposed to be registered shared the distinctive and dominant element of the prior mark, a finding of confusion was highly likely.

17. The Hearing Officer took the view that the only real question was whether the presence of the words “featuring John Rossall” in the applicant’s mark negated what was otherwise a likelihood of confusion, comparing the marks as a whole. She concluded that it did not.

18. The Hearing Officer held, having considered the impact of the additional words, that the inclusion of Mr Rossall’s name in the mark would not counteract confusion. I agree. The particular manner in which Mr Rossall’s name appears in the mark is unlikely to counter any confusion which is, *prima facie*, likely. It may, if anything, reinforce it. The mark as a whole is likely to be taken by at least some members of the public as saying that the undertaking providing the services in question is “The Glitter Band” *additionally* featuring Mr Rossall thereby signally that the undertaking providing the services is “The Glitter Band”. As the Hearing Officer said, the average consumer will either assume that John Rossall is a band member or that The Glitter Band is performing with a guest artist called John Rossall. In either case, the presence of the words “featuring John Rossall” in the manner in which they appear would not reduce the likelihood of confusion.

19. The Hearing Officer said that there was therefore not only a risk of confusion but that confusion was inevitable (paragraph 23). In my judgment she was right, both as to approach and result.

20. There was some evidence, the value of which is questionable, by way of a letter from Mr Ray Martin, Director of BCM Promotions Ltd, dated 5<sup>th</sup> November 2009, saying that the agency had been booking both “The Glitter Band” and “John Rossalls Glitter Band” for 8 years and that

there was “no confusion in the minds of the public and in his opinion”. There is no such evidence directed to the specific mark in issue which is “The Glitter Band featuring John Rossall”. There is therefore, in my judgment, nothing in the evidence which undermines her evaluation.

21. Having considered the Decision, I now turn to whether any grounds have been provided by the applicant for overturning it.

### **Approach to Appeal**

22. An appeal in a case of this kind is a review of the Hearing Officer’s Decision. Robert Walker LJ (as he then was) said of such appeals:

“...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle” (*Reef Trade Mark* [2003] RPC 5 at [28]; see also *BUD Trade Mark* [2003] RPC 25).

23. Since the applicant is unrepresented, it is fair to explain that this means that I can only reverse the Hearing Officer’s Decision if it contains a distinct and material error of principle or was clearly wrong. It is not open to me to look at the case again from scratch in the absence of such an error.

### **Grounds of Appeal**

24. I therefore turn to consider whether there the grounds of appeal raise any material error of principle in the Hearing Officer’s approach or was plainly wrong, having regard to the fact that, prima facie, no such error is discernable.

25. The grounds in this case make essentially three points, under separate heads.

26. First, it is said that the Hearing Officer was wrong to conclude that Mr Sheppard’s interest in the prior trade mark was assigned in 2003. It is said that this was in 2008. Even if this is correct, it is not relevant to the Decision or any ground for reversing the Hearing Officer. The basis for the Hearing Officer’s Decision was and, given the law, was bound to be, the narrow question of whether the earlier CTM was confusingly similar to the mark applied for. The Hearing Officer was neither obliged nor permitted to engage in a wide ranging enquiry into the earlier transactions with respect to the marks.

27. Second, it is said that the opponent performed fewer performances under the name “The Glitter Band” than were stated in the Decision. In a further document served by the applicant entitled “Extended Statement of Appeal Against the Registrar’s Decision dated 10<sup>th</sup> June 2011”, this point is developed, with a number of further documents purporting to show that the opponent did not perform at all of the venues in question on the dates stated. Even if this late material were to have been admissible on this appeal which, for the reasons I have given in earlier procedural rulings it is not, it does not impugn the Hearing Officer’s Decision.

28. Third, it is said that, in para. 13 of the Decision, the goods and services are “more specifically” the songs. Whether that is so or not, it does not cast doubt on the Hearing Officer’s assessment of the similarity of the services in respect of which the marks in question are registered. It is not a basis in law for overturning the Decision.

29. It is additionally said that the Decision affects the livelihood of the applicant and other musicians. Even if that was so, it would not be a basis in law for overturning the Decision of the Hearing Officer. This decision does not concern the issue of whether the applicant would be able to trade under any given name. It is also said that there are examples of co-existence of other bands featuring names such as “The Rubettes featuring Alan Williams/The Rubettes featuring Bill Hurd”. That too is sought to be advanced on the basis of further evidence. However, even if it were true that such co-existence took place in certain cases, it would not be relevant to the present case and the grounds of opposition advanced. This case concerns only the narrow point of whether the mark “THE GLITTER BAND FEATURING JOHN ROSSALL” may be registered for the specific goods and services in question, having regard to the need to compare the marks, without any extraneous material.

### **Admissibility of further evidence**

30. The applicant annexed a number of exhibits to the more recent submissions. I held in the Procedural Direction on 19 October 2011 that, in the light of the relevant principles relating to the admissibility of fresh evidence on appeal which I set out in full there, that this material was *prima facie* inadmissible. I gave the applicant an opportunity to persuade me that this provisional view was wrong. In a Second Procedural Direction dated 31 October 2011, I set out the applicant’s submissions in full on this issue following that direction. These submissions did not,

contrary to my earlier direction, address each of the *Ladd v. Marshall* requirements. The applicant's response did not explain why the evidence was relevant to the grounds of appeal or the basis upon which this opposition must be decided.

31. The Hearing Officer's Decision was based on a CTM for which no proof of use was required. Evidence relating to use was irrelevant and the new material could not satisfy one of the fundamental requirements of admissibility, having regard to the *Ladd v. Marshall* principles and *EI Du Pont De Nemours & Company v S.T. Dupont* [2003] EWCA Civ 1368, [2004] FSR 15, [2006] 1 WLR 2793, namely that it would have a material bearing on the case.

32. The additional points made under that head relating to the alleged performances together with an alleged agreement are also not relevant to any ground of opposition advanced in this case. Nor are any of the submissions regarding the position taken in settlement or any other aspects of the alleged approach of the opponent or his representative. I should make it clear that I do not consider that there is any substance prima facie in the suggestions of wrongdoing on the part of the opponent's representative.

33. None of the submissions made by the applicant, each of which I have considered with some care, has therefore persuaded me that the provisional view of inadmissibility I took was wrong. This additional material is inadmissible in this appeal and I have not had regard to it in deciding this appeal. Whether any of this material has a bearing on the wider dispute between the parties must be determined elsewhere.

### **Conclusion on the grounds of appeal**

34. None of the points made in the grounds of appeal (even as supplemented by the arguments in the applicant's Extended Statement, to the extent that the argument in that document is admissible) and the applicant's most recent submissions show that the Hearing Officer made any material error of principle or that she was so wrong in her evaluation of the facts that this tribunal should interfere within the meaning of the *REEF* case.

35. Viewed in the manner in which the law requires the comparison to be made for trade mark registration purposes, "THE GLITTER BAND FEATURING JOHN ROSSALL" is confusingly similar to the earlier CTM, the distinctive and dominant element of which is "THE

GLITTER BAND”. Whether that is so of any other mark which the applicant may use is not in issue in this case.

### **Contents of the grounds of appeal**

36. Finally, the opponents have criticized the grounds of appeal for failing to conform with the requirements of Rule 57(1) (as interpreted by *Coffeemix TM* [1998] RPC 717) of fullness and completeness. There is some force in this submission and it is necessary to read the applicant’s documents in this case with a particularly charitable eye to treat them as satisfying the rule. However, in my view, that rule does not require the appellant to set out grounds that are good grounds of appeal. Even if the grounds are fundamentally misconceived as a matter of law, a statement of grounds of appeal conforms with Rule 57 if it sets out clearly and completely what those grounds are.

### **Conclusion**

37. In the circumstances, since no sufficient grounds have been given for overturning the Hearing Officer’s Decision, this appeal must be dismissed.

### **Costs**

38. As to costs, contrary to the applicant’s submissions, there was ample basis for an award of costs by the Hearing Officer and I would not disturb her award.

39. Since the opponent has also succeeded on appeal, I confirm that award and award the further sum of **£450** in respect of the written submissions in lieu of a hearing on this appeal and the other submissions which required to be made to deal with the issue of admissibility and whether there should be an oral hearing.

40. This decision is being provided a few days before the date originally fixed for the hearing which turned out to be unnecessary. In all the circumstances, I am therefore going to give the applicant a slightly extended period for payment of these sums than ordered by the Hearing Officer and order that a payment of should be paid within 21 days of the date of this decision.

## **Order**

**The appeal is dismissed and the applicant must pay £2000 to the opponent as a contribution to his costs of these proceedings, including this appeal, within 21 days of the date of this decision.**

DANIEL ALEXANDER QC

Appointed Person

28 November 2011

## **Representation**

The applicant appeared in person.

R Khilkoff-Boulding, Estate and Corporate Solicitors, for the opponent.