

O-480-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3017756  
IN THE NAME OF HOWARD TOSHMAN

AND

OPPOSITION UNDER NO 401188 THERETO  
BY EILEEN DALY

## **Background**

1. On 12 August 2013, Howard Toshman (“the applicant”) filed an application under no 3017753 to register the trade mark The Courtesans in respect of:

Class 9:

Transmission or reproduction of sound or images, compact discs, DVD’s and other digital recording media

Class 25:

Clothing

Class 41:

Entertainment

2. Following publication of the application in *Trade Marks Journal* 2013/036 on 6 September 2013, notice of opposition was filed by Eileen Daly (“the opponent”). There is a single ground of opposition, brought under section 5(4)(a) of the Trade Marks Act 1994 (“the Act”) on the basis of passing off. Ms Daly claims she has used the sign ‘The Courtesans’ since “on or around 1998” throughout the UK in respect of DVDs, Films, Recording media, Clothing and branded merchandise including signed cups, photos, records and entertainment”.

3. Mr Toshman filed a counterstatement in which, essentially, he denied the claims made. Both parties filed evidence and the matter came before me for a hearing on 14 October 2014 when Mr Toshman represented himself and Miss Maria-Christina Peyman of Nockolds Solicitors represented Ms Daly.

## **The evidence**

4. The opponent’s evidence takes the form of two witness statements by Eileen Daly, with a total of 14 exhibits. The applicant’s evidence consists of a single witness statement of Howard Toshman and 42 exhibits.

5. On 10 October 2014, i.e. just a few days before the hearing, Mr Toshman forwarded by email what he referred to as “four additional pages of exhibits” asking that they be taken into consideration. As I indicated at the hearing, no information to support a request for leave to file late evidence was given and I declined to allow its admittance as evidence. Given its content, however, and with the agreement of the opponent, I was prepared to consider it as submission. I have taken all material into account in reaching my decision.

## Opponent’s evidence

6. Eileen Daly states she is the founder and lead singer of “a music band” called The Courtesans which “performs music with a gypsy/glam/rock & roll slant to it”. She states she formed the band in 1998. Ms Daly states she is also “an actress in cult gothic horror films and as such my work as an actress and my music with The Courtesans are intrinsically linked as the music is often used in my films”.

7. Ms Daly exhibits the following:

ED1: A copy of a Wikipedia entry which she says has been in place since 2005. From its contents, the entry is much more recent as it refers to matters in 2013 and 2014. She states the entry is for The Courtesans but, in fact, the entry is headed Eileen Daly. I note that the first paragraph states that Ms Daly “fronts her own band called the Courtesans who formed in 2005” which appears to contradict Ms Daly’s evidence given in her witness statement.

Under the heading “Television” the text states:

“Daly has acted in a number of television shows and adverts...

With the formation of Redemption TV by her then boyfriend Nigel Wingrove, Daly was given the chance to present her own magazine show...”

Under the heading “Film career” it states:

“Daly met Nigel Wingrove and together they started up a company called Redemption Films”

Under the heading “Music Career” it states:

“Daly’s most recent music project, The Courtesans features Daly (vocals) with Ben Thirkettle (music). Eileen started the Courtesans in 1998, whilst her other musical project Jezebel was put on hold. The duo play a combination of what they describe as “gypsy, glam and rock” and are currently working on their first album. Their first single featuring *Webcam Girl* and *Burnout* was released on distinctive pink vinyl in 2007 and a follow up EP *Elving About* features three tracks *Mazeltof*, *Doll* and *Peckham Rolex* and a video to their song *Peckham Rolex* directed and filmed by Jack Doyle, lit by Daniel Land and edited by James Brady.

The group have regularly played around London and Southern England together with appearances at festivals in Glastonbury, Bram Stoker International Film Festival and Italy. They have changed their lineup several times since their formation and have performed both Electric and Acoustic sets. A track by the band features in the forthcoming film *Rose – The Movie* and the band will provide the title track for the film which is scheduled to premier at Cannes.

The Courtesans will be releasing their first album, ‘The Courtesans’ one song at a time for digital download throughout 2013 and 2014. The first two songs have already been issued in this way. Each song will have an accompanying video. They will be promoting the album live from September 2013 and throughout 2014. The video of the first single, “Burnout” featured on Loaded TV’s ‘Dial M’ throughout 2013.

Daly formed a band called Jezebel in 1998 which played in her own words “an eclectic mix of rock, Goth and perverse fairy tales.” The first album, *Forbidden Fruit* was released on 26 March 2004 on the record label Triple Silence, a music label linked to Redemption...”

Under the heading ‘Gipsyphilia Productions’, the article states (with footnotes omitted):

“In 2012, Eileen started her own production company called Gipsyphilia Productions. With this company she has started her career as a director, writer and producer. One of the first shows she directed was ‘Daly Does The Dead, a ghost hunting show that takes the team to a haunted hotel in Whitby. Eileen writes the scripts for all the shows and films, although most of the acting is improvisation. Her band The Courtesans provide all the music for the productions. In its first year Gipsyphilia Productions have made several magazine and ghost hunting shows; ‘Mr Crispin at your Cervix’, ‘Daly Does Webcam Girl’, ‘Daly Does Porn Stars’, ‘Daly Does Ghosts’ and also has several feature films and shows in pre-production.”

ED2: Said to be a copy of a registration certificate issued by The Worldwide Band Name Registry showing registration of “The Courtesans of London United Kingdom” as of November 26, 2011. The page also shows a logo of Bandname.com which indicates it was established in 2007. No explanation is given as to who this entity might be and no details of any membership or ownership of the band is shown.

8. Ms Daly states The Courtesans first made a television appearance on ITV in 1998 with another appearance on Redemption TV and the ‘Peek-a-Boo’ show in 2006. At ED3 she exhibits what she refers to as “print outs of the front sheet”. The exhibit consists of two pages taken from youtube.com. The first is headed “Eileen Daly on a ITV Show ‘Nightlife’ with The Courtesans (1998)”. The picture shown on the page is not of good quality but I can see that it shows the face of a woman against what appears to be a field. The second page is headed “The Courtesans Live (2006) The Peek-a-Boo Show”. It refers to “The Courtesans first Live TV appearance on the Peek A Boo Show, 2006”. The picture shown on the page shows the top half of a woman in front of a doorway.

9. Ms Daly states the band released its first single on vinyl in 2007 (Webcam Girls). She states it was manufactured and distributed as a limited (700) edition 7” single on the Triple Silence label and that the printed sleeve artwork “copyrights the songs to The Courtesans as 2006, and the sleeve art to Triple Silence, copyright 2007”. She does not exhibit the sleeve but at ED4 exhibits a page taken from the discogs.com website. Headed “Courtesans, The-Webcam Girl/Burnout (Vinyl) at Discogs” it shows what I take to be a picture of the sleeve. Though I can see it shows a drawing of a naked woman and what I take to be THECOURTESANS, I can see no other text on it. The page notes the release date of the single to be 9 April 2007 and states it was “Limited to 666 hand-numbered copies on pink vinyl”.

10. Ms Daly states that as part of the relationship with Triple Silence, the band were filmed in concert: “several times during 2007 and 2008 for Redemption TV (subsequently Rockworld TV, which is what Redemption was rebranded as in late 2007). Elements were subsequently broadcast on SKY TV until late 2007.”

11. Ms Daly states that “Between 2008 to date, (her statement is dated 18 April 2014) The Courtesans have released further songs for digital download, recorded music for films, and performed at a number of live venues and festivals”. She states these have included playing at “Brixton... 12 Bar, 100 Club and Dingwalls in London”. She states the group “performed at the premiere of a Jack Doyle film in Manchester on 14 November 2008”.

12. Ms Daly states that the band’s manager at Triple Silence is Nigel Wingrove and that he is the person who registered thecourtesans.net website for them. At ED5 she exhibits a copy of an email from Mr Wingrove to Ms Daly dated 26 August 2013 in which he states “Hi Nips, I’ve spoken to Network Solutions and we registered the domain thecourtesans with them on the 14<sup>th</sup> June 2011...” .

13. Ms Daly states that the website gives information about “what The Courtesans is currently doing [and] sells merchandise including T-shirts, their own music and posters, all branded as The Courtesans. In addition to the website, The Courtesans have a significant social media presence including on YouTube, Facebook, Pinterest, Twitter, Word Press, Bebo, Googleplus and My Space (amongst others).” She gives no details of when this ‘presence’ began nor the form it takes nor are any downloads exhibited to her witness statement which shows any online activities or sales on any of the aforementioned (or other) platforms.

14. At ED6 is exhibited another email from Mr Wingrove to Eileen Daly. It is dated 26 August 2013. It states:

“I am writing to confirm that in 2007, our record label, Triple Silence, manufactured and distributed a limited edition 7” single entitled ‘Webcam Girl /Burout’ (sic) by the band The Courtesans....We also filmed The Courtesans in concert several times during 2007 and 2008 for Redemption TV which was broadcast on SKY TV between December 2006 and later 2007, and subsequently for Rockworld TV, which is what Redemption was rebranded as in late 2007.”

15. Whilst the email is headed “Statement by Nigel Wingrove, Managing Director Salvation Films” it is addressed “To Whom it May Concern” and is not in evidential form. Mr Wingrove has not filed evidence in these proceedings.

16. Ms Daly states “The Courtesans have used a number of logos and branding over the years”. At ED7 she exhibits a copy of each. There are three pages each with one logo on it. The first shows the words The Courtesans written in cursive script. Ms Daly says this version has been used “since mid-2012 on their website for internet promotion”. The second shows a device of skulls, roses and peacock feathers with the words The Courtesans in capitals superimposed over the decorative feature. Ms Daly states this was the version used “since 2011 predominantly for t-shirt designs”. The third shows the words The Courtesans in stylised capital letters which she states

“began being used in 2005 as the band commenced the preparation for the release of material”. No examples of any use of any of these logos in relation to sales or promotion of particular goods or services at particular dates are included within the evidence.

17. At ED8, Ms Daly exhibits what she states is a copy of a “social media extract” from a fan. She says the person has “clicked onto links bearing the name ‘The Courtesans’ only to find that it was not The Courtesans but Mr Toshman’s band”. In fact, the exhibit shows nothing of the sort. The exhibit appears to have been downloaded from facebook and whilst it enquires as to whether “Eileen and Ben... are aware of another London based band” of the same name, it gives no information to explain how the writer is aware of this. The extract is not dated.

18. At ED9 is exhibited what is said to be a page from the applicant’s band’s youtube page. It shows it to have been published on 24 December 2012 and refers to a debut album in April 2013. It also indicates that the video linked to the page is age-restricted and has had 12,834 views.

19. At ED10 is exhibited a short exchange of emails between Nigel Wingrove and the applicant regarding the name The Courtesans. There are three mails, of which only the latter is dated (29 January 2012) though it refers to an earlier communication of 29 November. From the content, it appears this exchange was initiated by Mr Wingrove who sought to persuade the applicant to change the name of the band he represents.

20. At ED11 Ms Daly exhibits a facebook page from the “koosh” site which she says confuses the applicant’s and opponent’s bands. She says it shows tour dates for the applicant’s band but contains text in which reference is made to her band. In fact it does no such thing: whilst the text does refer to Ms Daly and her band, it does not show any tour dates for any band and there is nothing on the page that I can see that links anything on it to Mr Toshman or his band. The page is dated 17 April 2014.

21. In her second witness statement, Ms Daly refers to the name of her band and states it “has not existed solely as Eileen Daly and The Courtesans” though remixes of records have been issued under this name. Although it is not entirely clear, I take it from this submission that the band is sometimes referred to as The Courtesans but at other times is referred to as Eileen Daly and The Courtesans. She gives no details of what name was used at any given time, when the remixes were issued nor whether any sales took place. She goes on to state that “at one stage we were working with Maori Music Publishing (UK) Limited (“Maori”) who dealt with PRS matters for us”. At EDA she exhibits a copy of an email sent to her from Maori which is dated 29 April 2014 and which has, as its subject, “Eileen Daly & The Courtesans”. The email is from someone identified only as “Nev” and states “I’ll be sending a more formal response with documentary evidence in a few minutes” and “As you chose to revoke your agreement/s with Maori Music in 2013, there’s not a lot more I can do for you...”. “Nev” has not been further identified nor has he filed evidence in these proceedings but, at EDB is exhibited what Ms Daly says are PRS statements sent to her by Maori.

22. The exhibit at EDB consists of a single page presented as three columns. In the first, headed column A, is what appears to be a letter from Nev Barker on behalf of both Maori and Confidential Records (UK) Ltd to Ms Daly. It is dated 13 April 2012 and shows total royalties of £1472.94 equally divided between seven titles and with the source given as "UK General Live". Under column B, which bears the date 23 January 2012, the same seven titles are listed. They are said to have been written by "Eileen Daly, Ben Thirkettle and Ralf Cardel" and recorded and performed by "Eileen Daly and The Courtesans". The "interested party" is also said to be "Eileen Daly and the Courtesans". In column C, on which is handwritten the date 11/1/12, the same interested party is listed. Both of the latter columns are headed "online services>unpaid performances" and no values are shown in any of the sub-columns.

23. At EDC is exhibited a copy of printouts taken from an unidentified website which refers to an event at the 100 Club on 14 April 2010. The text refers to a "launch gig for the AidsBeGone CD, a various artists compilation intended to be a fundraiser for AIDS charities" and refers to an evening with Angie Bowie, The Duel and The Courtesans. It goes on to say:

"While AIDS might have dropped out of the headlines in recent years, it hasn't gone away. There's still work to be done to beat it, and to support those who've got it. Good cause, then, no question. But without wishing to be a wet blanket, I'm not entirely sure how much dosh the AidsBeGone CD will actually raise, for it features a line up of mostly unknown artists. To be blunt about it, we are not in Bob Geldof territory here. The Duel, our middle band tonight, are about the best known of the contributors. Angie Bowie herself, who'd lend a certain amount of above-the-parapet profile to the track listing, isn't featured on the CD. It's a grass roots effort, then, and no less worthy for that. But in the absence of any star contributors, any cash the project may raise will inevitably be limited.

Last time I saw The Courtesans, they were playing upstairs at the Slimelight, and vocalist Eileen Daly was wearing rubber- a slinky fetish image that couldn't quite make up for the fact that the band were galumphing pub rockers. This time she's a fab gear sixties chick, and the band has a revised line up and a sharpened up sound...."

### The applicant's evidence

24. Mr Toshman's witness statement consists, to a large extent, of a critique of Ms Daly's evidence or the nature of her performances in films. For this reason, I do not intend to summarise it but will refer to it as necessary in this decision.

### **Decision**

25. Section 5(4)(a) of the Act states:

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) .....

A person thus entitled to prevent the use of a trade mark is referred to in the Act as the proprietor of an “earlier right” in relation to the trade mark.”

26. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It 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.”

27. 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."

28. The earlier use by the opponent must relate to the use of the sign for the purposes of distinguishing goods or services. For example, merely decorative use of a sign on a T-shirt cannot found a passing off claim: *Wild Child Trade Mark* [1998] RPC 455 (AP).

29. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (House of Lords), the court stated:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

30. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

31. In *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat), however, Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

32. As to the extent of goodwill, in *Hart v Relentless Records* [2003] FSR 36, Jacob J. (as he then was) stated:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark [1969] R.P.C. 472*. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had

been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

33. Nevertheless, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA).

34. I have to consider what the position was at the relevant date. In determining what this is, I note the decision in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, where Mr Daniel Alexander Q.C. as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could

be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Allan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

35. In his evidence, Mr Toshman states that he formed the band he manages under the name The Courtesans on 14 June 2011 "although the facebook URL was acquired in May 2011 along with other preparatory activities carried out prior to this date" which might suggest the relevant date to be earlier than the date of filing of the

application for registration. In its skeleton argument and re-iterated at the hearing, the opponent maintained the relevant date is the application filing date. Given the date of actual first use by the applicant is unclear, the application filing date is the date on which I will consider the matter though for the avoidance of doubt, I do not consider my finding would have been any different had any earlier date been considered.

36. Ms Daly refers to the registration of the group's name with the so-called Worldwide Band Name Registry in November 2011. No evidence is given as to who this might be or what authority, if any, it has but, in any event, passing off does not protect a name. What has to be shown is use of the sign for the purposes of distinguishing goods or services and which accrue to the opponent.

37. As was submitted at the hearing and is mentioned in the evidence at ED1 under the heading "Music Career", "[the opponent's band has] changed its lineup several times since their formation". No further details are given of these changes or when they occurred but I note, for example, that the evidence at ED4 refers to Ms Daly on vocals, Mr Thirkettle on guitar and bass and a Martin Symonds on Drums, and the evidence at EDB refers to Ms Daly, Mr Thirkettle and a Ralf Cardel. Others are mentioned elsewhere and the band appears, latterly, to be a duo. Ms Peyman submitted that Ms Daly had been the frontman of the group at all times and was said to have had the agreement of another member, Mr Thirkettle who attended the hearing, to bring these proceedings. Whilst there is a degree of uncertainty as to the composition of the band at the relevant date, it was open to Ms Daly to invoke the law of passing off for the protection of any goodwill and reputation to which the members of the band were collectively entitled (see the comments of Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Burdon v Steel*, BL O/369/13).

38. In addition to the uncertainty about the composition of the band, as can be seen from my summary of Ms Daly's evidence, there are several references to the formation of it with widely varying dates being given as to when this took place. I note that at the hearing, Ms Peyman excused the discrepancy by submitting that the band was originally formed in 1998 but was "not used" until 2004 when Mr Thirkettle joined, with the band being re-launched in 2005.

39. As set out above, there is evidence that a first single, Webcam Girl/Burnout, was issued in 2007. That is said to have been a limited edition of either 700 or 666 records, issued on pink vinyl (the discrepancy in numbers shown in various parts of the evidence is not material). What is material is that there is no evidence of how many, if any, of these have been sold at any time and certainly no evidence which relates to a period on or before the relevant date. Indeed, Mr Toshman has exhibited at HT22, a printout from the Gipsyphilia website, downloaded in January 2014, which shows that this pink vinyl limited edition record is still available for purchase some seven years later despite the very low number issued, which suggests the impact at launch would have been limited in the extreme.

40. Mr Toshman submits that in order to benefit from royalties and to register ownership to the writer(s), professional musicians will register with the Performing Rights Society ("PRS"). Ms Daly has filed material said to be from the PRS showing notification of payments of £210.42 each in relation to seven songs under cover of a

letter dated 13 April 2012. Mr Toshman challenges the authenticity of this document and, at HT23 and HT24, exhibits copies of documentation from the PRS showing that whilst Burnout was first registered with them on 23 January 2012 (with a 50/50 split between Ms Daly and Mr Thirkettle as composers/authors), Webcam Girl was not registered with them for the first time until 20 September 2013 (with 100% of the rights accruing to Ms Daly as composer/author). Ms Daly has not directly answered that criticism but I note that in her second witness statement and shown elsewhere in the evidence, Ms Daly refers to songs being issued originally under the name The Courtesans and re-issued at a later, unspecified, date as a re-mix under the name Eileen Daly and The Courtesans.

40. Ms Daly also gives evidence of the band appearing in films and television programmes. Whilst she refers to the band being recorded by Redemption Films, this is, with another, her own company and there is no evidence that any recordings were made available to the public or what was shown and whether the band was even mentioned and if so, what it was called. Ms Daly states that the band has provided the music to films in which she has performed which were produced by her production company Gipsyphilia and so there is an inextricable link to her. This company is said to have been established only in 2012 and there is no evidence provided to show any sales, distribution or audience figures for those films in any format nor any evidence of whether or how the band are identified in those films, if at all, given that the music is unlikely to be the primary reason why the films are watched.

41. As to the television programmes, the group is said to have appeared on an ITV show, Nightlife, in 1998 and been recorded for Redemption TV in 2006. There is no evidence of what was shown on these programmes, what, if any, reference was made to the band or how many people may have seen them whenever they were shown. That said, a screen shot exhibited at ED3, shows a link to a youtube video of less than five minutes entitled "Eileen Daly on a ITV Show 'Nightlife' with The Courtesans (1998)". The page indicates it was published on 4 September 2012 and had been viewed 222 times at the date of the print which was 17 April 2014. A similar screen shot published on 27 August 2013 referring to the Peek-A-Boo show on Redemption TV in 2006 is shown to have had 5 views. Again, Mr Toshman disputes the authenticity of these entries and further submits that the titles shown for videos on youtube are chosen by the person who uploads them. As neither video has been included in the evidence, it is not possible for me to make any finding as to their authenticity, the accuracy of the titles or, as indicated above, to determine what their content might have been and whether the band was shown or referred to. Ms Daly states that certain "elements" of a concert filmed by Redemption TV were broadcast by Sky TV. She gives no details of whether Redemption/Rockworld TV broadcast any footage they may have filmed nor, if so, when, where or to how many people it was broadcast. Neither does she give any details of what the "elements" were that were broadcast on SKY TV or when or what they might have shown nor, again, who might have seen it.

42. In relation to performances given by the band, Ms Daly says several took place in venues around the UK but she gives no details of when all but one of these took place or who might have attended and neither has she filed any evidence of e.g. advertising of these performances. The exception is a charity event taking place at

the 100 Club in London in April 2010 at which the band was due to appear. I shall return to this shortly.

43. Whilst the opponent claims to have used the mark on a range of goods and services as set out in paragraph 2 above, this is, for the most part, an entirely unsubstantiated claim. There is, for example, no evidence from the trade or the public and no evidence of turnover or advertising expenditure. In her witness statement, Ms Daly refers to the sale of e.g. T-shirts and posters but, as set out above, decorative use cannot found a claim for passing off and the opponent has filed no evidence to show what might have been offered for sale or under what sign nor has she filed any evidence of e.g. any sales or even advertising of these goods at any time.

44. At best, there is evidence of the issue of one record and one live performance (at the 100 Club) before the relevant date. It is not clear from the evidence whether the record was issued under the name The Courtesans or Eileen Daly and The Courtesans but there is no evidence which shows any sales of that record, though given the low number produced and the fact that the record remains available to buy, any sales must have been miniscule in the context of the relevant market. Nor is there any evidence to show that the event at the 100 Club was brought to the attention of the relevant public or how many people attended, if indeed it went ahead. The screenprint evidenced at exhibit EDC which refers to the event, was taken from an unidentified website whose audience and reach is not known and suggests the performers, which included “The Courtesans”, was made of up “mostly unknown artists” which goes nowhere near supporting the claimed goodwill or reputation. The fact that the event was supported in some way by the ex-wife of a well-known musician, herself not shown to have been known for her vocal abilities, does not improve the situation. Whilst the author went on to refer to the Courtesans and Ms Daly and the “last time I saw [them],” no evidence is given of where or when this might have been or who else might have been present.

45. Whilst Ms Daly herself may have had some exposure in films, made for the most part, it would seem, by a company of which she is an officer and for a niche audience, that body of work is not at issue here. The issue to be determined is whether the evidence shows there is goodwill in the sign The Courtesans as claimed by Ms Daly. She has made various claims but has not substantiated them, and much of her evidence is contradictory, unclear or unfocussed and subject to a certain degree of exaggeration. Taking that evidence as a whole, I find she has not shown the requisite goodwill existed in the sign The Courtesans at the relevant date in relation to any of the goods or services claimed. That being the case, the claim made under section 5(4)(a) falls at the first hurdle.

## **Summary**

46. The opposition brought on grounds under section 5(4)(a) of the Act fails.

## **Costs**

47. The opposition having failed, the applicant is entitled to an award of costs in his favour. I take into account that both parties filed evidence, a hearing was requested

and the fact that the applicant represented himself during all stages of the proceedings and thus would not be subject to the usual scale of costs but a proportion of it. I do not consider it necessary or proportionate to make further enquiries as to the costs to which the applicant has been put. There was a single issue to be determined and the evidence filed, whilst not extensive, would have taken some time to review and/or prepare. In all the circumstances, I consider the sum of £800 to be a reasonable award to reflect the time and effort involved in defending his application.

48. I order Eileen Daly to pay Howard Toshman the sum of £800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 10th day of November 2014**

**Ann Corbett  
For the Registrar  
The Comptroller-General**