

O-512-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3015244
BY PAMELA BURGESS
TO REGISTER THE TRADE MARK
SUITE ELITE
IN CLASSES 9 & 41
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 401074 BY
PAUL AND STACEY BOXWELL**

BACKGROUND

1) On 24 July 2013 Pamela Burgess (hereinafter the applicant) applied to register the trade mark SUITE ELITE in respect of the following services:

In Class 9: Compact discs and DVDs; digital music (including downloadable from the Internet); recording discs; audio and video recordings; transmission and reproduction of sound and images; software for the recording, transmission and reproduction of music, videos, screensavers, wallpapers, ringtones, MP3s, games, photographs, chat boxes and discussion groups; apparatus, instruments and software programs for producing audio or visual recordings; apparatus, instruments and software programs for transmission and reproduction of sound and images; computer software for computer games; video accessories; cinematic and photographic apparatus and instruments; computer games; video games; electronic publications; downloadable electronic publications; electronic games; parts, fittings and accessories for all the aforesaid goods.

In Class 41: Entertainment and entertainment services; production and publishing of music; hiring out sound recordings; recording studio services; television, film, audio and radio production and distribution; publishing of electronic publications; organisation and provision of corporate events, games and competitions, including via the Internet; organisation, presentation and production and performance of shows and live performances; educational services; DJ services; organisation of dance events and discos; musical performances; record production; provision of club services; entertainer services; provision of musical entertainment; provision of live entertainment and information services relating to the foregoing; party planning; performance services; providing facilities for, arranging and conducting parties, dances, nightclubs and discotheques; film events; musical events; cultural and sporting events; live events; arranging of film events, musical events, cultural and sporting events and live events; audio entertainment services; audio-visual display presentation services for entertainment purposes; services providing entertainment in the form of live musical performances or recorded music; entertainment services performed by a musical group, by musicians, by singers, by a musical vocal group or by vocalists; live entertainment; live entertainment production services; live entertainment services; management of entertainment services; musical entertainment services; musical group entertainment services; booking of entertainment; entertainment; entertainment by means of concerts; booking agency services; organisation of competitions and award ceremonies; arranging and conducting of conferences, conventions and exhibitions; provision of radio and television entertainment services; information relating to entertainment, music, live performances and events, recordings; information and advisory services relating to all the aforesaid services.

2) The application was examined and accepted, and subsequently published for opposition purposes on 16 August 2013 in Trade Marks Journal No. 2013/033.

3) On 8 November 2013 Paul and Stacey Boxwell (hereinafter the opponents) filed a notice of opposition. The grounds of the opposition are in summary:

a) The opponents contend that the applicant was “an employee or at the very least a partner in business with the opponents”. The opponents state that they run an entertainment agency from their base in the Cayman Islands and that from 2008-2013 the two parties were in a business relationship, part of which led to the opponents seeking a work permit for the applicant enabling her to stay on in the Islands. The relationship ended in July 2013 and shortly after the applicant sought the registration of the mark in suit. The address provided is said to be incorrect as the applicant’s work permit had been revoked and she no longer resided in the Islands. They contend that they paid the applicant’s health insurance and pension contributions as well as paying for her work permit and as such the applicant had a business relationship with them and that by filing the application in suit she is acting in bad faith and so the application offends against section 3(6) of the Act.

4) On 30 November 2013 the applicant filed a counterstatement denying the ground of opposition. The applicant also contended that she was never a partner in a business with the opponents, did not work for them, and pointed out that the opponents have not made any claim to have ever used the mark in suit at any time in any jurisdiction. She states that she applied, and paid for, her own work permit. The permit request required a signature of a Cayman Island resident who holds an entertainment licence which is why the opponents were asked to sign the document. She contends that she ran the Class Act Entertainment Agency on her own and simply handed over the running of the Agency to the opponents in August 2013. She created the mark in suit and recordings under the mark in suit were released by the applicant in the UK prior to any association with the opponents. At the time of applying for the mark in suit she was residing in the Cayman Islands and her work permit was not revoked but cancelled at her request. The mark in suit has been used by the applicant as her artistic name.

5) Both sides filed evidence and both parties seek an award of costs in their favour. The matter came to be heard on 13 October 2014 when the applicant represented herself; the opponents were represented by Ms Edwards-Stuart of Counsel instructed by Messrs Boulton Wade Tennant.

OPPONENTS’ EVIDENCE

6) The opponents filed nine witness statements. The first witness statement, dated 5 March 2014, is by Paul Boxwell, a partner in Class Act Entertainment & Tuition Agency (CAE) which he has owned since its inception in April 2008. He states that he has been a musician for many years and has performed with his own band from the early 1990s. He states that he met the applicant in 2007 when she was performing as a vocalist in a small wine bar under the name “Pam Burgess and Friends”. He joined the band and played under the same title, although the musicians changed on an almost nightly basis. He states that the applicant had worked in the Cayman Isles for a number of years for a variety of companies in a variety of jobs. As a British national she required a work

permit, but this was terminated by her then employer, Love Culture Agency, in March 2008. As he had not set up his agency at the time he asked a friend, Ms Wheaton, to obtain a temporary work permit for the applicant, until his agency was in being, when he and his wife would employ the applicant. Ms Wheaton ran an entertainment company called Millennium Tate Management Ltd. Mr Boxwell states that his agency was granted a trade and business licence on 29 April 2008, and shortly thereafter a temporary work permit was obtained by the agency to allow Ms Burgess to stay on the island as an employee of the Agency.

7) Mr Boxwell states that Ms Burgess was an employee of the agency and was responsible for marketing the band and scouting for new business. Both Mr Boxwell and his wife had employment elsewhere, and so they hired Ms Burgess. He provides a number of exhibits to support this claim. He states that after her employment in 2008 the name SUITE ELITE for the show band was decided upon. An alternative spelling had been suggested by Ms Burgess (Sweet Elite) but he had the last word as he was the owner of CAE. He states that prior to this no-one had used the mark and he provides a newspaper article regarding the formation of the new band. He states that whilst the line up of the band changed over the years with more expatriates playing, all of whom required work permits and all of whom were employees of CAE. He states that Ms Burgess was treated no differently to any of the other band members save that she was also the manager. They all received a pension from the agency.

8) Mr Boxwell states that on 6 May 2013 the applicant stated that she did not want CAE to use the name SUITE ELITE in future. Mr Boxwell sent an email pointing out that he was involved in the creation of the name and pointing out that if she left the band she could not expect the band to change its name. He states that he did not have an issue if she used the mark, as she informed him, on an entertainment agency in the UK but if he had been aware of her intention to register the trade mark then he would have objected as a registration in the UK blocks his ability to register the name in the Cayman Isles. Mr Boxwell also states that the applicant sought to damage the band by writing to the host of the band's website claiming that she owned the site. Mr Boxwell points out that as the Manager of CAE she had control of the site and has retained it despite leaving the agency's employ. She posted on the website that the band would not be working for a period of twelve months. The band has therefore had to set up a new website. A number of previous and potential clients have received emails alleging infringement and passing off regarding use of the mark in suit. He also contends that many of the records of the agency were taken by the applicant when she left. He also provides the following exhibits:

- PB2: A copy of the work-permit application, dated 16 September 2008, submitted by Ms Burgess which states that she had a work permit with Love Culture Entertainment and a temporary work permit with CAE.
- PB3: A witness statement by Victoria Wheaton confirming that she is the owner of Millennium Tate Management Ltd and that she obtained a temporary work permit for Pamela Burgess until a work permit could be obtained by CAE. In the

exhibit attached she states that she assisted with a temporary work permit for Ms Burgess after being asked by her friends Mr & Mrs Boxwell to help out until they had set up their agency as they intended to employ her as a vocalist and manager for their newly formed band Suite Elite. She states that they subcontracted Ms Burgess to the Suite Elite Band.

- PB4: A copy of the Trade and Business Licence issued to Stacey and Paul Boxwell t/a Class Act Entertainment and Tuition Agency allowing them to trade in the business of Entertainment Services.
- PB5: A copy of a letter, dated 11 June 2008, from CAE to the Chief Immigration Officer in the Cayman Isles, enclosing a temporary work permit application for Ms Burgess. The letter explains that Mr Boxwell and Ms Burgess both worked for Love Culture Agency but when the agency terminated Ms Burgess' contract he decided to also leave. He explains the setting up of his own agency and the employment of Ms Burgess by his friend Ms Wheaton. In the letter he explains that the success of the band Suite Elite meant that they had commitments with various establishments on the island that the band needed to fulfil. He states that his company will employ Ms Burgess as a vocalist and promotions agent.
- PB6: Copies of work permit renewal forms dated 16 September 2008, 27 August 2010, 28 September 2011 and 7 May 2013 in respect of Ms Burgess. Her employer is stated to be CAE and it indicates that in addition to a monthly stipend pension and insurance contributions were also paid by the employer as of September 2011.
- PB7: Copies of receipts in relation to applications for work permits on behalf of Ms Burgess paid for by CAE. These are dated from 2008-2013.
- PB8: A copy of a letter from the Work Permit Board, Grand Cayman dated 6 November 2008 confirming that CAE employed Ms Burgess.
- PB9: A copy of a "to whom it may concern" letter dated 19 September 2013 from Cayman Insurance Centre Ltd confirming that Ms Burgess was an employee of CAE and that she had medical coverage until 1 August 2013 when her employment with CAE was terminated.
- PB10: Documents from Fidelity Pension Services (Cayman) Ltd confirming pension contribution payments made by CAE in respect of Ms Burgess during the period February 2009- June 2013.
- PB11: A witness statement, dated 18 October 2013, by Andrew James Bolton an Attorney-at-law of the Grand Court of the Cayman Islands. He states that he is an expert on the law in the Cayman Isles. He states that the documents filed with this case are inconsistent with Ms Burgess being self employed or having an arms length relationship with CAE or Mr Boxwell, he feels she was an employee.

He also provides legal arguments as to why if Ms Burgess were to be regarded as a partner then the legal property would belong to the partnership and not the individual.

- PB12: A copy of a letter from Butterfield Bank on Grand Cayman stating that Ms Burgess was an authorised signatory on the CAE account during the period June 2008 – June 2013. Also included are copies of CAE accounts held by Butterfield which shows regular payments to Ms Burgess.
- PB13: A copy of a letter, dated 2 April 2013, from CAE to the Work Permit Board of the Cayman Isles seeking “Key employee” status for Ms Burgess. The letter describes that she is the vocalist for the Suite Elite Band and also that she “offers our agency her promotional skills, event planning, customer relations and over-all knowledge from her 25 years international experience”. Also attached is a copy of an email, dated 6 April 2013, from Ms Burgess to Mr Boxwell on which she describes herself as “Manager / Vocalist: The Suite Elite Show Band”.
- PB14: A copy of a newspaper article, dated 29 May 2008, from the Caymanian Compass announcing the formation of a new band Suite Elite. The article also describes Ms Burgess as the band’s manager.
- PB15: Copies of payments for work permits for other band members showing CAE as their employer.
- PB16: Witness statements by Lingga Rinaldy; Marlon Delano Salmon; Robert Charles Ebanks and Kevin O’Brian Blake. All of which are dated 4 March 2014. All state that they were employed by CAE and that it was their understanding that Ms Burgess was also an employee of CAE during their time with the band, and that she also managed the agency.
- PB17: This is a list of performances given by the band during the period November 2010 – June 2013. The list is incomplete as Ms Burgess did not hand over all the various papers when she left the agency. However, it does show a substantial number of events. Also provided are pages from the Suite Elite Facebook page and pages from the website which show images of the band.
- PB20: This consists of copies from the Cayman Isles Govt website dealing with the issue of work permits in the Cayman Isles. The guidance makes it clear that an employer must inform the Cayman authorities immediately that an employee leaves the company.
- PB21: A copy of an email, dated 14 August 2013, from Mr Boxwell to the applicant informing her that he had no option other than to inform the authorities to cancel her work permit.

- PB22: A copy of an email from the applicant to Mr Boxwell and other members of the band. In the email she makes a number of claims. She states that she paid for her own work permits “..whilst under employment with Class Act Entertainment” (and seeks a refund from CAE), she also claims to have paid for the business license for CAE in relation to 2013 as well as the work permits for other members of the band. She states that she is the registered owner of trade marks for Suite Elite throughout the Caribbean, USA, UK and Europe. Also warning them that they have no right to use this name for the band. She finishes “it has been a joy to create and market Suite Elite and to employ you all as my musicians”. Under the name Pamela Burgess is the title “Owner Operator – The Suite Elite Group of Companies”.
- PB24: A witness statement, dated 5 March 2014, by Sara Jane Leno the opponent’s Trade Mark Attorney. She states that she carried out trade mark and company searches but could find no registered companies with the name Suite Elite and only the UK trade mark application.
- PB25: Details of a record “Backbone” by “Suite Elite featuring Pam Burgess” released on 12 October 2009.
- PB27: Copies of emails regarding the allegation by the applicant of infringement and passing off by using the mark in suit on a website. This caused the website owner to threaten to cease serving CAE.
- PB28: A copy of a page from the website of Suite Elite stating that the band will not be available between September 2013 and September 2014.
- PB30: A copy of an email from the applicant to the organiser of an event in the Cayman Isles stating that the name Suite Elite was her artist name and that she had not given permission for anyone else to use it.

9) The second witness statement, dated 5 March 2014, is by Stacey Boxwell. She states that she has read Mr Boxwell’s witness statement and exhibits and agrees with everything within and believes it to be true.

10) The third witness statement, dated 4 March 2014, is by Victoria Wheaton. She confirms that she applied for a temporary work permit for the applicant at the behest of the opponent and when the permit was granted she sub-contracted Ms Burgess to the Suite Elite Band until CAE was formed and could obtain the applicant a full work permit.

11) The fourth, fifth, sixth and seventh witness statements are by Lingga Rinaldy, Marlon Delano Salmon, Robert Charles Ebanks and Kevin O’Brian Blake. These have already been summarised under exhibit PB16 above.

12) The eighth witness statement, dated 5 March 2014, is by Sara Jane Leno. This has already been summarised at exhibit PB24 above.

13) The ninth witness statement, dated 18 October 2013, is by Andrew James Bolton. It has already been summarised at exhibit PB11 above.

APPLICANT'S EVIDENCE

14) The applicant herself filed a witness statement dated 4 May 2014. She claims to have first used the mark in suit in the UK in 2009 on a range of goods and services very similar to those for which the mark is sought to be registered. She states that this use has been enhanced by use in the Cayman Islands since 2008. She claims that Suite Elite is one of the main artist names that she uses, in addition to Pamela Burgess and Pam Ella. She states that she chose to register the mark as a result of her use since October 2009 and had nothing to do with events in the Cayman Islands. She claims that the evidence of Mr Boxwell is contradictory in that when applying for a work permit for her he states that the band Suite Elite already exists yet the basis of the claim is that the name was invented after she was employed by CAE. She states that the receipts from the Cayman authorities are all marked duplicate and are not originals and she contends that she paid for the work permits and that the opponents did not invest any money in her business operation in the Cayman Islands. She states that none of the Cayman based musicians performed upon her albums. She claims that the opponents have lied in referring to the partnership CAE as a company. Because of this distinction she contends that all of the witness statements filed by the independent witnesses are "not true statements". She contends that as CAE is not a legal entity all the statements which refer to it as a company whether it be setting it up or running it etc are false statements. She also contends that CAE cannot therefore be an employer or own any intellectual property rights. She continues:

"33. The opponents therefore cannot truthfully state that I was an "employee" of "the Agency" as "the Agency" they refer to in the third person did not exist in any factual or legal sense. The name "Class Act Entertainment & Tuition Agency" is merely a name on a Trade and Business Board license document, and further, the name "Class Act Entertainment" was used by me for banking purposes on two joint business bank accounts."

15) The applicant claims that Mr Boxwell was hired by her as a backing musician. She states:

"39. From November 2006 until August 2013 I worked in the Cayman Islands as a music performer, band manager and booking agent. My music business activity was validated and facilitated by way of obtaining a series of work permits, with consecutive Trade and Business Board licence holders whose trading names are listed below:

November 2006 to May 2007: Music Mogul Entertainment

May 2007 to March 2008: Love Culture Entertainment

April 2008 to June 2008: Millennium Talent Management

June 2008 to August 2013: Class Act Entertainment

40. The business I operated in the Cayman Islands was created and conducted entirely as my own, and using my own capacity for the whole duration of such activity in that territory. Before my obtaining a work permit in the name Class Act Entertainment, and before any association with the opponents, I had already established considerable public profile and reputation in the Cayman Islands as a live music performer and live music booking agent. During my work permit period with Love Culture Entertainment I recruited and rehearsed a full band of musicians and had also personally purchase a PA system, stage lights and transportation.”

16) The applicant states that she recruited all the members of her band. She claims that the public in the Caymans often called her Suite Elite. She states that she had been performing as Suite Elite in February / March 2008. The Drummer in the band, Stuart Wilson, traded as Love Culture Entertainment, and so when he left the band her work permit ended. She approached a number of people who held business licences and eventually obtained a permit via Ms Wheaton trading as Millennium Talent Management. She states that her arrangement with the opponents was simply that in return for them signing the documents in order for her to get a work permit she would employ Mr Boxwell as a musician. The opponents had to be joint signatories of the bank accounts to meet Cayman Island rules. However, the applicant maintains that she paid all the fees from her own money and ran the company with no input from the opponents, who had day jobs. She continues:

“60. On 30 June 2008, my work permit was granted by The Cayman Islands Immigration Department. I paid the full fees from my own personal funds for the application for this work permit, as was required by the opponents. This was the first work permit that I had held in the name “Class Act Entertainment Agency”, having previously held several different work permits with separate Caymanian “employers”. Mr & Mrs Boxwell had signed the required parts of the Immigration documents that requested the name of the “employer”, however as stated herein, the opponents were in no true sense my employer, merely acting as required signatories. It is common practice in The Cayman Islands for work permits to be obtained by so-called Cayman resident “employers” for overseas visitors, when no actual employment conditions are being met.”

17) The applicant points out that as a manager the work permit fee would have been considerably higher than those shown in the opponents’ exhibits. She also points out that the salary figures on the work permit applications vary considerably and that no payslips etc have been provided to show that she was paid a wage. She states that Ms Wheaton did not sub-contract her to the opponents and that this has been invented. She points out that no evidence relating to this subcontracting has been provided. She contends that she paid for her own work permit application with Ms Wheaton which was again in breach of the laws of the Caymans. She points out that no employment contract has been filed by the opponents. The applicant states that in November 2012 Mrs Boxwell acting on behalf of her employer contacted the applicant to hire the

services of Suite Elite. The applicant contends that this shows that the mark in suit and agency was owned by the applicant and not the opponent. The applicant provides details of a meeting with the opponents at which she states the opponents asked her a number of questions which proved that they had no idea of how to run an entertainment agency and at this same meeting she contends that the opponents admitted that they did not own the mark in suit. She states that she agreed to sell the equipment she had bought such as speakers, a microphone, mixers etc to the opponent when she was leaving the Cayman Isles. At exhibit PEB 20 she provides an invoice for the items. However, Mr Boxwell did not manage to get a bank loan and so the sale did not occur. She puts her claims to own trade mark registrations and a group of companies as an “entirely innocent error” and also her intention to register a limited company. She also provides the following exhibits:

- PEB1: a page from itunes showing an album with a release date of 12 October 2009
- PEB2-4: pages from itunes which show more albums being released on 21 September 2013, 31 January 2014 and 17 April 2014 respectively.
- PEB5: A list of territories world wide where the itunes store has offered her albums for sale since October 2009.
- PEB6 & 7: BBC radio playlists dated February 2014 and April 2014.
- PEB11: An article from Cayman Airways Skies Magazine which is undated. This states that the band was set up by Ms Burgess.
- GR1: A witness statement by Mr Graeme Robinson a director of Circulation Recordings Ltd. He states that his company released commercial sound recordings in the UK by the artist Suite Elite on 12 October 2009. There have also been subsequent releases. He states:

“8. My label has made the above commercial releases billing the artist as Suite Elite featuring Pam Burgess, Pam Ella and the Suite Elite Dub Section featuring Sly and Robbie, and Pam Ella and the Suite Elite Orchestra.”

OPPONENTS’ EVIDENCE IN REPLY

18) The opponents filed three witness statements in reply. The first, dated 1 July 2014, is by Mr Boxwell who has provided evidence earlier in this case. He points out that Suite Elite Ltd was not incorporated until 7 March 2014 and that its registered address is a residential street in Darlington identical to the registered office of Circulation Recordings Ltd. He states that he was not aware of any recordings being released under the mark in suit in 2009 by the applicant. He points out that there is no evidence of any sales of the recordings. He states that the claims regarding BBC playlists relate to 2014 and also to local radio. He states that the applicant applied for the trade mark prior to leaving the

Cayman Isles and that he believed that she was only going to use the mark in relation to an entertainment agency. He refutes most of the applicant's evidence. He states that a partnership does not need to be registered but a business does have to have a licence. He points out that the applicant is unable to work in the Caymans without a work permit and she is not legally entitled to apply for such a licence herself, it has to be applied for by an employer who is legally entitled to apply for such a permit. He states that the bank account, in the name CAE, belongs to him and his wife, and he files documents at exhibits PB40 & 41 to confirm this. He points out that under the law in the Caymans the applicant could not employ others as she had no licence. He also provides the following exhibits:

- PB40: A copy of a form, dated 13 June 2008, in relation to setting up accounts at Butterfield Bank in the name of CAE. The applicants are Mr & Mrs Boxwell.
- PB41: A copy of a form, dated 13 June 2008, for the accounts at Butterfield Bank signed by Mr & Mrs Boxwell allowing Pamela Burgess to draw cheques up to CI\$5,000 and to pay monies into the account.
- PB48: A copy of a cheque, dated 30 June 2008, signed by Mr & Mrs Boxwell relating to the work permit for the applicant.

19) The second witness statement, dated 30 May 2014, is by Stacy Boxwell who has provided a witness statement earlier in this case. She merely states that she agrees with the evidence of her husband.

20) The third witness statement, dated 3 July 2014, is by Emma Jane Pitcher the opponents' Trade Mark Attorney. She provides her opinion on matters within the case which do not assistance my decision.

APPLICANT'S FURTHER EVIDENCE

21) Ms Burgess filed her second witness statement in these proceedings, dated 2 October 2014. She repeats her earlier claims to have issued commercial sound recordings under the name Suite Elite in 2009. She provides a number of exhibits which relate to recent events which are of no assistance to me in my decision. She provides the following exhibits:

- GR2: This consists of a witness statement, dated 25 September 2014, by Mr Robinson who has already provided evidence in the instant case. He claims that exhibit GR7 shows "photo scans of original studio track sheets dated 1996 and 1997, with titles of music recordings subsequently released on iTunes stores worldwide by the artist Suite Elite featuring Pam Burgess in 2009". He states that "the handwriting is that of former co-writer and musician, Mr Martin Alderdice, whom I last worked with in 2007". However, the only artist's name which appears on these sheets is "Tandra". There is no mention of Suite Elite on any of the sheets. He also states that he was advised by an independent record

label owner that the applicant should distance herself from the work she carried out in the Caymans in relation to weddings, corporate events etc as this would give a negative impression. He provides his opinions and also gives details of recent marketing and recording events carried out by the applicant, none of which assist me in my decision.

- GB1: A witness statement, dated 20 September 2014, provided by Gavin Bell a professional musician for over 25 years in the UK. He provides his opinions and comments on recent matters significantly after the relevant date, neither assists my decision.
- DNA1: A witness statement, dated 17 September 2014, by Dominic Nelson-Ashley who states that he runs a record label and is also an independent recording artist. He provides his opinions and comments on recent matters significantly after the relevant date, neither assists my decision.
- PEB25: Copies of four vendor agreements with the Ritz Carlton in the Cayman Isles. These show the name of the vendor as Suite Elite and the contact as Ms Burgess.
- PEB26: Examples of audience feedback between 2009 and 2013 most of which say how good the band were, some comment upon Ms Burgess' singing.
- PEB28: Copies of various articles, dated 2011 to 2013, about the band many of which feature photographs of the band, some have only a photograph of Ms Burgess. She states that she feels that these show "I am clearly portrayed as the representative of the goods and services of the name Suite Elite prior to the relevant date.
- PEB40: This consists of a printed sheet on un-headed paper which purports to show how much each musician was paid for a series of performances in 2013, including Mr Boxwell. No payments are listed for Ms Burgess.
- PEB33: This is a transcript of a covert recording of a meeting with Mr and Mrs Boxwell on 7 July 2013. It was apparently taped by Lily Yong without the knowledge of Ms Burgess. The recording is clearly not of the whole meeting as it starts in the middle of a conversation. Given the quality of phrasing and English used, and the fact that it took place in Mr Boxwell's home, it is not clear whether the attendees are somewhat intoxicated or whether the recording and/or transcript are faulty. For the most part they do not speak in complete sentences or even coherently. For instance Mr Boxwell apparently said:

58. "They're-there's-they're not coming on seeing right, Pam and seeing her videos yarna-yardna-yah, and then not getting that."

129. "Bearing in mind that, you know, come..this..I mean how long before you actually get on and do something like that?"

To my mind it appears that at the start of the meeting Mr Boxwell believes that Ms Burgess is only leaving for six months. Once he realises that she is not coming back he considers the issue of rebranding the band. The applicant contends that she got the impression that he was happy to rebrand and that he did not object to her using the name SUITE ELITE on her own, for recording purposes. However, to my mind the conversation does not seem quite so clear cut. I have quoted extensively from the transcript so that the lack of coherent views is demonstrated as is the "thinking out loud" particularly by Mr Boxwell.

58. **Paul Boxwell:** They're-there's-they're not coming on seeing right, Pam and seeing her videos *yarna-yardna-yah*, and then, not getting that.
59. **Pamela Burgess:** Yeah, yeah.. Cos that, that kinda concerned me because The Ritz.. and like I, I didn't wanna ruin anything with them either, I thought, they gonna be fussy about that. She brought it up to me, I didn't even bring it up to her.
60. **Stacy Boxwell:** You haven't sent them anything yet?
61. **Pamela Burgess:** No I was just holding back to send like a communal email to everybody to say, look this is.. I was waiting to sorta hear.. how you forward you were on with this girl, cos then what I can do in that email is add the information that: here is.. the new.. even if you guys got a picture, it would be, like, as soon as possible I could attach that and say look, I've left the band, here's the new band, here's a picture, if you can get some recording of her, video.. something.
62. **Paul Boxwell:** The only thing what I was to.. what, how I, kinda told her from the beginning is what I would do is I would sell them.. sell it.. for this four month period as: Suite Elite with Shameka Clarke, No: Suite Elite. Not as Suite Elite.
63. **Pamela Burgess:** Featuring Shameka Clarke, right.
64. **Paul Boxwell:** The idea being..
65. **Stacy Boxwell:** Yeah... she's already in the picture, she's just.. separate.
66. **Paul Boxwell:** The idea being when you came back, it would just be Suite Elite again, or Suite Elite with Pam Burgess ...
67. **Pamela Burgess:** Right.
68. **Paul Boxwell:** ... but if you're not coming back, then, and that's why I say, if I lose Kevin if I lose Lingga, and bring in a new singer, it

- is a new band.
69. **Pamela Burgess:** Yeah.
70. **Paul Boxwell:** Right? We start again with a new name ...
71. **Pamela Burgess:** Yeah.
72. **Lily Yong:** Umm!
73. **Paul Boxwell:** ... and, by that time we'd have 'ad a chance to build up.. me having physical, Stacy having physical contact with these people, that it is then easier to do so ...
74. **Pamela Burgess:** Right.
75. **Paul Boxwell:** ... rather than just shut off and say that's it.
76. **Pamela Burgess:** Right. I think they're gonna like that too, if it's like a rebrand thing and you know, the island's so small and it won't take long for that to.. develop either, you know. Emm.
77. **Paul Boxwell:** So that's really what I was thinking.
- (Point in recording: 5 Mins)
78. **Lily Yong:** How is that gonna work if you.. you know we're setting up Suite Elite in the UK ...
79. **Stacy Boxwell:** (shouting to children) Leela!.. Dylan, what's happening?
80. **Lily Yong:** ... and we want worldwide coverage, how is that gonna contradict with Suite Elite being run locally?
81. **Pamela Burgess:** Well that's what I'm gonna see, I mean, I think it kind of is up in the air, it remains to be seen just how things.. like you're gonna know in six months time whether you're gonna..
82. **Paul Boxwell:** If we name the new website..
83. **Lily Yong:** Yeah.
84. **Stacy Boxwell:** It's OK.
85. **Paul Boxwell:** Suite Elite Cayman..
86. **Lily Yong:** Yeah.
87. **Paul Boxwell:** And even if there is an overlap ...
88. **Lily Yong:** Yeah.

89. **Paul Boxwell:** ... people will know as they did it, that it's.. not the right one.
90. **Lily Yong:** Um.
91. **Paul Boxwell:** Right? Especially they know you when they come up and they see that you're not there..
92. **Lily Yong:** Um.
93. **Paul Boxwell:** ... they would know.
95. **Pamela Burgess:** Yeah.
96. **Paul Boxwell:** But the chances are, by the beginning of next year it will.. have rebranded and changed anyway.
97. **Lily Yong:** Um. So if you call it Suite Elite Cayman, when people do the search it will not interfere with the UK business?
98. **Pamela Burgess:** Well what I'm gonna do is hold off for six months..

And:

139. **Paul Boxwell:** Put Suite Elite Cayman. So that they know.

(Time in recording: 10 minutes)

140. **Pamela Burgess:** Or just like Suite Elite's line up has changed. And that's what I'm sayin' if you.. could get a picture of.. the new line up.. with this girl. Even that is just letting them see.. at least you're, you're get.. you're informin' them that there's a change. And if they still wanna still go ahead on the strength of 'well, we got them last year, OK it's just a new girl.. yeah we'll give..', you know. I think rather than just blanking it completely it, it's a bit dauntin' for somebody that.. I would like to just put.. maybe ...
179. **Stacy Boxwell:** Wait, what's the business, Suite Elite or Class Act? Cos Suite Elite isn't really a business.
180. **Lily Yong:** It's Suite Elite. Class Act is a legal structure, the business is Suite Elite.
181. **Stacy Boxwell:** But Suite Elite isn't registered as a business.
182. **Lily Yong:** The.. the.. the.. You got to look at it differently, umm.. What generate values to the business is Suite Elite, what generates value for Suite Elite, is the website.

(Time in recording: 15 minutes)

183. **Stacy Boxwell:** Well OK, listen. This is what it is.. umm, Lily. Where we went wrong. Right? In the whole start of this thing we never really write down anything. We never.. The only thing on paper is Class Act ...
190. **Stacy Boxwell:** ... Right? Wha'.. What we have to understand Lily.. We have right now.. We went into this.. We have nothing written on paper to say.. It's a trust thing, that we went in. The only legal document that we're having right now is these people's work permits and Class Act Entertainment. Suite Elite is a seg.. is a name of a segment that came.. with it. You understand what I'm saying? It's not legally anywhere.
191. **Pamela Burgess:** Yeah, it was. It was a product,. It, it was like my product, my brand. Yeah.
192. **Stacy Boxwell:** ... Class Act was a (inaudible). Yeah! So it's for us to come to some agreement. An a sensible.. agreement
...
193. **Pamela Burgess:** And the.. the song choice, the whole like, persona of Suite Elite was built around me.
194. **Stacy Boxwell:** Yeah.. But yeah.. I mean.. We understand that you put so much into it, and stuff, Pam, but the thing is, what we're saying is, just like.. It was a big woosh! Like.. You know ...
195. **Lily Yong:** Ummm.
196. **Stacy Boxwell:** ... because them guys out there is all I'm concerned. The five.. other.. the other band members. It's Paul and I really, right now it's down to. They don't know.. all these things that's going on.
300. **Paul Boxwell:** We've already.. We've already been sold as Suite Elite for these bookings that we've already got. Right?
301. **Lily Yong:** Yeah, I understand.
302. **Paul Boxwell:** And therefore.. And we are still Suite Elite.. We are.. five out of six members of Suite Elite. OK? So that's why I'm saying let's.. run it for now.. I.. as I said I.. I gotta go over it again,
317. **Paul Boxwell:** We could even run as: Suite Elite Blah-blah-blah, and

then later on we drop Suite Elite and just carry on as Blah-blah-blarr. You know there, there's more ways of killing a cat than.. jumping on its head.

318. **Stacy Boxwell:** Yeah but that's what I'm wanting to find out what Lily is thinking about, if after pass of six months ...
319. **Paul Boxwell:** But basically that's, that's how it could be done, so it's subtle and there's not a shock. If we shut off as Suite Elite.. nobody's gonna know who we are. We become Blah-blah-blah today.. Nobody knows us. Right? So those ...
320. **Pamela Burgess:** Yeah but as long as the venues know who they're dealing with, you're on a winning streak.
321. **Lily Yong:** Yeah.
322. **Pamela Burgess:** That's what I'm saying, your reputation.. what's important here is that..
323. **Paul Boxwell:** But they don't know yet.. That's what I'm saying, the transit ...
324. **Pamela Burgess:** And they can, through, through...
325. **Paul Boxwell:** That.. That transition period? Is important.
326. **Pamela Burgess:** Yes, and I want to help one hundred percent with that.. you know ...
327. **Paul Boxwell:** And that, and to me that's important, that transition period.
328. **Pamela Burgess:** And yeah, and I have a switch to do that. I can make that happen through.. the forwardness of information, through bookings.. enquiries that come to me, relaying to them that.. there's no quality loss here, all the rest of it. I can do that.
329. **Stacy Boxwell:** And after the six months.. after the six months?
330. **Pamela Burgess:** And Stacy, I don't appreciate you saying that I babble on, I don't ...
331. **Stacy Boxwell:** Yeah, after the six months.. Lily? And after the six months?
332. **Pamela Burgess:** ... I don't, no. I don't appreciate that. W' what's the.. issue, why is there issues coming up here? Like you got ...
333. **Stacy Boxwell:** Don't, don't go there!

334. **Pamela Burgess:** Are you threatening me?
335. **Stacy Boxwell:** Let's stick to.. Because a lot of times I've gone over and I'm trying to contain and pull back and be professional.
...
336. **Pamela Burgess:** You talk all over me every time, its rude.
337. **Stacy Boxwell:** ... What do you mean by the six months? When the six months is up.. What do you mean by its rep.. a name.. damaging her?
338. **Lily Yong:** It's gonna block.. the future revenue potential for this UK Suite Elite that we.. we're setting up.
339. **Stacy Boxwell:** Even though most of the gig is on this ...
340. **Lily Yong:** Because we're using the same domain, um, by diverting traffic the future.. the business gonna lose.. The new business gonna suffer.. loss of.. loss of potential.. traffic here. If you're happy to do it, for six months, Pam ..
341. **Pamela Burgess:** See most of, most of the traffic is coming though from the US to here ...
342. **Lily Yong:** Yeah.
343. **Pamela Burgess:** ... which is traffic I wouldn't be dealing with in the UK..
344. **Lily Yong:** OK.
345. **Pamela Burgess:** ... Umm, there will be a period I see of a couple of months where.. yes I'm gonna have to.. revamp my own website. ...
346. **Lily Yong:** Um.
347. **Pamela Burgess:** New pictures, new.. Just do exactly what I did with YouTube videos whatever it may be. ...
(Time in recording: 25 minutes)
348. **Pamela Burgess:** ... Ah.. It's not going to be me, but I want to use my skills to go out and form my Suite Elite with my female singer, tutor her, all of... that's.. was my plan.
349. **Lily Yong:** Um.
350. **Pamela Burgess:** So, its gonna take a couple of months for that to happen...
351. **Paul Boxwell:** It's.. yeah.. It'll take a transition period.

362. **Pamela Burgess:** But no. it won't.. In the UK I will have no connection between Pam Ella and Suite Elite. I'm gonna be.. I.. I have an agency in the UK. And I.. under that agency I'm gonna have different acts. But it's not gonna be me. I'm gonna.. like my own solo career but.. they wouldn't.. they wouldn't see the thing is Suite Elite dot com is gonna be.. whatever band I put.. under that. On the website. So I don't know whether ...
363. **Paul Boxwell:** The Suite Elite.. UK, is really like a.. an agency?
364. **Pamela Burgess:** I can't change the domain name to Suite Elite UK.. I mean it's.. it's, it's always gonna be Suite Elite dot com.
365. **Paul Boxwell:** But that's gonna be an agency rather than a band, is that what you're saying?
366. **Pamela Burgess:** Yeah.. yeah. The name of the agency ...
367. **Paul Boxwell:** Right?
368. **Pamela Burgess:** ... can be that.. like, as a brand.
378. **Pamela Burgess:** If, if you were to call yourself Elite Crew, or like some name: Elite Beat or something like that ...
379. **Paul Boxwell:** But it doesn't apply to use that.. It could be.. that's what I'm saying is.. as you move on, we could become Suite Elite... Blah-blah-blah. Right? And then...
380. **Pamela Burgess:** Um.
381. **Paul Boxwell:** ... you eventually drop Suite Elite and keep Blah-blah-blah. Suite Elite's gone.
382. **Pamela Burgess:** Right.
383. **Paul Boxwell:** So now we're Blah-blah-blah.
384. **Pamela Burgess:** You've, you've built up the name of.. Yeah. I know what you're saying.
385. **Lily Yong:** So.. So your website's gonna be the footbridge here, right. To bridge traffic onto the new.. onto their website.
436. **Pamela Burgess:** I was sayin' make.. the, the best thing.. the way to do that is I've.. All the insurance will be paid up, everybody's pension, everything..
437. **Lily Yong:** Um.

438. **Pamela Burgess:** ... up until the end of this month. So as from like the first of August.. You know as far as.. banking.. an', an' all the rest.. everything.. That's I'm like, ending. That's was kinda the date that I had in my head. Um.. Then I, eh, uh, haven't figured what exact day I'm leavin', yet. I have to.. got a lot of stuff to do.
439. **Stacy Boxwell:** Well.. Even though this.. there's an.. th'.. this other thing..find out from Immigration about that work permit..The thing is, once you open up that avenue, a letter.. a notification letter.. will go in. And, you know
...
440. **Pam Burgess:** Ummm.
441. **Stacy Boxwell:** ... None of us have control how long.. they will give you.
442. **Lily Yong:** Uuuuh. Um.
443. **Stacy Boxwell:** Y'unders.. you get what I'm saying? What.. no.. nobody.. none of us have control. We can't say: Oh well we want.. three weeks or whatever.
444. **Lily Yong:** Um.
445. **Pamela Burgess:** What you mean for my ...
446. **Stacy Boxwell:** From Pam notific.. yeah. They will..
447. **Pamela Burgess:** ... officially.. finish workin' for you.
448. **Paul Boxwell:** So, this permit for.. Doing... no, it's gone. I'm just thinking do we need Pam to give us a termination letter.
449. **Stacy Boxwell:** That's probably better.. I don't know. Yeah. So you have somethin' in writing.
450. **Pamela Burgess:** Ummm.
451. **Paul Boxwell:** Just like an official.. style.
452. **Stacy Boxwell:** Just.. and if they're gonna ask for something like that to go to them.
453. **Paul Boxwell:** They need to know it that's the thing.
454. **Pamela Burgess:** Well if that's the case, I'll make a.. to give myself more time, cos I don't know.. what's.. something gonna happen that I have to stay longer, might be selling my van.. eh.. the, cat, dog or whatever. Need to the end of August officially terminate my employment at the end of August.

(long pause)

455. **Stacy Boxwell:** What..?

456. **Paul Boxwell:** Or wait on us sending that in, cos I haven't even.. put feelers out for a permanent.. singer. I know.. I just.. I mean I did talk to Shanika and I'm pretty sure her situation isn't going to change. And I would hate to get in that situation she says 'Oh yeah, I'll do it' because she wants to try and help out, and then.. you know January, February the gigs start rolling and s he's like ' Well, you know, this is too much'. And.. (inaudible).

457. **Pamela Burgess:** There's maybe a chance that she will, like, like , is she.. is she earning? Does she have any other part time work?

458. **Paul Boxwell:** Yes. Well, she has a full time job. She has a full time job and she's ...

459. **Pamela Burgess:** Oh she has, as well? Alright. I thought she was just doing the singing.

460. **Paul Boxwell:** ... gonna be studying.

461. **Pamela Burgess:** Alright. That is a lot.

22) The transcript appears to end with Ms Burgess and Ms Yong leaving the Boxwell's house. It is said that the recording continues with Ms Yong and Ms Burgess discussing the meeting. I find it rather odd that Ms Yong would continue to record a private discussion and not reveal to Ms Burgess what she was doing. However it is claimed that despite the meeting taking place on 7 July 2013 Ms Yong did not inform Ms Burgess of the recording until 25 September 2013. Quite why it took her so long to do so is open to interpretation. As is the question as to why it took Ms Burgess so long to decide to file the transcript as part of her evidence. It was clearly available a year before she decided that she wanted to rely upon it.

23) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

24) At the hearing the preliminary issues indicated in the opponents' skeleton were waived. Ms Edwards-Stuart accepted the admission of the applicant's additional evidence including the transcript at exhibit PEB33. The opponents also dropped their request to cross examine Ms Burgess. The opponents also requested to add, as a fall-back position, a ground of bad faith on behalf of Mr Boxwell as a member of the band which performed as Suite Elite. I allowed the amendment to the pleadings even though

it was very late in the proceedings as it did not affect the evidence which would have been filed by either party and could therefore not prejudice the applicant.

25) The sole ground of opposition is under Section 3(6) which reads:

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

26) In *Red Bull GmbH v Sun Mark Ltd & Anr* [2012] EWHC 1929 and [2012] EWHC 2046 (Ch), Mr Justice Arnold summarised the general principles underpinning section 3(6) as follows:

“Bad faith: general principles

130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/ Article 3(2)(d) of the Directive/ Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of 27 many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C-529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2009] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207–2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffstoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also “some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined”: see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and

DAAWAT Trade Mark (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see Melly's Trade Mark Application [2008] RPC 20 at [51] and CHOOSI Trade Mark (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see Cipriani at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see Lindt v Hauswirth at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see AJIT WEEKLY Trade Mark [2006] RPC 25 at [35]-[41], GERSON Trade Mark (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and Campbell v Hughes [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in Lindt v Hauswirth:

“41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-5089 , paragraph 48).”

27) The applicant contended that all of the evidence of the opponents was flawed and should be discounted as they referred to a “company” when no such legal entity existed. In my experience it is common for individuals or partnerships to refer to their businesses as a company. This does not make any statement misleading, as it was clear to everyone that the “company” being referred to was the partnership CAE. I pointed out to the applicant that most of the major law and accountancy firms are LLP’s, yet no-one would consider a reference to them as a “company” as being misleading. The applicant has accepted in her evidence that under the law in the Cayman Islands she had to be employed by a registered business and that she did not qualify to be registered as a business in her own name. The applicant’s evidence as summarised at paragraphs 15 & 16 above clearly states that under the laws of the Cayman Islands she was employed by a range of businesses. The employers in the crucial period, around the time that the band was formed being, Millennium Talent Management from April 2008 to June 2008, and CAE from June 2008 to August 2013. At the hearing the applicant contended that most of those involved in business in the Cayman Islands are corrupt and that most work permits are legalised extortion with the Cayman residents able to obtain payment for falsifying documents. Interestingly, the applicant would not accept that if this were the case then she too was complicit in hoodwinking the Cayman authorities as she would have had to have freely gone along with the subterfuge in return for providing, by her own evidence, work to Mr Boxwell. The applicant invited me to accept that all of the witness statements provided by the opponents were false and part of a conspiracy against her by the opponents and their friends or those they can blackmail into providing false statements. She also claims that all of the documents such as receipts from the Cayman Government and letters from the bank stating who the account was set up by are false, as she paid her own work permit fees, pension and healthcare fees, and that the bank account was also hers. Further, it is claimed that the musicians were paid by her, and that she was the attractive force in the band and as such owned all the goodwill. In the absence of any evidence to back up these contentions, set against the documented claims of the opponents, I reject the applicant’s contentions.

28) The opponents filed evidence which states that the applicant was employed by Millenium Talent Management at their request and the owner of this business also provided a witness statement stating that the applicant was “sub-contracted” to the Suite Elite Band until CAE could be formed. Once CAE was formed and licensed then they took over the employment of the applicant. The applicant’s own evidence shows her promoting herself as the manager of the band known as Suite Elite. If, as she claims, Suite Elite is simply another of her performing names then this seems somewhat odd. All of the evidence points to the band known as Suite Elite having been formed in May 2008 (exhibit PB14). At this time the applicant was said to be subcontracted to the

band until CAE gained legal status and could function as a business and thus apply for a work permit for the applicant. I also note that the other members of the band have also provided statements which state that they were employed by CAE. However, I also note that CAE do not appear to have required band members to sign a waiver granting all rights including goodwill to CAE.

29) The applicant contends that the mark has been used by her since 2009 on recordings and that use has been made in the UK and worldwide of the name Suite Elite and that the opponents had acquiesced to such use. However, no evidence was filed that the other members of the band were aware of what the applicant was doing or, if they were aware, from what date they became aware of such usage. I note that the record sleeve shows the name as "Suite Elite featuring Pam Burgess", and the evidence also shows that the names "Pam Ella and the Suite Elite Dub section featuring Sly and Robbie" and "Pam Ella and the Suite Elite Orchestra" (paragraph 17). It is my understanding that when the term "featuring" is used this indicates that a person is a guest performer on another artists recording. Just as Sly and Robbie are well known in their own right and are not members of Suite Elite. To my mind, the applicant's use is not with clean hands. As the manager of the band known as Suite Elite in the Cayman Isles she had a duty to the other members. Instead, she seems to believe that she is the embodiment of the band. I understand that as the lead singer, and the only female in the group she would inevitably garner most of the attention. However, this does not negate the rights of the other band members.

30) As to the contention that the opponents gave the applicant permission to use the mark in the UK, and also gave a clear indication that the opponents would cease to use the mark in suit after a transitional period of a few months I find this fanciful and self serving. The transcript of the conversation shows that the applicant did not set out clearly and unequivocally her plans and that the opponents were reacting to events as they unfurled in the meeting and seemed, to my mind, to be thinking out loud. The only person who knew precisely what her plans were for the mark was the applicant and her position changed as the meeting wore on. At no point does she state what use she had already made of the mark in a separate deal with her record company and the future plans to use the mark as a band name. The discussion centred on the applicant setting up an agency business which the opponents thought would not impact their band in the Caymans. This of course was without the benefit of any legal advice and could not be taken as binding by any normal reasonable person. Given that the meeting was surreptitiously recorded by the applicant's friend and advisor it could be suggested that the conversation was steered to ensure it was unfavourable to the opponents. It is also difficult to accept that the applicant knew nothing about the recording until a year later.

31) Ms Edwards-Stuart pointed out that in order to obtain a trade mark in the Cayman Islands, one must first obtain a UK registered trade mark and then apply to extend that trade mark to the Cayman Islands. This means that by applying for the trade mark in the UK for such a wide range of goods and services the applicant was in a position to block the opponents being able to register the mark for use in the Cayman Islands.

32) Taking into account all of the above it is my opinion that any goodwill and reputation in the Cayman Islands would reside either with CAE or with all the members of the band. Each time the line up changed, which was not that frequently, the new line up effectively started a new partnership at will. This is not a case of the last man standing as the band Suite Elite still exists, has performed with another lead singer instead of the applicant and has bookings in the Cayman Islands. However, merely knowing that another party uses a mark abroad is not sufficient to justify a finding that a mark was registered in bad faith in the UK (*Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker*, Case C-320/12, CJEU). To my mind neither party has established goodwill in the UK and crucially the opponents have not shown that the applicant's motivation in seeking registration was not simply to use the mark in the UK but part of a devious plan to use the mark herself in the Cayman Islands, something which she has denied. There is no evidence to suggest that the applicant was seeking to disrupt the opponents business in the Cayman Islands. As such the applicant cannot be held responsible for the technical outcome that registration in the UK blocks registration in the Cayman Islands. **Therefore the opposition under Section 3(6) of the Act fails.**

CONCLUSION

33) The opponents have failed in their opposition.

COSTS

34) As the applicant has been successful ordinarily she would be entitled to a contribution towards her costs. However, the allegations made by the applicant in the course of her evidence caused the opponents to file additional witness statements. In addition the late request to allow the transcript of the covert recording caused additional work to the opponent and yet was of no value to my decision, if anything it strengthened the opponents' case that the applicant did not own the goodwill under the mark in the Cayman Islands. I therefore decline to award any costs.

Dated this 2nd day of December 2014

**George W Salthouse
For the Registrar,
the Comptroller-General**