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TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 3069320 IN THE NAME OF PAUL GILMARTIN

AND IN THE REQUEST FOR A DECLARATION OF INVALIDITY THERETO UNDER NO. 500708 BY PAUL NASH AND MAETHELIAH L PILE

AND IN THE MATTER OF TRADE MARK APPLICATION NOS 3083130 AND 3083229 BY PAUL NASH AND MAETHELIAH L PILE

AND IN THE MATTER OF OPPOSITION NOS 404032 AND 404043 THERETO BY PAUL GILMARTIN

DECISION

Introduction

1. This is an appeal against the decision of Mr George Salthouse, acting on behalf of the Registrar, dated 17 February 2016 (O-086-16). In his Decision the Hearing Officer:
 - (1) Allowed the application for a declaration of invalidity by Paul Nash and Maethelyiah L Pile in respect of Trade Mark Registration No. 3069320 in the name Paul Gilmartin for the series of marks ("*the Series Mark*"):



- (2) Allowed Opposition No. 404032 brought by Paul Gilmartin to Application No 3083130 in the name of Paul Nash and Maethelyiah L Pile for the mark ("*the Logo Mark*"):



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(3) Allowed Opposition No. 404043 brought by Paul Gilmartin to Application No. 3083229 in the name Paul Nash and Maethelyiah L Pile for the mark **THE DANSE SOCIETY** (“*the Word Mark*”).

2. The appeal relates to the question whether which, if any, of the parties is entitled to the registration of a trade mark of the name a band namely The Danse Society. I understand that negotiations/mediation of the dispute has been raised at various times by the parties with a view to resolving the issue as between them but that has come to nothing.

Background

3. On 20 August 2014 Mr Gilmartin applied to register the Series Mark and on 21 November 2014 that mark was registered for the following services in Class 41:

Live performances by a musical band; Music concert services; Music concerts; Music performances; Music production; Music publishing; Music publishing and music recording services; Performance of music and singing; Performing of music and singing; Production of sound and music recordings; Providing digital music [not downloadable] for the internet; Providing digital music [not downloadable] from MP3 internet web sites; Providing digital music [not downloadable] from MP3 internet websites; Providing digital music [not downloadable] from the internet; Music entertainment services; Arranging of music shows; Band performances (live -); Digital music [not downloadable] provided from mp3 web sites on the internet.

4. On 25 November 2014 Mr Nash and Ms Pile applied to register the Logo Mark in respect of the following services in Class 41:

Live performances by a musical band, Music concert services, Music composition for film radio documentary and television use, Music concerts, Music performances, Music production, Music publishing, Music publishing and music recording services, Performance of music and singing, Performing of music and singing, Production of sound and music recordings, Providing digital music [not downloadable] for the internet, Providing digital music [not downloadable] from MP3 internet web sites, Providing digital music [not downloadable] from MP3 internet websites, Providing digital music [not downloadable] from the internet, Music entertainment services, Arranging of music shows, Digital music [not downloadable] provided from mp3 web sites on the internet.

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5. On 26 November 2014 Mr Nash and Ms Pile applied to register the Word Mark in respect of the following goods and services:

Class 9: Photographic, cinematographic, apparatus for recording, transmission or reproduction of sound or images; recording discs; compact discs, DVDs and other digital recording media; data processing equipment, computers; computer software.

Class 25: Clothing, footwear, headgear.

Class 41: Live performances by a musical band, Music concert services, Music composition for film radio documentary and television use, Music concerts, Music performances, Music production, Music publishing, Music publishing and music recording services, Performance of music and singing, Performing of music and singing, Production of sound and music recordings, Providing digital music [not downloadable] for the internet, Providing digital music [not downloadable] from MP3 internet web sites, Providing digital music [not downloadable] from MP3 internet websites, Providing digital music [not downloadable] from the internet, Music entertainment services, Arranging of music shows, Digital music [not downloadable] provided from mp3 web sites on the internet.

6. By an application dated 16 December 2014 Mr Nash and Ms Pile applied for a declaration of invalidity. They did so on the basis that in summary:
- (1) In February 1981 Mr Nash and Mr Gilmartin together with Steve Rawlings, Tim Wright and Lyndon Scarfe formed a musical band called The Danse Society. This band disbanded in 1986. In 2009 The Danse Society was reformed by Mr Nash and Mr Gilmartin together with Steve Rawlings and David Whitaker ("*the Band*"). In January 2011 Ms Pile joined the Band. It was averred that the Series Mark as registered was first used by the Band in December 2011 but that a 'crown of thorns logo' very similar to the Series Mark had been used since 2009 and had been designed by Mr Nash personally. It was further averred that M Gilmartin voluntarily left the Band on 30 January 2014 but that after that date the Band continued to perform. It was alleged that it was always understood by the Band members that if one of them left the Band the remaining band members would be entitled to use the mark The Danse Society whether in word of logo format and that the exiting member would not be able to use such mark or marks. On that basis it was stated that the registration by Mr Gilmartin was contrary to section 5(4)(a) of the Trade Marks Act 1994 ("*the Act*").

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- (2) The registration by Mr Gilmartin was contrary to section 5(4)(b) of the Act as the logo the subject of the Series Mark was designed by Mr Sam Cairney in August 2011, upon Mr Nash's personal instructions and that Mr Cairney licensed the sole usage of the logo to Mr Nash in connection with the Band. That Mr Nash and Ms Pile had deposited the 'copyright work' with The UK Copyright Service under Registration No. 284679401.
 - (3) By reason of the matters above and Mr Gilmartin's knowledge of such matters the application for the Series Mark had been made in bad faith.
7. On 27 February 2015 Mr Gilmartin filed a Counterstatement in which he denied all the Grounds and contended (1) that the Band did not enjoy success; (2) had performed under the name The Danse Society and not under the Series Mark; and (3) that Mr Nash and Ms Pile were confusing copyright with trade mark law.
8. On 23 March 2015 Mr Gilmartin filed a Notices of Opposition (which was subsequently amended) in respect of both the applications filed by Mr Nash and Ms Pile. The Grounds of Opposition in each case were in summary:
 - (1) Under sections 5(1) and 5(2) of the Act on the basis of Mr Gilmartin's earlier right in the form of the trade mark registration for the Series Mark;
 - (2) Under sections 5(3) and 5(4)(a) of the Act on the basis that he had used the Series Mark since 20 August 2014 and was the owner of the goodwill and reputation in the mark in the UK with respect to the services applied for in Class 41; and
 - (3) Under section 3(6) of the Act on the basis that Mr Nash and Ms Pile were aware of Mr Gilmartin's earlier mark but had gone on to apply for the marks in suit; had contacted promoters and venues and stated that Mr Gilmartin's earlier mark was 'illegal' and that they owned the mark The Danse Society in word and logo form; and had used such marks causing confusion.
9. On 9 July 2015 (Opposition No 404032) and on 12 August 2015 (Opposition No 404043) Mr Nash and Ms Pile filed Counterstatements. Those Counterstatements in essence reiterated the points made in paragraphs 6(1) and 6(2) above.
10. The application for invalidity and the oppositions were consolidated on 1 October 2015.
11. Both sides filed evidence.
12. The matter came to be heard on 26 January 2016 when Mr Gilmartin represented himself and Mr Nash represented himself and Ms Pile.

The Hearing Officer's Decision

13. Having set out a review of the evidence filed on behalf of the parties the Hearing Officer first considered the Application for invalidity. He began with the Ground of Opposition under section 5(4)(b) and stated as follows:

30) There is some confusion as to quite who originated the logo which is said to have been copied by the mark in suit. The mark in suit has a logo device of a crown of thorns integrated with the letter "O" in the word "Society". In the statement of grounds it is claimed that the words "The Danse Society" with the crown of thorns device in the letter "O" has been copyrighted by [Mr Nash and Ms Pile]. It is claimed that the creator of this was Mr Cairney who was credited on the album sleeve with the sleeve artwork. He is said to have licensed this work to Mr Nash solely for use with the band known as The Danse Society. However, later in his evidence Mr Nash claims that the crown of thorns device was originally designed by himself with the assistance of another band member, Mr Rawlings, and used on a number of album covers and on posters, flyers etc. albeit underneath or above the name of the band and not incorporated into the letter "O". It is stated that the original crown of thorns artwork was supplied to Mr Cairney for him to develop for use on the band's album cover.

31) I take into account the case of *BBC Worldwide Ltd v Pally Screen Printing Ltd* [1998]FSR 665 at 669 where Laddie J. was faced with a claim for copyright infringement based on T-shirts bearing representations of the well known "Teletubbies" characters. He said:

"It is not possible to identify a particular artistic work created by or on behalf of the plaintiffs of which these can be said to be unlicensed reproductions. However, the plaintiffs say that this is effectively a *Popeye* type case, that the artwork on these two T-shirts must have been derived from one or other of those numerous drawings. Therefore substantial reproduction of a copyright work is made out. That is the overall structure of the claim to copyright infringement.

I must say that as far as the second group of garments is concerned, once again it seems to me clear that this artwork is derived directly or indirectly from Teletubby designs and, subject to the other defences raised by the defendants in this action, my view is that there is no reasonable defence to the plaintiff's claim that this artwork is a substantial reproduction of one or other

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pieces of artwork which the plaintiffs have generated in designing Teletubby programmes.”

32) It seems clear to me that copyright cannot subsist with Mr Cairney. It appears that the design was created by Mr Nash and Mr Rawlings. Copyright is owned by the author(s) or their employers if created under a contract of employment. There is no suggestion that either were employed to design the logo and so the design of the crown of thorns logo belongs jointly to Mr Nash and Mr Rawlings. Whilst Ms Pile cannot claim ownership to the copyright, Mr Nash can and he can act independently of Mr Rawlings in seeking to protect his copyright. He is therefore the proprietor of the copyright to the crown of thorns device and as such the ground of opposition under section 5(4)(b) succeeds.

14. The Hearing Officer then turned to consider the position under section 5(4)(a) of the Act. Having reviewed the general case law relating to passing off in paragraphs [34] to [38] of his Decision the Hearing Officer then referred to two cases relating to the considerations to be applied in cases involving bands namely The Original Bucks Fizz case (O-296-11) at paragraph [39] of his Decision in which the Hearing Officer referred to the judgment of Laddie J. in Byford v. Oliver [2003] FSR 39 and the Decision of Geoffrey Hobbs QC sitting as the Appointed Person in The Animals (O-369-13) at paragraph [40] of his Decision.
15. Having reviewed this case law the Hearing Officer went on to make the following findings:

41) In the instant case [Mr Nash and Ms Pile] put forward a list of the different band line ups over the years. However, the events in early 2014 seem to have been distorted, perhaps by the passage of time. It is accepted by both parties that from May 2012 to the start of January 2014 the band consisted of five members, Gilmartin, Nash, Pile, Roberts and Whitaker. Initially the view of [Mr Nash and Ms Pile] was that [Mr Gilmartin] had resigned on 30 January 2014 and the rest of the band carried on albeit having to find a replacement for [Mr Gilmartin]. However, it seems relatively certain that Roberts left the band at the same time as Gilmartin. It also seems, contrary to comments by [Mr Nash and Ms Pile] that Whitaker also left at this point. The email from Mr Whitaker to Mr Nash and Mr Gilmartin is dated 8 March 2014 and is reiterating his view that he will not join either of the offshoots of the band. It therefore seems to me that at the end of January the band split three ways. Gilmartin and Roberts going one way, Nash and Pile another with Mr Whitaker opting out in order to concentrate on his studio business.

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42) The activities of Mr Gilmartin after January 2014 seem fairly clear. He first of all started a group named after one of [The Danse Society's] songs "Heaven is Waiting". There is no evidence that this band actually played any gigs or recorded anything. It was quickly renamed "Danse Society Reincarnated" which also appears to have done little if anything and by August 2014 he changed it to [The Danse Society] and applied to register the mark. Therefore at the point of the application Mr Gilmartin and his new band members had not accrued any independent goodwill in the name [The Danse Society].

43) The activities of [Mr Nash and Ms Pile] are less clear cut. However, it is clear that whilst maintaining that Mr Whitaker was still part of the line-up Ms Pile states that he was unavailable to tour until July 2014 and that "after a few hesitations" he left the band in September 2014. He was not replaced until November 2014. There were also other comings and goings within [Mr Nash's and Ms Pile's] band (see paragraph 17 above). It was in November 2014 that the new band put together by [Mr Nash and Ms Pile] began recording a single which was due to be released in December 2014, although it is unclear if this actually occurred. Ms Pile states that this single "re-established The Danse Society as a living entity" which suggests that 2014 had been a year of little or no activity.

44) Given the comments of [Mr Nash and Ms Pile] that the band was run along democratic lines with all members receiving royalties irrespective of who wrote a song and sharing all income and costs equally I do not understand why in part of their evidence they suddenly write Mr Roberts out of history and claim that only a quarter of the band ([Gilmartin]) left in January 2014 whilst three-quarters ([Nash and Pile] and Whitaker) remained. The sales figures provided at paragraph 13 apparently include sales of recordings (CDs etc), merchandise and revenue from shows. These figures can best be described as small. Notwithstanding this, the band would have had enough residual goodwill that use of the name eight months after the split would have caused misrepresentation. In my opinion none of the last men standing (Gilmartin, Nash, Pile, Roberts and Whitaker) had abandoned their rights to the name [The Danse Society].

45) It therefore follows that Mr Gilmartin's application (sic) would cause misrepresentation and **therefore offends against section 5(4)(a) of the Act and the opposition succeeds.**

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16. Other than identifying section 3(6) of the Act as a ground of invalidity (paragraph 2(c) of the Decision) the Hearing Officer did not refer to the section 3(6) basis for seeking invalidity of the trade mark registration in his Decision.
17. With respect to the opposition proceedings the Hearing Officer dealt with the matter very shortly at paragraphs [46] and [47] of his Decision as follows:
 - 46) Given the finding in paragraph 44 that Gilmartin, Nash, Pile, Roberts and Whitaker equally had goodwill under the name [The Danse Society] in respect of sales of recordings (CDs etc), merchandise and live shows obviously impacts upon the two applications of [Mr Nash (sic)]. To my mind the goodwill covers all the goods and services applied for under these two marks. As such, the oppositions under Section 5(4)(a) must succeed for the same reasons that the application to invalidate [Mr Gilmartin's] registration succeeded.
 - 47) This finding may at first blush appear strange given my finding earlier in this decision that Mr Nash was the joint owner of the copyright in one of the marks he has sought to register. However, Mr Gilmartin owns a share in another legal right, passing off, which prevents Mr Nash using the mark on his own account in relation to the goods and services at issue.
18. Save that he identified all the grounds of opposition in paragraph [7] of his Decision (including a ground under section 3(6) of the Act) the Hearing Officer made no reference to any of the grounds of opposition relied upon other than under section 5(4)(a) of the Act referred to in paragraphs [46] and [47] of the Decision.

The Appeal

19. On 16 March 2016 Mr Nash and Ms Pile appealed the Decision of the Hearing Officer with respect to the opposition proceedings.
20. The Grounds of Appeal filed by Mr Nash and Ms Pile contend in substance that the Hearing Officer erred in finding that Mr Gilmartin along with the other 'last men standing' owned a share in the goodwill in the mark The Danse Society whether in word or logo form on the basis that the Band had split on or around the end of January 2014.
21. Instead it was contended that the Hearing Officer should have found on the evidence before him that: (1) Mr Gilmartin had resigned from the Band on or about January 2014 and having left the Band ceased to have any interest in the collectively owned goodwill; and (2) the Band continued to exist being made up of Mr Nash and Ms Pile together with others from time to time who collectively continued to have and to accrue goodwill in The Danse Society in word and/or logo form.

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22. It was further contended that the Hearing Officer's findings in respect of the copyright in the logo in the context of the invalidity proceedings was inconsistent with the findings that he made in respect of the opposition proceedings.
23. In those circumstances it was averred that the Hearing Officer should not have allowed the oppositions on the basis of section 5(4)(a) of the Act.
24. No appeal was brought by Mr Gilmartin in relation to the findings made by the Hearing Officer with respect to the invalidity proceedings.
25. A Respondent's Notice was served. In so far as the Respondent's Notice contained relevant material it stated that the Hearing Officer was correct to allow the Oppositions for the reasons he gave and in particular on the basis that: (1) there was a band split; and (2) that on the split each band member retained an interest in the assets which included the goodwill and name of the band i.e. The Danse Society in word and/or logo form. That this was the position being taken by Mr Gilmartin on the appeal was confirmed by him at hearing.
26. It is to be noted from the above that there is no appeal before me in relation to the Grounds of Opposition in respect of which the Hearing Officer made no findings in his Decision.
27. At the hearing of the appeal Ms Pile made submissions on behalf of herself and Mr Nash and Mr Gilmartin represented himself.

Standard of review

28. This appeal is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong. See Reef Trade Mark [2003] RPC 5, and BUD Trade Mark [2003] RPC 25.
29. In Fine & Country Ltd v Okotoks Ltd (formerly Spicerhaart Ltd) [2013] EWCA Civ 672; [2014] FSR 11 Lewison LJ said:

50. The Court of Appeal is not here to retry the case. Our function is to review the judgment and order of the trial judge to see if it is wrong. If the judge has applied the wrong legal test, then it is our duty to say so. But in many cases the appellant's complaint is not that the judge has misdirected himself in law, but that he has incorrectly applied the right test.

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In the case of many of the grounds of appeal this is the position here. Many of the points which the judge was called upon to decide were essentially value judgments, or what in the current jargon are called multi-factorial assessments. An appeal court must be especially cautious about interfering with a trial judge's decisions of this kind. There are many examples of statements to this effect. I take as representative Lord Hoffmann's statement in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] 1 WLR 2416 , 2423:

‘Secondly, because the decision involves the application of a not altogether precise legal standard to a combination of features of varying importance, I think that this falls within the class of case in which an appellate court should not reverse a judge's decision unless he has erred in principle.’

30. This approach was reiterated by the Court of Appeal in Fage UK Ltd v. Chobani UK Ltd [2014] EWCA Civ 5; [2014] E.T.M.R. 26 at paragraphs [114] and [115]. Moreover in paragraph [115] Lewison LJ said:

115 It is also important to have in mind the role of a judgment given after trial. The primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties and, if need be, the Court of Appeal the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted. These are not controversial observations: *see Customs and Excise Commissioners v A* [2002] EWCA Civ 1039; [2003] Fam. 55; *Bekoe v Broomes* [2005] UKPC 39; *Argos Ltd v Office of Fair Trading* [2006] EWCA Civ 1318; [2006] U.K.C.L.R. 1135.

31. More recently Geoffrey Hobbs QC in ALTI Trade Mark (O-169-16) considered the approach at paragraphs [19] to [20] where he referred to the general applicability of the observations of Lord Neuberger PSC in Re B (a child) (Care Order Proceedings) [2013] UKSC 33 at paragraphs [93] and [94]:

[93] There is a danger in over-analysis, but I would add this. An appellate judge may conclude that the trial judge's conclusion on proportionality was (i) the only possible view, (ii) a view which she considers was right, (iii) a view on which

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she has doubts, but on balance considers was right, (iv) a view which she cannot say was right or wrong, (v) a view on which she has doubts, but on balance considers was wrong, (vi) a view which she considers was wrong, or (vii) a view which is unsupportable. The appeal must be dismissed if the appellate judge's view is in category (i) to (iv) and allowed if it is in category (vi) or (vii).

[94] As to category (iv), there will be a number of cases where an appellate court may think that there is no right answer, in the sense that reasonable judges could differ in their conclusions. As with many evaluative assessments, cases raising an issue on proportionality will include those where the answer is in a grey area, as well as those where the answer is in a black or a white area. An appellate court is much less likely to conclude that category (iv) applies in cases where the trial judge's decision was not based on his assessment of the witnesses' reliability or likely future conduct. So far as category (v) is concerned, the appellate judge should think very carefully about the benefit the trial judge had in seeing the witnesses and hearing the evidence, which are factors whose significance depends on the particular case. However, if, after such anxious consideration, an appellate judge adheres to her view that the trial judge's decision was wrong, then I think that she should allow the appeal.

32. It is necessary to bear these principles in mind on this appeal.

Decision

33. As noted above at the centre of this dispute is the extent, if any, to which Mr Nash, Ms Pile and/or Mr Gilmartin are entitled to the exclusive rights conferred by registration of a trade mark.
34. As noted in the Decision, and there does not seem to be any dispute about this, in February 1981 Mr Nash and Mr Gilmartin together with Steve Rawlings, Tim Wright and Lyndon Scarfe formed a musical band which performed under the name The Danse Society. The band disbanded in 1986. In 2009 a band under the name The Danse Society was formed by Mr Nash and Mr Gilmartin together with Steve Rawlings and David Whitaker (as defined above "*the Band*"). In January 2011 Ms Pile joined the Band and by May 2012 Martin Roberts had also joined the Band. That remained the position, as was accepted by the parties, until January 2014: see paragraph [41] of the Decision.
35. It is not disputed that there was no written agreement between the members of the Band at any material time. Mr Nash gives evidence that from the beginning the Band was always a democracy with all members sharing equally in the royalties/income and sharing all costs. Again that does not seem to be a matter of dispute.

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36. As noted above in paragraph [40] of the Decision the Hearing Officer referred to the decision of Geoffrey Hobbs QC sitting as the Appointed Person in The Animals (above) and in particular to the proposition that goodwill belonged to the ‘last man standing’ a proposition which the Hearing Officer then went on to apply in the present case.
37. In paragraph [8] of the Decision of Mr Hobbs QC in The Animals he referred to his earlier decision in CLUB SAIL Trade Marks [2010] RPC 32 at paragraphs [26] to [28]. Those paragraphs state as follows (emphasis added):

26 This opens up the appeal to the extent that I am now required to determine the competing claims of the parties to proprietorship of the goodwill of the business appertaining to the signs in issue. Before doing so, **I make the general observation that goodwill can be and frequently is built up and acquired by means of economic activities carried out collectively. By using the word ‘collectively’ I am intending to refer to all of the various ways in which alliances may be formed between and among individuals or corporate bodies in pursuit of shared interests and objectives.** It is appropriate in this connection to refer to the following observations in the judgment of the Court of Appeal delivered by Hughes L.J. in *R v L(R) and F(J)* [2008] EWCA Crim. 1970; [2009] 1 Cr. App. R 16:

Unincorporated associations

11. There are probably almost as many different types of unincorporated association as there are forms of human activity. This particular one was a club with 900-odd members, substantial land, buildings and other assets, and it had no doubt stood as an entity in every sense except the legal for many years. But the legal description “unincorporated association” applies equally to any collection of individuals linked by agreement into a group. Some may be solid and permanent; others may be fleeting, and/or without assets. A village football team, with no constitution and a casual fluctuating membership, meeting on a Saturday morning on a rented pitch, is an unincorporated association, but so are a number of learned societies with large fixed assets and detailed constitutional structures. So too is a fishing association and a trade union. And a partnership, of which there are hundreds of thousands, some very large indeed, is a particular type of unincorporated association, where the object of the association is the carrying on of business with a view to profit.

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12. At common law, an unincorporated association is to be distinguished from a corporation, which has a legal personality separate from those who have formed it, or who manage it or belong to it. The most numerous species of corporation is the limited liability company, but there are of course other types, such as chartered professional associations, local government bodies and indeed bishops. At common law, as the judge succinctly held, an unincorporated association has no legal identity separate from its members. It is simply a group of individuals linked together by contract. By contrast, the corporation, of whatever type, is a legal person separate from the natural persons connected with it.

13. This is an apparently simple legal dichotomy duly learned by every law student in his first year. But its simplicity is deceptive. It conceals a significantly more complicated factual and legal position.

14. As to fact, many unincorporated associations have in reality a substantial existence which is treated by all who deal with them as distinct from the mere sum of those who are for the time being members. Those who have business dealing with an unincorporated partnership of accountants, with hundreds of partners world-wide, do not generally regard themselves as contracting with each partner personally; they look to the partnership as if it were an entity. The same is true of those who have dealings with a learned society, or a trade union, or for that matter with a large established golf club. Frequently, as Lord Phillips of Worth Matravers C.J. pointed out in *R. v W. Stevenson & Sons* (a partnership and others) [2008] EWCA Crim. 273; [2008] 2 Cr. App. R. 14 (p.187) (at [23]) third parties will simply not know whether the organisation being dealt with is a company or some form of unincorporated association.

15. As to the law, it no longer treats every unincorporated association as simply a collective expression for its members and has not done so for well over a hundred years. A great array of varying provisions has been made by statute to endow different unincorporated associations with many of the characteristics of legal personality. Examples selected at random include the following. The detailed special rules for partnerships contained in the Partnership Act 1890 scrupulously preserve the personal joint and several liability of the partners (see ss.5-12), and the Law

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Commission recommendation in November 2003 (Law Com. No. 283) that a firm should have legal personality has not been implemented, but the partnership can sue or be sued in its firm name: see CPR 7.2A and 7PD5A.3, repeating a rule which has existed for more than a century. A trade union is, by statute, not a corporation: s.10(1) of the Trade Union and Labour Relations (Consolidation) Act 1992. But by the same section it can make contracts, sue and be sued in its own name, and commit a criminal offence. In the case of learned societies and institutions, their property (if not vested in trustees) is by s.20 of the Literary and Scientific Institutions Act 1854 vested in their governing body, albeit that neither the institution nor the governing body is a corporation. Nor are these developments confined to the statutory. As long ago as 1901 the House of Lords held in *Taff Vale Railway v Amalgamated Society of Railway Servants* [1901] A.C. 426 that a trade union (unincorporated) could be sued in its own name despite the absence of any statutory provision permitting it. Lord Lindley observed (at 442) that the problem of how to adapt legal proceedings to unincorporated societies consisting of many members was by no means new, and that the rules of common law had had to be altered to meet them. Those several examples relate largely to civil liability, but as will be seen, there is a similar variety of provision dealing with criminal liability in the case of unincorporated associations. The judgment in that case related to the operation of the general rule that in any enactment passed after 1889 the word 'person' includes 'a body of persons corporate or unincorporate' unless the contrary intention appears: s.5 and Sch. 1, Interpretation Act 1978.

27 I consider that the starting point for the purposes of analysis in the present case is the general proposition that the goodwill accrued and accruing to the members of an alliance such as I have described is collectively owned by the members for the time being, subject to the terms of any contractual arrangements between them: *Artistic Upholstery Ltd v Art Forma (Furniture) Ltd* [2000] F.S.R. 311 at paras.31 to 40 (Mr. Lawrence Collins Q.C. sitting as a Deputy High Court Judge). When members cease to be members of an ongoing alliance they cease to have any interest in the collectively owned goodwill, again subject to the terms of any contractual arrangements between them; see, for example, *Byford v Oliver (SAXON Trade Mark)* [2003] EWHC 295 (Ch); [2003] F.S.R. 39 (Laddie J.); *Mary Wilson Enterprises Inc's Trade Mark Application (THE SUPREMES*

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Trade Mark) BL O-478-02 (20 November 2002); [2003] EMLR 14 (Appointed Person); *Dawnay Day & Co Ltd v Cantor Fitzgerald International* [2000] R.P.C. 669 (CA); and note also the observations of Lord Nicholls of Birkenhead in *Scandecor Development AB v Scandecor Marketing AB* [2001] UKHL 21; [2002] F.S.R. 7 (HL) at paras.[42] to [44]. **This allows the collectively owned goodwill to devolve by succession upon continuing members of the alliance down to the point at which the membership falls below two, when ‘the last man standing’ becomes solely entitled to it in default of any other entitlement in remainder:** see, for example, *VIPER Trade Mark* (BL O-130-09; 13 May 2009) (Appointed Person, Professor Ruth Annand).

28 These principles were fully analysed and explained in the context of a claim concerning the distribution of the assets of an unincorporated association in the judgment of Lewison J. in *Hanchett-Stamford v Attorney General* [2008] EWHC 330 (Ch.); [2009] Ch. 173 at paras.[28] to [50]. At para.[47] he provided the following summary:

47. The thread that runs through all these cases is that the property of an unincorporated association is the property of its members, but that they are contractually precluded from severing their share except in accordance with the rules of the association; and that, on its dissolution, those who are members at the time are entitled to the assets free from any such contractual restrictions. It is true that this is not a joint tenancy according to the classical model; but since any collective ownership of property must be a species of joint tenancy or tenancy in common, this kind of collective ownership must, in my judgment, be a subspecies of joint tenancy, albeit taking effect subject to any contractual restrictions applicable as between members. In some cases (such as *Cunnack v Edwards* [1895] 1 Ch. 1 489; [1896] 2 Ch. 679) those contractual restrictions may be such as to exclude any possibility of a future claim. In others they may not. The cases are united in saying that on a dissolution the members of a dissolved association have a beneficial interest in its assets, and Lord Denning MR goes as far as to say that it is a “beneficial equitable joint tenancy”. I cannot see why the legal principle should be any different if the reason for the dissolution is the permanent cessation of the association’s activities or the fall in its membership to below two. The same principle ought also to hold if the contractual restrictions are abrogated or varied by agreement of the members. . . .

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I believe that this reasoning helps to clarify some of the obscurities in the case law relating to the acquisition, retention and elimination of interests in collectively owned goodwill noted and discussed in Wadlow *The Law of Passing Off* (3rd Edn, 2004) paras.3-104 to 3-185.

38. As noted in paragraph 33 above and as not disputed as between the parties the membership of the Band varied from time to time. It further seems to me that the members of the Band from time to time were members of an alliance of the kind described by Mr Hobbs QC in paragraph [27] of the CLUB SAIL decision (above). That would seem to also have been the finding of the Hearing Officer. That is to say there was collectively owned goodwill.
39. In my view it follows from this that:
- (1) When members ceased to be members of Band they ceased to have any interest in the collectively owned goodwill in the mark, The Danse Society, whether in word or logo form, subject to the terms of any contractual arrangements between them; and
 - (2) The collectively owned goodwill in the mark, The Danse Society, whether in word or logo form would devolve by succession upon continuing members of the Band down to the point at which the membership fell below two, when ‘the last man standing’ would become solely entitled to it in default of any other entitlement in remainder.
40. With regard to whether there were any relevant contractual arrangements between the parties whilst it is common ground that there was no written agreement it is maintained by Mr Nash and Ms Pile that there was an oral contract the effect of which was to confirm the position identified in paragraph 39(1) above; whilst Mr Gilmartin maintains that there were no such contractual arrangement. Either way in the light of the facts and matters set out in paragraphs 37 and 38 above in this particular case it does not matter.
41. It seems to me that on the evidence and on the basis of the other findings that the Hearing Officer made he was wrong to conclude that there was a ‘split’ of the Band such that the band had been brought to an end leaving each of the members at the time of the cessation of the band’s activities as the ‘last men standing’ as was the case in The Animals.
42. Rather it seems to me that what occurred in January 2014 was that Mr Gilmartin relinquished his membership of the Band. That this was the position is confirmed by the findings of the Hearing Officer in paragraph [42] of his Decision that Mr Gilmartin had started a new band under a new name “Heaven is Waiting”. Again as

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found by the Hearing Officer it was only later that Mr Gilmartin's band was renamed "Danse Society Reincarnated" and ultimately "The Danse Society".

43. Further support of this position can be found in the evidence some of which was whilst noted in the summary of evidence was not explicitly referred to by the Hearing Officer when making his findings. For example a statement by Mr Gilmartin on Facebook in which he stated on 30 January 2014 '*for those interested . . . the rhythm section has resigned . . . sorry if u were planning to come to the shows this tour I apologise*'.
44. It would also seem that Mr Roberts relinquished his membership of the Band at around the same time as Mr Gilmartin as was found by the Hearing Officer. Mr Whitaker likewise relinquished his place in the Band. There is a dispute as to whether Mr Whitaker relinquished his membership of the Band at some stage after Mr Gilmartin had left on 30 January 2014 but prior to the 8 March 2014 (as held by the Hearing Officer) and September 2014 (according to the evidence of Mr Nash and Ms Pyle and advanced on appeal before me as to which see further below).
45. Again for reasons that will become apparent ultimately the exact date upon which Mr Whitaker relinquished his membership of the Band does not it seems to me affect the outcome of this appeal. What is clear and does not seem to be contested as between the parties is that Mr Whitaker left in order to concentrate on his studio business (again as held by the Hearing Officer).
46. By contrast, neither Mr Nash nor Ms Pile relinquished their membership of the Band. There was no cessation of the Band's activities. Indeed the evidence is quite to the contrary. Although, as the Hearing Officer found in paragraph [43] of his Decision, there was little or no activity in 2014 there is no suggestion in the materials on file that Mr Nash and Ms Pile were not continuing with the Band. Rather the evidence is that they were seeking to recruit new members to the Band and trying to overcome the difficulties that had arisen as a result of a number of members leaving in the course of 2014 and which had led to the cancellation of the planned tour at the beginning of 2014. Those activities were expressly referred to in paragraph [17] of the Hearing Officer's Decision.
47. Moreover the evidence of Mr Nash was that the Band '*continues to trade and has never stopped trading since our reformation in 2011*'. He gives further details of the ongoing sales of various products albeit that they are properly to be regarded as small and of promotional and marketing material which largely appeared online.
48. Further in this connection, I note that the email from Mr Whitaker to Mr Nash on 16 September 2014 suggests that Mr Nash '*should start to audition a new keyboard player*' to replace him and Ms Pile gives evidence that Mr Whitaker on relinquishing his place in the Band provided the relevant details to ensure that the Band could

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'access the digital media distributions as well as the Paypal account'. These are matters that do not appear to be referred to in the Hearing Officer's Decision both of which suggest that Mr Nash and Ms Pile were continuing with the activities of the Band.

49. In addition, there is no suggestion in the evidence of Mr Gilmartin that Mr Nash and Ms Pile were not engaged in these activities. Indeed the Hearing Officer himself accepted that Mr Nash and Ms Pile had not abandoned any rights (paragraph [44] of the Decision).
50. Moreover, it is to be noted that Mr Gilmartin did not appeal the findings of invalidity. In so doing he accepted those findings including the finding that Mr Nash and Ms Pile had a protectable goodwill in the mark The Danse Society whether in word or logo form (albeit that those findings were made on a different basis from the findings made on this appeal) such that the Series Mark was invalid *inter alia* pursuant to section 5(4)(a) of the Act.
51. On the basis of the evidence it seems clear that there were at all times at least two continuing members of the Band. It was not a situation that could properly be characterised as a 'last man standing' one. The collective goodwill remained with the members of the Band and Mr Gilmartin, by leaving the Band in January 2014, thereby relinquished any rights that he may have had in the collective goodwill.
52. In the circumstances, it is my view that the Hearing Officer should have rejected the Opposition to the Word Mark and Logo Mark on the basis of the section 5(4)(a) of the Act objection. As there was no appeal against the finding of invalidity in respect of the Series Mark and no cross-appeal with respect to section 3(6) of the Act Ground of Opposition that was the only Ground of Opposition that was before me for determination.

Conclusion

53. For the reasons given above I allow the appeal by Mr Nash and Ms Pile against the Hearing Officer's Decision in which he allowed Opposition Nos 404032 and 404043 and therefore refused trade mark application Nos 3083130 and 3083229.
54. I therefore direct that Trade Mark Application Nos 3083130 and 3083229 should proceed to registration.
55. In relation to the application for costs of the present appeal the parties agreed at the hearing that I should determine such costs. Since the appeal has been allowed Mr Nash and Ms Pile are entitled to a contribution to their costs of the Appeal. Since they have represented themselves on this appeal I have taken this into account. I will

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therefore order Mr Gilmartin to pay £800 to Mr Nash and Ms Pile jointly for the costs of the appeal.

56. With respect to the costs ordered by the Hearing Officer below: (1) the costs order requiring Mr Gilmartin to pay £1,100 to Mr Nash and Ms Pile with respect to the invalidity proceedings remains unchanged; and (2) the costs order requiring Mr Nash to pay Mr Gilmartin £1,600 is set aside. Mr Nash and Ms Pile are entitled to their costs of the Oppositions. I therefore order Mr Gilmartin to pay £1,600 to Mr Nash and Ms Pile jointly for the costs of the Opposition proceedings.
57. On the basis that, as I understand the position all the cost orders made by the Hearing Officer below were stayed pending the outcome of this appeal, I direct that Mr Gilmartin should pay a total of £3,500 to Mr Nash and Ms Pyle jointly within 14 days of this decision.

Emma Himsworth QC
Appointed Person
16 November 2016