

O-664-19

**CONSOLIDATED PROCEEDINGS UNDER THE TRADE MARKS ACT 1994
CONCERNING:**

1) AN APPLICATION (No. 501828) TO CANCEL TRADE MARK No. 3129760:



OWNED BY ANGLO ATLANTIC MEDIA LIMITED

AND

2) OPPOSITION (No. 411250) AGAINST TRADE MARK No. 3263958:

BONZO DOG DOO DAH BAND

APPLIED FOR BY:

**ROGER SPEAR, NEIL INNES, LARRY SMITH, RODNEY SLATER, VERNON
DUDLEY BOHAY NOWELL & MARTIN ASH (NOW DECEASED)**

BACKGROUND

1. These proceedings have been hard fought by both sides, hard fought in an often emotionally charged manner. In their dealings with the Tribunal, neither side has been represented by legally qualified representatives¹; this has not helped matters. The proceedings have been overly long and, despite best efforts to control matters, have been punctuated by large numbers of procedural issues and applications.

2. At its heart, this is a dispute about the name of band. Unlike many of the band disputes this Tribunal has dealt with over the years, this is not a falling out between band members. Instead, it is a dispute between persons who say they comprise the band (there is no dispute that all of them have been members of the band at some point in time), and a company who, the band say, has either nothing to do with them (and did not know of them), or is otherwise just to be regarded as their promoter.

3. The first trade mark was filed on 2 October 2015 by a company called Anglo Atlantic Media Limited. Throughout these proceedings it has been described as Party B, a moniker I will continue to use. The mark filed by Party B is as follows:



4. The mark was accepted without objection by the IPO, was subsequently published for opposition purposes on 30 October 2015, and, given that no opposition was received, it was entered on the register on 8 January 2016. It is registered for:

Class 9: Music recordings; Digital music [downloadable] provided from mp3 web sites on the internet; Downloadable music files; Digital music downloadable provided from the internet; Prerecorded audio tapes featuring

¹ Save that one side was represented by Counsel at the final hearing.

music; Pre-recorded DVDs featuring music; Compact discs featuring music; Audio tapes featuring music.

Class 41: Music concert services; Music concerts; Music performances; Music production; Music publishing; Music publishing and music recording services; Music publishing services; Performance of music and singing; Performing of music and singing; Music entertainment services; Arranging of music performances; Arranging of music shows; Digital music [not downloadable] provided from mp3 web sites on the internet; Digital music [not downloadable] provided from the internet.

5. On 17 October 2017, the Tribunal received a Form TM26(I), a claim form used to request the invalidation of a registered trade mark. There were two problems with the form: i) the ground given (section 3(6) of the Act - bad faith) lacked specificity as to why the filing of the mark was to be regarded as an act of bad faith, and ii) the claimant had been given simply as “The Bonzo Dog Doo Dah Band”, a name which did not divulge a legal person(s) capable of suing or being sued.

6. The above issues were rectified by who I will refer to as Party A, who said that The Bonzo Dog Doo Dah Band was a partnership consisting of the following six people:

- i) Rodney Slater;
- ii) Neil Innes;
- iii) Sam Spoons (Martin Ash) (I will refer to him as Mr Ash);
- iv) Vernon Dudley Bohay Nowell;
- v) Roger Ruskin Spear;
- vi) “Legs” Larry Smith (I will refer to him as Mr Smith).

7. In terms of the specificity of the claim, and I summarise, it is claimed that The Bonzo Dog Doo Dah Band is the name of a group of musicians formed in the 1960s and is a name which has been used in partnership since then. Party A state that this would have been well known to the registrant, who promoted concerts for the band in 2016 (I note that this is after the trade mark was filed). It is stated in an accompanying letter that Party B approached the band to promote a tour, to which they agreed and signed

a contract, but they had no idea that Party B had already filed the mark. They say it cannot be right for an entity with no entitlement to a well-known band's name, to just register it as a trade mark. The Tribunal accepted these amendments and set a time period for Party B to defend.

8. Party B filed a notice of defence and counterstatement in which, and I again summarise, it says that it has generated goodwill since 2005 associated with the mark it registered, as a result of activities it undertook; later evidence shows that the activities relied upon were those of a claimed predecessor in title, specifically, the activities of a Mr Bob Carruthers, and companies he controlled. It denies that Party A did not know of Party B. It denies that there has been a permanent ensemble with fixed members performing or trading under the name, and it also denies that any goodwill resides entirely with Party A.

9. In relation to the second trade mark the subject of these proceedings, this was filed on 17 October 2017 and consists of the plain words: **BONZO DOG DOO DAH BAND**. Nicknames aside, the applicants were identified as the six individuals detailed in paragraph 6 above. There is no indication that the six individuals were making the application on behalf of a partnership of which they comprise. Although there may be differences between doing things as a partnership and doing things individually, I will still refer to the applicants for this trade mark as Party A unless I need to make some form of distinction. Party A seeks registration for the following:

Class 9: Music recordings; Digital music [downloadable] provided from mp3 web sites on the internet; Downloadable music files; Digital music downloadable provided from the internet; Prerecorded audio tapes featuring music; Pre-recorded DVDs featuring music; Compact discs featuring music; Audio tapes featuring music.

Class 41: Entertainment.

10. The IPO accepted the application, although, after conducting a search of the register, it highlighted to Party A the existence of Party B's earlier mark. The mark was then published for opposition purposes on 3 November 2017. The mark was opposed

by Party B, relying on grounds of opposition under: i) section 5(2)(b) (confusion with its earlier mark), ii) section 5(3) (relying on the same earlier mark with a claimed reputation, which (the mark) would be damaged by the use of the later mark, or would otherwise take unfair advantage of its reputation), and, iii) section 5(4)(a) (that Party B owns the goodwill associated with the name, which would enable it to restrain the use of Party A's mark).

11. Party A defended the opposition. There is no real denial that confusion will arise between the marks. The fact that Party A has not denied the likelihood of confusion does not matter because they have challenged the validity of the earlier mark on which two of the grounds are based; in relation to the third ground (section 5(4)(a)), this is challenged on the basis that Party B does not own the relevant goodwill, party A claims that they do.

12. Both sides filed evidence. A hearing to discuss the substantive claims took place before me on 5 September 2019. Party A was represented by Mr Richard Allen, as they have been throughout these proceedings; Mr Allen is not a legally qualified representative but describes himself as a "friend of the band". Party B was represented by Mr Christian Panayi, of Counsel; at all other times during the proceedings, Party B has been represented by Mr Carruthers.

THE EVIDENCE

13. I do not intend to provide a piece meal summary of the evidence. Instead, I record below who has given evidence on behalf of each party, and, roughly speaking, about what. I will then return to the aspects of the evidence that are necessary to determine matters. I will not touch on everything each witness has said, to do so would not be proportionate in these proceedings:

Party A's evidence

First witness statement of Mr Richard Allen

14. Mr Allen has worked in the music business for many years and describes himself as a fan and friend of the band. Much of his witness statement contains submissions and opinion as opposed to evidence of fact. He does, though, provide some evidence about the history of band, its activities in certain time periods, and the band's relationship with Mr Carruthers since 2005 when he approached the band with a view to promoting a 40th anniversary concert/tour. When I come back to his factual evidence later, I have guarded against the fact that some of it is hearsay in nature.

Witness statement of Mr Rodney Slater

15. Mr Slater is one of the individuals who form Party A, one of the band's members. His evidence is about the formation of the band, its activities and, again, the relationship with Mr Carruthers.

Witness statement of Mr Stephen Fry

16. Mr Fry is a well-known celebrity in the entertainment field. He is also a fan of the band. He was approached to perform with the band as part of the anniversary concert mentioned above, and he gives his view on who he thought he was performing for/with, and his view on the role of Mr Carruthers in this.

Witness statement of Mr Adrian Edmondson

17. Mr Edmondson is another well-known celebrity. His evidence is similar in nature/purpose to that of Mr Fry.

Witness statement of Mr Daniel Barbour

18. Mr Barbour does not explain his role/experience, but it is clear from his evidence that he is involved in the music business in some way, and is also a fan of the band.

He gives evidence about some of the recordings issued by the band and his involvement in releasing/compiling some of them.

Second witness statement of Mr Allen

19. Much of this is, again, submission/opinion, or critiques of Party B's evidence. He does, though, add some factual information about the activities of the band and the relationship with Mr Carruthers.

Witness statement of Ms Robynetta Bradshaw

20. Ms Bradshaw works for Rhino records, part of the Warner group of companies. Her evidence is about various recording agreements with the band, and who she considers the band to be.

Witness statement of Mr Christopher Welch

21. Mr Welch is a music journalist and considers himself to be an authority on the band. He gives evidence about the history of the band and the selection of its name.

Witness statement of Mr Michael Livesey

22. Mr Livesey works in the entertainment industry. His evidence is about his role performing on some of the bands shows in 2015, a subsequent agreement for vocal services reached in relation to a recording of that show, and his potential involvement in a 2016 tour.

Witness statement of Mr David Glasson

23. Mr Glasson is a pianist who has worked with the band. He has also worked with other bands including: "Three Bonzos and a Piano", and "Almost the Dog Doo Dah band". His evidence is primarily about his role in the former band (between 2008 and 2014) and also with the band itself between 2015 and 2016.

Third Witness statement of Mr Allen

24. This, again, is mainly submission. However, there is some further evidence which includes: press releases from 1967 about the composition of the band at that point in time, a 2007 recording contract, and various royalty statements issued to three of the band members.

Witness statement of Mr Vic Pratt

25. Mr Pratt works for the British Film Institute (“BFI”). His evidence is about the band and three events hosted by BFI at which he says members of the band attended/participated. He has never dealt with Mr Carruthers or Party B.

Witness statement of Mr John Kaufman

26. Mr Kaufman also works in the music business. He says that he was the band’s manager between 1997 and 2002 and gives evidence about some of the activities during this period.

Party B’s evidence

First witness statement of Mr Robert Carruthers

27. Mr Carruthers works in the music industry. His evidence is about the history of the band, and, notably, the events from 2005 onwards when he, his companies, and Party B, were involved.

Second witness statement of Mr Carruthers

28. Much of this is by way of submission/critique, although Mr Carruthers does introduce some further factual evidence about his role in matters.

Third witness statement of Mr Carruthers

29. Again, much of this is by way of critique, although, he does give some further evidence particularly dealing with the nature of the band during the time period after 2005.

First Witness statement of Mr Gwilym Davies

30. Mr Davies is a director of Party B. His evidence is predominantly filed to deal with an application for security for costs by Party A (see paragraph 58 below), although, he does touch on what he says is Party B's assignment of the unregistered figurative mark from Mr Carruthers/his companies.

PROCEDURAL ISSUES

31. Two case-management conferences took place before me during the course of the proceedings, dealing with a variety of issues. I have also issued a number of directions letters to the parties. The issues worth recording here are:

Mediation

32. Right from the outset, I encouraged the parties to mediate this dispute to a resolution. During the first case-management conference (CMC 1) that took place on 25 February 2019, I summed up in my post-CMC letter as follows:

“I highlighted the usefulness of mediation as providing a mechanism to resolve disputes in a cost effective and timely manner. However, after hearing the observations made by the respective representatives, I am not convinced that mediation will be useful here. Therefore, whilst I remind the parties of its availability, I will not direct that mediation takes place.”

33. My lack of conviction, and why I did not make a direction specifically ordering mediation, was down to the approach taken by the parties and the very entrenched view of matters that had been taken, with little scope for compromise. However, I

remain of the view that the proceedings could sensibly have been mediated by the parties to some form of resolution.

Without prejudice correspondence

34. Various documents filed in evidence contained material that was without prejudice in nature. The Tribunal directed that such references should be struck from the evidence. By the time of CMC 1, such directions had been complied with.

Partnership issues

35. Party B have made various points throughout the proceedings regarding the nature of the partnership that Party A says it comprises (in the cancellation proceedings), the disconnect that arises because the 6 partners are not identified as such in their trade mark application, and the impact of the unfortunate death during the course of proceedings of one of those individuals, Mr Ash. I dealt with this issue at CMC 1, with my decision being summed up as follows:

“Mr Carruthers suggested that this was an important issue because claims had been made in the cancellation proceedings by a member of a partnership, a partnership which no longer existed due to the subsequent death of Mr Ash. He further highlighted that there was an inconsistency between the cancellation proceedings (brought by the band as a partnership) and the band’s trade mark application (made by individuals).

I need not make any formal directions in relation to this issue. This is because the cancellation was brought by the 6 members of the band who identified themselves as a partnership at that point in time. That one of those 6 has since died, does not mean that the whole claim is flawed. Further, a claim of bad faith requires no particular form of standing and it would, for example, be permissible for 1 member of the partnership to pursue a cancellation on such grounds. No one has requested that they be substituted as a party to the proceedings in Mr Ash’s stead, this means that the applicant (for cancellation) comprises the 5 remaining identified persons (as a partnership), who have confirmed that they

are jointly and severally liable for any costs stemming from both sets of proceedings.

In relation to the opposition proceedings, the omission of any indication that the 6 individuals were a partnership is not something on which I need to intervene. Any impact on the substance of the proceedings will be considered when a substantive decision is prepared. That said, if Party A wishes to file a TM21 (a correction of a name, which would normally also require a supporting witness statement) to record that the individuals named were a partnership, that is a matter for them. It is also up to Party A to decide if they wish to file a Form TM16 (a form to change the ownership of a mark) to record that Mr Ash is no longer a joint owner/partner).

It should be noted (by Mr Carruthers in particular) that the recordal, or otherwise, of any Form TM21 and/or TM16 is a matter between Party A and the Registrar; it is not something that a third party (including Party B) have a role to oppose.”

36. There are three things to briefly note in relation to the above:

- i) Party A did not file a TM21 to change the status of the applicants (for their trade mark) to a partnership;
- ii) Party A did file a TM16 to remove Mr Ash from the application, and;
- iii) My point about the standing of Party A to make a claim based on section 3(6) was applicable at that time (and still is), that being the only ground being pursued at that point in time.

37. Following this, further observations were received from Party B about my decision/directions at CMC 1, to which I responded in a directions letter dated 7 March 2019:

“Mr Carruthers has raised further points and sought further clarification on the partnership issue and the impact of Mr Ash’s death. I do not intend to further debate the point. I have issued my directions and what reasoning I consider adequate. If and when a substantive decision is issued, and if it is adverse to Party B, an appeal can be made if Party B is not satisfied.”

38. I do not intend to explore this procedural matter further. I add one point though. The addition of a further ground of invalidation under section 5(4)(a) (see paragraph 63 below) changes matters somewhat because the goodwill relied upon under that claim must be owned by the claimant. I return to this matter when I deal with the substantive grounds.

Disclosure request made by Party B

39. Party B made a very lengthy request for disclosure, a matter which I dealt with at CMC 1. My decision/direction was given as follows:

“Mr Carruthers, on behalf of Party B, made a lengthy request for disclosure (his email of 13 February 2019 refers). I already indicated at the CMC that some of those requests were misguided, for example, the requested disclosure of affidavits that did not exist. Further, given my comments about the death of Mr Ash set out above, the disclosure requests, in so far as they go to documents connected with such an issue, is refused.

In relation to the remaining requests, and save for one area I come on to, I hereby refuse the request for disclosure. I do so because the documents sought are not sufficiently germane to the substantive issues to make their disclosure proportionate, and/or that the request constitutes an inappropriate fishing exercise. I will, though, allow the disclosure request in relation to the recording/licence agreements referred to in paragraph 1 of Mr Carruthers’s email because it is fair to allow Party B to see the full agreements, as opposed to the partial agreements provided thus far.

.....

.....Party A should provide to Party B the documents specifically referred to in Mr Carruthers' email dated 13 February 2019 (at point 1, sub points 1-5). They should make reasonable efforts to obtain and provide such documents. I hereby set a deadline of 26 March 2019 to do so.”

40. Put simply, the requests lacked specificity in terms of what they would bring to the table to assist the Tribunal in making a fair and reasonable decision; such lack of specificity and proper direction is symptomatic of how Party B has addressed some of the procedural matters. That said, the one area in which disclosure was directed (Ms Bradshaw's evidence) was simply to reflect that it is always better to see the full documents being relied upon as opposed to partial extracts. I stress, though, that the direction was not made with any real sense that there was a smoking gun behind Ms Bradshaw only providing a partial extract.

41. After further correspondence from Party A, indicating that Ms Bradshaw would not be able to comply with my direction, I responded as follows in a directions letter issued on 5 April 2019:

“It is noted that Ms Bradshaw will not provide to Party A the documents upon which I directed if they are to be used for the purpose of disclosure in these proceedings, as she is not satisfied that they are germane. Whilst this is noted, the matter was discussed at the CMC and a formal direction issued. I have no intention of varying my direction or attempting to explain to Ms Bradshaw why the direction was made, beyond repeating my decision that in the interests of fairness the other party should be entitled to see the full content of the documents relied upon rather than the partial extracts provided.

..... I will give a final period expiring on 12 April 2019 to comply with the above direction.

.....

If Party A does not comply with the disclosure direction then the above evidence in reply deadline still stands. In terms of the consequences of non-compliance,

I will take submissions at any final hearing (or written submissions if neither party elects to be heard) as to what those consequences should be, including what weight ought to be given to the redacted documents thus filed.”

42. Ms Bradshaw did not comply. I return later to the impact of non-compliance.

Disclosure request from Party A

43. Party A made a disclosure request in relation to documents which proved that Party B had properly assigned to it the goodwill on which it relied in defence. Although Party B had indicated in its (invalidation) claim that it owned goodwill due to trading activities since 2005, the position had developed by the time of CMC 1, from which it was clear (and as stated earlier) that such activities were undertaken by a claimed predecessor in title. I dealt with the matter at CMC 1, with my decision communicated as follows:

“On 16 August 2018, Party A requested disclosure of documents relating to the claimed assignment of goodwill from Mr Carruthers (or his companies) to Party B. Also requested were documents showing what role Mr Carruthers plays in Party B (with Party A assuming he was just an employee) so that it can be understood what relationship he has with the directors of Party B.

Since the CMC, I have had sight of a letter from Party A acknowledging that Mr Carruthers has, since the disclosure request was made, become a director of Party B. It is also stated that the document provided by Party B to meet the disclosure request with regard to assignment of goodwill is not sufficient to prove the assignment and that, consequently, further disclosure should be directed. The matter was only briefly discussed at the CMC because Mr Carruthers had to leave to catch a train. However, I have considered the matter fully. No directions are required in relation to this issue. Party B claims to own the goodwill associated with the sign upon which it relies. It is a matter for the tribunal to decide if the evidence it has filed establishes that fact. Party A’s position that the assignment has not been proven is noted and will be taken into account when a substantive decision is issued.

44. It should be noted that evidence was, in any event, subsequently filed showing the purported assignment.

Impact of court proceedings

45. By the time of CMC 1, Party B had threatened Party A (and various of its witnesses, including Mr Allen) with court proceedings. The following summary from CMC 1 provides some context:

“Mr Carruthers mentioned on a number of occasions that some form of claim before the High Court had been drafted and was to be made against the parties to this dispute, others, and also Mr Allen. I highlighted the capacity of the tribunal to transfer its cancellation proceedings to the High Court, if the issues overlapped; obviously, this can only be considered if claims are made, and will depend on their nature. In the list of directions given below, Party B is directed to inform the tribunal if High Court proceedings are indeed launched.”

46. The court proceedings were duly lodged. In response, I issued the following in a directions letter dated 7 March 2019:

“The claims made in the High Court have been noted. I do not at this stage intend to make any directions in relation to this, but if the proceedings are defended and subsequently pursued, I will consider at that point whether to transfer the cancellation proceedings before this Tribunal to the Court and/or whether to stay the proceedings (including the opposition).

.....

At the CMC, Mr Allen stated that if High Court claims were made against him he would need to withdraw his representation from the proceedings before this Tribunal. If Mr Allen does intend to withdraw his representation, he should do so formally in writing. The new representative details will need to be provided on Form TM33P (for the cancellation proceedings launched by Party A) and a TM33 (for the

trade mark application filed by Party A). No fee is required for the filing of these forms.”

47. Mr Allen was named as a defendant in the court proceedings, but, despite threatening to do so, he did not withdraw from representing Party A.

48. Party A subsequently made an application for the strike-out of the court claims. After receiving further correspondence from the parties, I issued the follow in a directions letter dated 10 May 2019:

“Party B has lodged two claims. Party A has submitted a claim, in the first instance, that Party B’s claims be struck out. Given the uncertainty of what, if any, claim the Court will pursue, I do not consider it appropriate to countenance a transfer of the validity claims launched here to the Court, or to suspend the claims made here. However, the Hearing Officer still wishes to be kept up-to-date as to the status of the Court proceedings and may revisit that direction if appropriate.”

49. At CMC 2 (which took place on 2 July 2019), I was advised that no hearing date had been set to deal with the respective claims. Given it was not clear at that stage what claims, if any, were to be pursued before the Court, there was no benefit in transferring the cancellation proceedings to the Court, or to otherwise suspend matters here. I was advised at the substantive hearing that the Court was due to hear the strike-out application on 31 October 2019. I was asked by the parties to issue my decision before this date so that it could be reflected upon in Court.

Letters of intimidation

50. The issue of Party B’s court claims first came to the attention of the Tribunal due to the individuals making up Party A, and various of their witnesses, receiving “NOTICE[S] BEFORE ACTION”, letters which Party A considered to be an attempt to intimidate their witnesses in some way. I dealt with this at CMC 1 as follows:

“Mr Allen has brought to the attention of the tribunal various letters sent by Party B/Mr Carruthers in the form of NOTICE BEFORE ACTION (which Mr Carruthers explained at the CMC related to the impending High Court claims). Mr Allen considered them to be intimidating to himself and to those who received them. Mr Carruthers stated that no further letters were to be issued and they were only sent as part of his duty to issue a letter before action.

.....

There is no formal direction to make, or action to take, at this stage of the proceedings. However, at the conclusion of the proceedings (after the tribunal's decision is issued) I may invite submissions as to whether the letters sent constitute, having regard to all the circumstances that were/are in play, unreasonable behaviour that should be reflected in an off-scale award of costs, and/or, whether I should refer the matter to the Crown Prosecution Service as a potential attempt to pervert the course of justice by intimidating witnesses/parties.”

51. Party A repeated their concerns on a number of occasions. I responded in a directions letter issued on 7 March 2019 saying:

“In relation to any points regarding the claimed intimidation, beyond what I have already indicated on 4 March, I have no further comment to make. It is for Party A to consider what other legal recourse may be open to them.”

and in a further directions letter issued on 10 May 2019 saying:

“Whilst further reference to this has been made by Party A, and as previously directed, the Hearing Officer will only consider this issue (and what, if any, referral needs to be made) once the proceedings have been disposed of. What Party A does of its own motion is entirely up to it.”

52. I stand by what I said above, and I will make no further observations here. I will, though, at the end of this decision provide a mechanism to receive submissions on

costs. In relation to the referral, I will only invite submissions once the court has determined the strike-out applications that are before it.

Late/further evidence

53. By the time of CMC 1, the parties had been through what would ordinarily be classed as the evidence rounds – Party A had filed its evidence in chief, Party B then followed, with Party A having an opportunity to reply. However, at CMC 1, Party B submitted that because Party A had (in reply) filed further witness evidence it should be able to reply directly to that. I agreed. However, before Party B did so, Party A filed more evidence. I dealt with this in a directions letter issued on 10 May 2019:

“Party B was set until 26 April to file reply evidence, but in advance of this (on 16 April) Party A filed further evidence, which adds to the overall evidential picture and for which Party A explained its lateness. Party B then met its deadline for reply evidence which, it appears, is also in reply to Party B’s recent evidence. The Hearing Officer’s direction is to accept all the evidence that has been filed. He stresses, though, that the evidence rounds are now considered closed. If either Party believes it necessary to put any further evidence before the Tribunal, it should not do so unless it has first sought leave, explaining what the evidence is, why it is important to have it admitted, what it adds to the case, and why it could not have been filed earlier.”

54. Whilst it is not ideal to continually build one’s case, I came to the above view given that there was some justification for the lateness of the evidence, and, further, in an attempt to get all the available evidence to hand on which a just and fair decision could be reached; it was also an attempt to draw a line under evidential matters.

Requests for cross-examination

55. Party B requested that each and every person who had given evidence on behalf of Party A should be cross-examined. I dealt with this first in a directions letter issued on 10 May 2019:

“Party B has requested an opportunity to cross-examine all of Party A’s witnesses. In the Tribunal’s proceedings, cross-examination is neither an automatic right or a default position. Nevertheless, the Hearing Officer still has discretion to direct that cross-examination takes place, if doing so would be useful and proportionate to the matters that need determination. In deciding whether to direct cross examination of any witness, the Tribunal requires the following information before directions are issued:

Give reasons why cross-examination of each witness is requested;

Set out the specific issues to which cross-examination would, if allowed, be directed;

Explain the relevance of those issues to the matters to be decided;

Give an estimate of the time any cross-examination is expected to take.”

56. Party B did little to provide the above information, but, nevertheless, the matter was discussed at CMC 2. In my post-CMC letter to the parties, I summarised the discussion and decision thus:

“Mr Carruthers focused very much on the formation of the band in the 1960s and, also, the existence of the claimed partnership. He also suggested that documents may have been forged. He wanted to get to the bottom of things. Mr Allen submitted that the request was misconceived, that the evidence was clear, that what happened in the 1960s was not pertinent because this case hinged on the conduct of Party B.

My direction is that all the requests for cross examination are refused. The application lacked specificity and, I share Mr Allen’s view that the much of what was submitted by Party B was not particularly germane to the primary issue to be decided. I will, of course, say more in any final decision, including dealing with the accusations of forgery.”

57. To the extent that it is relevant, I will come back to the issue of forgery. In terms of the cross-examination request, the failure of Party B to comply with the directions to explain why each of the witnesses should attend, together with the scant and broad-brush way in which the applications to cross-examine were put, means that I am satisfied with the above as providing adequate reason why cross-examination was refused. I highlight again that much of the reasoning put forward was based on the creation of the name in 1962, which, for reasons that I set out later, does not really matter.

Security for costs application from Party A

58. Party A sought security for costs from Party B. I dealt with the matter at CMC 2. The following directions were given in my post-CMC letter to the parties:

“Mr Allen’s submissions focused on the absence of financial assets in the last reported accounts of Party B, together with the fact that if Party A were to win the proceedings, Party B will have been found to have acted in bad faith (which amounts to dishonesty), and, if this is so, it is probable that such dishonesty would lead to not honouring an award of costs. In writing he referred to untruths that have been stated by Mr Davies (the person who apparently produced the more up-to date management accounts) when the original claims were filed, and that the more up to date accounts are not signed.

Mr Carruthers submissions focused on the historic nature of the last reported accounts and that Party B is now in a healthy position. He said that simply because a bad faith claim had been made (which is disputed) it would be wrong to make a party provide security of costs as this could prevent a party from accessing justice. In writing, he highlighted recent media activity put out by Party A and that it now has a Crowd Funding page, which he said should have been brought to the attention of myself.

My direction is that, subject to Party B providing (within 14 days) a short witness statement from Mr Davies confirming that these are the accounts collated by him of Party B’s current financial position, the request for security of costs will

be refused. I come to this view because I would be satisfied that the financial position of Party B is stable. In relation to the “won’t pay” argument, there is, in my view, not a strong enough picture to make that finding and, in any event, Party A, if they were to receive an award in their favour, would be able to pursue that debt through the Courts.”

59. Subsequent to these directions, a witness statement was received from Mr Davies. I was satisfied with its content and I could see no reason why the application for security should succeed.

Further evidence at the hearing

60. At the substantive hearing, Party B sought the introduction of a further witness statement from Mr Davies. The reasons given for its introduction stemmed from comments made in a Crowdfunding campaign (in support of Party A) by members of the public – Party B said it wanted to put the record straight. After hearing submissions on this basis, I indicated to Mr Panayi that this was no good reason to admit the evidence because I had not had sight of the Crowdfunding comments, nor did I intend to look at them. He did, though, press for some of the evidence (paragraphs 37-38 of the witness statement) to be taken into account because the content went to a crucial point between the parties in terms of Party B’s (specifically Mr Davies’) conversations with certain band members after a concert at the venue Koko (in April 2015) about registering the trade mark.

61. Mr Allen had no objection to any of the evidence coming in, in fact, he encouraged it as it contained some of the material he had earlier had to remove on the basis of it being without prejudice. Given there was no objection, and given that it might potentially assist the Tribunal, I allowed the evidence to be considered, but only to the extent of the evidence contained in paragraphs 37-38 (which did not include without prejudice material). Later in the hearing, Mr Panayi relied heavily on those paragraphs, highlighting that none of the band members had challenged Party B’s version of events. I found this an odd submission because the evidence had only just been admitted, and thus could not have been challenged earlier. Therefore, given that Mr Panayi wished to rely on this, and the absence of challenge, I allowed the band

members with whom the conversations allegedly took place to comment upon the evidence. My direction was as follows:

“By 3 October 2019, Party A may file further evidence if any of the persons mentioned in paragraphs 37-38 of Party B’s further evidence wish to comment on the statements made by Mr Davies in those paragraphs. No further evidence beyond this should be filed.”

62. Evidence was filed by:

- i) Mr Smith (one of the band members) – he states that he does not know what Mr Davies looks like and has no recollection of meeting him at, or after, the concert at the Koko venue regarding Party B registering the name – he adds that he would not have agreed to this anyway. He states that the only person he recalls being at Koko was Mr Carruthers and they did not discuss such matters.
- ii) Mr Slater – focusing only on the issue about which I directed that evidence could be filed, I note that Mr Slater states that he has never discussed or agreed with Mr Davies Party B’s registration of the name, either at the Koko concert or anywhere else.
- iii) Mr Innes (another band member) – again, focusing only on the evidence I directed could be filed, Mr Innes states that he has no recollection of meeting Mr Davies, or what he looks like – he accepts that he may have been introduced briefly, but does not recall when or where. He categorically denies that he agreed anything to do with the name or its registration – he says he would not have been able to agree such a thing without the other band members’ agreement as it would have stopped the band from using its name.
- iv) Mr Nowell (another band member) – he states that he has no recollection of speaking to, or meeting, Mr Davies about the ownership of trade marks. If there was a casual chat (which he says nobody can remember) then this

stands for nothing legally. At the Koko concert, he was focused on packing up and heading home.

- v) Mr Spear (another band member) – he was not referred to as being part of the discussion with Mr Davies, thus, the direction I gave regarding further evidence does not apply to him, so I do not take his evidence into account. In any event, he says little more than confirm that he was not part of this concert and so was not there.

Adding a passing-claim to the invalidly case

63. After considering a skeleton argument filed by Mr Allen on behalf of Party A, it was clear and apparent that they were arguing the matter not just on bad faith grounds (section 3(6)), but also on passing-off grounds (section 5(4)(a)). I highlighted to Mr Allen that only section 3(6) had been originally pleaded, however, he asked that I consider allowing the additional claim to also be considered. Mr Panayi objected given the lateness of such an addition.

64. Although clearly very late in the day, and although there was no good reason for the lateness of the claim (beyond Party A not having a legally qualified representative), I allowed section 5(4)(a) to be considered as a ground for invalidation. I did so because it was clear from the pleadings and evidence filed thus far that the existence of goodwill, and who owned it, was a central plank running through everything. I saw absolutely no prejudice to Party B because all their evidence addressed goodwill, as did much of Mr Panayi's skeleton argument. In an attempt to avoid elongating and complicating the proceedings further, I did not require an amended statement of case because Party A has already claimed that they own the goodwill associated with the name of the band The Bonzo Dog Doo Dah Band as a result of their activities since 1962; Party B has already denied that and provided evidence supporting its own claim to own a relevant goodwill under the name. Therefore, the addition of the s.5(4)(a) ground is purely a matter of law. However, after giving my decision and discussing the matter with Mr Panayi, I did allow an opportunity to file written submissions directed solely at the passing-off ground, to the extent that he could not provide them on the day. My subsequent direction read:

“By 3 October 2019, Party B may file supplementary written submissions directed only at the section 5(4)(a) ground of cancellation. Submissions already made should not be repeated.”

65. In response, Mr Carruthers provided his 4th witness statement. It contains a mixture of evidence and submission. The witness statement and exhibits combined run to 79 pages. It is clear that before providing this witness statement Mr Carruthers obtained the transcript of the hearing. This is perfectly permissible in and of itself. However, one cannot use that to make further reply submissions after the hearing has concluded that ought to have been made on the day. Mr Panayi had an opportunity to reply on the day, which he took. The same applies to the evidence provided with the witness statement (for which no leave has been given), which includes a whole new line of argument that there was in fact a further early name of the band which was racist in manner. Thus, for these reasons, I will ignore and have no regard to most of what Mr Carruthers has said in his fourth statement. I also note that he asks for a further hearing in relation to the section 5(4)(a) ground at which he can cross-examine each and every one of Party A’s witnesses. This is not a course of action that is open to Party B given that I gave my decision on the introduction of the ground on the day – it cannot be revisited. I nevertheless acknowledge that there were some submissions within the witness statement which do go more closely towards the passing-off ground which I will take into account. For clarity, I note (and will take into account) the submissions to the extent that they deal with:

- That Party B is not a promoter, it is a management company;
- That Party B has used the mark since 2006, which is said to be relevant because Party A has claimed that it has used the mark, not that someone else has used it with their consent;
- Party A is not a partnership as they claim, they are nothing more than a loose unincorporated association;

- Party A has offered no explanation as to why Mr Kerr has been involved in every band activity since 2006;
- All trading activities since 2006 have been under the control of Party B (and its predecessors), so Party A cannot claim to be the proprietor who can exercise the right to bring a passing-off claim;
- That both parties submit that there has been honest concurrent use by Party B and others (he highlights Party A's acceptance that agreements were entered into with Mr Carruthers and his companies to use the name);
- That Party A has not been active since 1971;
- That Party B's new use since 2006 has a different distinctive character – the nature of the goods and services provided being different;
- There has been acquiescence by Party A to the use of the name by Party B since 2006.

THE INVALIDATION CLAIM AGAINST PARTY B's TRADE MARK

66. The grounds to be considered involve both bad faith and passing-off. The legal tests clearly differ, but it is necessary in respect of both grounds to consider the factual position at various points in time. Therefore, before coming to the grounds in detail, I will run through the evidence, but I will split the chronology to differentiate between the activities of the band pre-2005 (prior to Mr Carruthers'/his companies/Party B's involvement) and the post-2005 period.

The bands formation and activities up until 2005

67. There is no dispute that the origins of the band date to the 1960s. Mr Carruthers, who is the co-author of a book entitled "Jollity Farm – The Bonzo Dog Doo-Dah Band in Their Own Words", says that the position is as follows:

- In September 1962 a large ensemble of musicians was formed by Vivian Stanshall; he adds that Rodney Slater was with him when the idea was conceived. The name given to this ensemble was The Bonzo Dog Dada Band. He says that none of the other individuals that comprise Party A were part of the meeting that discussed the formation of this group. This group performed until 1963.
- After a hiatus, a new ensemble was formed in 1963. Mr Stanshall suggested that the name be changed to The Bonzo Dog Doo-Dah Band which was apparently accepted by popular consent. Between 1963 and 1965 it was a loose and large ensemble of musicians, but by 1965 it had slimmed down to 9 members including Bob Kerr, the individuals who make up Party A and, presumably, Mr Stanshall (it is not clear who the ninth member was), who then began a recording career in 1966, releasing two singles.
- In 1967, Bob Kerr left and Mr Ash was fired. Mr Nowell was fired in 1968. Also in 1968, The Bonzo Dog Doo-Dah band ceased recording and performing and the name was dormant for the next 38 years (until 2006).
- In late 1968, five of the former members of the above (which, on the evidence, would be: Stanshall, Spears, Slater, Smith & Innes) formed the “Bonzo Dog Band”. Mr Stanshall was their manager and frontman. Mr Carruthers says that they recorded four albums, the covers of which are provided in Exhibit 8 and which use the name BONZO DOG BAND. This band split in 1972. The band briefly reformed in 1992 to record a single. Mr Stanshall died in a fire in 1995.

68. It is clear from the above that Mr Carruthers considers that there were three distinct bands: The Bonzo Dog Dada Band, The Bonzo Dog Doo-Dah Band, and Bonzo Dog Band. However, the position evidenced by Party A does not reflect such a clear distinction, which is reflective of the bands being one and the same, albeit with there being some variant use of names (particularly as between The Bonzo Dog Doo-Dah Band and Bonzo Dog Band). I note the following evidence from Party A:

- Mr Parkinson states that he was a founding member of the band in 1962, that it was initially nameless, and that any claim that its first name was the Bonzo Dog Dada Band is a misunderstanding. He accepts that, at first, the band did not have a stable membership, but, by 1967, the membership had stabilised which was when they created their original sound. He says that sometimes the name was unofficially shortened by DJs and promoters. Mr Parkinson does not say when he left the band, but he makes no suggestion that he is currently part of it.
- Mr Slater states that he, along with Mr Stanshall, created the name in 1962. He makes no mention of The Bonzo Dog Dada Band, or the shortening to Bonzo Dog Band. He states that by 1965 the band had a settled line-up consisting of the 6 individuals who make up Party A, plus Mr Stanshall. He does, though, add that Mr Kerr was an ex-member who resigned in 1966.

69. Ms Bradshaw refers to the recording agreements with the band. The first she provides is from 1967 with the six individuals that make up Party A, plus Mr Stanshall. She says that later agreements were made by way of amendment to reflect that Mr Ash and Mr Nowell had left the band. The agreements are dated:

- 14 July 1967 – the band are identified as comprising Party A plus Mr Stanshall; and that they are professionally known as The Bonzo Dog Doo-Dah Band.
- 19 July 1968 – the band are identified as comprising: Innes, Slater, Smith, Spear and Stanshall; again, they are professionally known as The Bonzo Dog Doo-Dah Band.
- 1971 (exact date not specified) – the band are identified as the same five individuals as above.
- Although no agreement is provided, Ms Bradshaw does give evidence that the band released 2 singles in 1966 under the Parlophone label, part of EMI.

70. I should add that whilst Ms Bradshaw did not comply with the direction I gave in that she should disclose the full agreements, I am prepared to give her evidence some weight in at least identifying who was in the band at the given points in time. In doing so, I bear in mind the accusation of forgery that Mr Carruthers has made on the basis of, for example, that the signature sheet for the 1971 agreement appears to match exactly the signature sheet of the 1967 agreement. Whilst I accept that no explanation has been given for this inconsistency, the front pages of the agreements clearly say who the contracting persons were. Further, the composition of the band as indicated on these agreements matches evidence given elsewhere.

71. In his first witness statement, Mr Allen provides a significant amount of press cuttings about the band dating from 1970 to 2005. It is fair to say that there is a mixture of use between The Bonzo Dog Doo-Dah Band, Bonzo Dog Band and, also, colloquial use of just “The Bonzos”/“Bonzos”. Having said that, I think it fair to say that uses of the Bonzo Dog Band feature most heavily.

72. A number of the witnesses mention the recordings created by the band. Prior to 2005 there appear to have been 5 studio albums:

- i) Gorilla in 1967;
- ii) The Doughnut in Granny’s Greenhouse in 1968;
- iii) Keynsham in 1969;
- iv) Tadpoles in 1969;
- v) Let’s Make Up and Be Friendly in 1972.

73. The first album was put out under the full name The Bonzo Dog Doo-Dah Band, the subsequent releases were under the name Bonzo Dog Band. Subsequent greatest hits or compilation albums were also published, some under the full name, some under the abbreviated name. For example, in 1992 there was a release called Bonzo Dog Band Cornology, and, in 2001, an album entitled New Tricks by The Bonzo Dog Doo-Dah Band.

74. I also note that in his first witness statement Mr Allen states that the band disbanded as a performing unit in 1970 before reuniting in 1971 to make the album

“Let’s Make Up and Be Friendly” and, again in 1992, for a single called “No Matter Who You Vote for the Government Always Gets In” (a print of the cover of this single can be seen in Ms Bradshaw’s evidence which shows the name of the band as The Bonzo Dog Doo Dah Band). In his second witness statement, Mr Allen provides more about the discography of the band from which it is clear that in respect of the first studio album, the band featured Party A plus Mr Stanshall; the subsequent studio albums did not feature Mr Ash or Mr Nowell, which corroborates the recording agreements provided by Ms Bradshaw. In his third witness statement Mr Allen provides a press release from 1967 which notes that by that time only two original members of the band remained (Mr Stanshall and Mr Slater) with the rest of the “cast” being the other five individuals of Party A.

75. Mr Welch records some of the band’s history too, although he is under the impression that the name originally contained DADA not DOO-DAH. He also describes that by the late 60s the full name proved to be too long which is why a shortened version was used – he adds that on the Keynsham album the words Bonzo Dog Dada Band, Bonzo Dog Doo-Dah Band and even Bonzo Dog Trouser Experience were crossed out leaving Bonzo Dog Band. He says, regardless of this, the full name was at the core of their work. To illustrate, the front of the Keynsham album looked like this:



76. In his evidence, Mr Glasson refers to various other bands he was part of with musicians who have been members of The Bonzo Dog Doo-Dah Band, including The Whoopee Band with Bob Kerr, and bands he has been in with Mr Smith and Mr Nowell. He also refers to other activities with Mr Spear and Mr Ash.

77. Mr Slater states that the band's initial goodwill will have been created from their activities between 1965 and 1970, but, despite ceasing to exist as a fulltime day to day operation, the core members would remain a partnership in so far as the control of the band's name was concerned, the core members being Party A plus Mr Stanshall. He makes no mention of Mr Smith and Mr Nowell leaving or re-joining.

78. The core members (Party A plus Mr Stanshall) are mentioned by Mr Fry and Mr Edmondson. They are also mentioned by Mr Barbour who refers to the lyrics (as some other witnesses also do) of a 1967 song entitled "The intro and the outro" which mentions them all by name. However, neither Mr Fry or Mr Edmondson mention Mr Ash or Mr Nowell leaving at any point in time.

79. Mr Kaufman says he managed the band between 1997 and 2002, specifically mentioning the individuals in Party A (plus two "side" musicians). However, such management is described as being in the form of updating royalty structures for what he describes as the original band members.

Initial findings based on the pre-2005 evidence

80. The following summary sets out my view on matters:

- i) The band was formed in September 1962 by Mr Stanshall, along with Mr Slater.
- ii) The band may have first gone by the name The Bonzo Dog Dada Band. Although this goes against the evidence of Mr Parkinson (who says he was a founding member), this finding is consistent with i) the evidence of a number of other witnesses (including some of those for Party A) and, ii) that

on the cover of the Keynsham album a version of the name containing the word Dada was struck-through.

- iii) The original band had no settled line-up, with a large number of musicians contributing to it.
- iv) In 1963 the band, at the suggestion of Mr Stanshall, changed its name to The Bonzo Dog Doo-Dah Band. I regard this as an evolution of the band rather than a new band being formed.
- v) By 1965 the band members were less in number and more settled – all of the individuals that make up Party A were in the band, plus Mr Stanshall and Mr Kerr.
- vi) In 1966 two singles were released which would have featured Party A, Mr Stanshall and Mr Kerr (there is no challenge to Mr Carruthers' evidence of Mr Kerr's involvement).
- vii) Mr Kerr left the band in either 1967 (Mr Carruthers' evidence) or 1966 (Mr Slater's evidence), but either way it must have been before the band signed the recording contract set out below.
- viii) In July 1967, a new recording contract was made, at this time the band featured Party A plus Mr Stanshall.
- ix) Subsequently in 1967, the band released its first album, Gorilla. This featured Party A, plus Mr Stanshall. The cover featured the name The Bonzo Dog Doo-Dah Band.
- x) Mr Ash left the band in 1967, presumably after the recording of the first album.
- xi) Mr Nowell left the band in 1968.
- xii) In July 1968, the recording contract was revised – the band at this time featured: Stanshall, Slater, Smith, Spear and Innes.

- xiii) Subsequent albums were issued using the name Bonzo Dog Band, featuring the five individuals identified above. I regard this as a further evolution of the band rather than a new band being formed.
- xiv) Subsequent compilation albums have been issued, some featuring the full name, some the shortened name.
- xv) A large number of press articles have been published some (the most) featuring the Bonzo Dog Band, others the full name.
- xvi) There is no evidence that Mr Smith or Mr Ash re-joined the band.

Post-2005 activities

81. Mr Carruthers has provided a large amount of evidence in relation to the post-2005 activities, from which I note:

- He says that he decided to form a new version of the Bonzo Dog Doo-Dah Band in order to promote a 40th anniversary concert in celebration of their first single from 1966. He says that the death of Mr Stanshall in 1995 meant that a completely new version of the band had to be formed. He decided to employ as many of the original artists who recorded with the band as he could find. He was able to recruit the 6 members of Party A, plus Bob Kerr, who he says was on the original single. Celebrities (including Mr Fry and Mr Edmondson) were to handle the vocal duties instead of Mr Stanshall. Other musicians were employed to “provide a solid musical platform”. He says he created the figurative mark to identify the concert and accompanying recordings and TV programmes.
- The inaugural concert took place in the Astoria in January 2006. It was filmed for television release (it was subsequently screened on BBC4 after the event).
- An album entitled “Wrestle Poodles and Win” was also released in 2006 which uses the figurative mark; later evidence from Mr Allen shows that Party A plus Bob Kerr are the band personnel in relation to this live album.

- Others uses of the figurative mark include:
 - Use on posters promoting the Astoria concert and a subsequent 2006 tour;
 - Use in relation to the film of the concert, a DVD and the live album, Wrestle Poodles and Win;
 - A studio album entitled “Pour L’amour Des Chien” in 2007, evidence from Mr Allen lists Party A plus Mr Kerr as the band personnel;
 - A further Astoria concert in 2007;
 - A DVD collection in 2008;
 - Use on t-shirts in 2006, 2007, 2015 & 2016;
 - The book “Jollity Farm”, as referred to earlier;
 - Concert programmes (2006, 2015, 2016);
 - Use in relation to a 50th anniversary concert in the venue Koko in April 2015 (plus an associated film and live album);
 - Christmas concerts in Bristol and at the O2 in 2015;
 - A compilation album in 2015;
 - A studio album in 2016;
 - Eight concerts in 2016;
 - A further recording in 2016.

- Mr Carruthers says he has invested over 350k in such business activities; he does not say how much he has earned from them.

- Mr Carruthers says that there was no fixed line-up for the band, evidenced by Mr Spear withdrawing from activities in 2008 and Mr Innes in the autumn of 2015.

- Mr Carruthers says that in 2015, Party B purchased the figurative mark and goodwill in the name “The Bonzo Dog Doo-Dah Band” and it organised a concert at the Koko venue to take place on 17 April 2015. Five members of Party A (everyone except Mr Spear) plus Bob Kerr were employed to appear; a live recording and TV show were to follow. Other musicians (the ensemble reached 20 in all) were also employed to perform. Following this success,

Christmas concerts in Bristol and the O2 took place in December 2015. He says the artists were mostly paid by cheque. The cheques were issued by Party B (Exhibit 3 provides evidence of some of the cheques, including some issued to members of Party A).

- In the Autumn of 2015 Neil Innes informed Mr Carruthers that he did not wish to be employed on future concerts (after the O2 show in Christmas that year) and that he did not assert any rights in the name.
- In April 2016, he informed the performers that Party B would be arranging a 50th anniversary tour in 2017. He says that for a tour in 2016 he employed Mr Kerr, Mr Slater, Mr Nowell, Mr Smith and Mr Ash, plus a celebrity called Tim Brooke Taylor. He says they were all contracted as individuals.

82. From the various exhibits provided with Mr Carruthers' first witness statement, I note the following:

- A cover for the 40th Anniversary Collection DVD identifies the concert as "Featuring Original Members [Party A plus Mr Kerr]" of the band, plus special guests [Mr Fry, Mr Edmondson and others];
- The same original members (plus a special guest, Phil Jupitas) are listed for a concert in Ipswich in November 2006.
- On a promotional t-shirt, the band name is given (in figurative form) with an indication below that there are special guests who will appear.
- Covers of the album from 2007 are provided, which list the band as Party A plus Mr Kerr, but also Mr Fry, Mr Edmondson and Mr Jupitas. I note, though, that the cover further adds "featuring original members" [Party A plus Bob Kerr] with "Shiny new Millennium Bonzos" [Mr Fry et al].
- The cover of the Jollity Farm book published in 2009, which features recollections of original members [Party A plus Mr Kerr].

- Promotional material for the Koko concert in April 2015 which mentions Party A [minus Mr Ash and Mr Spear] plus Mr Kerr. The same names are identified on the live album said to have been released in November 2015.
- The same names as above are given on the flyers for the Christmas concerts in December 2015.
- A new anthology from 2016 by “The Bonzo Dog Doo-Dah Band plus Guests”. The credits differentiate between the band in 2006 [Party A plus Mr Kerr] and that in 2016 [Nowell, Kerr, Slater, Smith, Ash, plus Mr Glasson, Mr Livesey, Mr Sked and Mr Caitlin Birch].
- A letter dated 15 April 2015 from Mr Carruthers to Party B purportedly assigning all rights and goodwill in the business and name “The Bonzo Dog Doo-Dah Band” to Party B. It is stated in this letter that the figurative mark identifies an unregistered trade mark in the business of the band, the activities of which he (Mr Carruthers) has used, or which has been used under license by companies controlled by him.

83. In his second witness statement, Mr Carruthers states that he was the manager of the band from 2005 onwards, initially through his company Stratford Music Consultancy Ltd (“Stratford”), but more recently through Party B. He states that he has been the producer of everything the band has done since 2005. He states the decision to register the figurative mark was made in 2015 and was discussed with Mr Innes. He states the registration was made to protect the goodwill built up in the figurative mark. He states that Party B has not sought to register the unregistered mark (I assume he means the name of the band as opposed to the figurative mark) as other parties are using it and will no doubt continue to do so.

84. Rehearsal and payment schedules are provided in Exhibit RKC12 from January 2006. I note that Party A plus Mr Kerr are referred to as the “Bonzos”, other people play different roles including the house band. Also provided are a number of agreements including:

- An agreement between Mr Edmondson and Classic Rock Productions (“Classic Rock”) for him to perform at the Astoria in January 2006 and for the concert to be filmed for release. Mr Edmondson was paid £500 for appearing. A similar agreement with Mr Paul Merton is provided.
- An agreement with Mr Kerr (and Classic Rock) for the same event. He was paid for the concert, rehearsals, a percentage of merchandise sold, a sum for advance sales of the DVD, plus a royalty and a sum for his performance in respect of the TV broadcast. A similar agreement with Mr Ash is provided. A similar agreement with Mr Innes is provided, albeit in his capacity as master of ceremonies, and on different terms.
- An agreement with Mr Smith from October 2016, in which he agrees certain rehearsal days and performances (to be paid by the management company – Party B) for events at the end of that year. A similar agreement with Mr Kerr and Mr Ash is provided. A similar agreement with Mr Glasson and Mr Livesey is also provided with Mr Carruthers’ third witness statement.

85. Party A likewise provide a significant amount of evidence. In Mr Allen’s first witness statement he describes the 2006 anniversary concert as another reunion of the band, initially with the whole band. He refers to further performances, including at the Koko venue, but with the line-up being dependant on who was available/willing to perform. He says that Mr Carruthers was merely a promotor in all this. He says that there would be no reason for the audience to turn up without the band, which is why a 2008 tour was cancelled by Mr Carruthers because the band were unwilling to perform.

86. Mr Allen refers to Mr Kerr’s role in the band. He says that Mr Kerr was in an early pre-record deal line up. He joined in late 1965 and resigned in October 1966. He was then involved with his own band, but was welcomed as a guest member of the reunion band. He adds that he could not be considered as having any claim on the ownership of the band’s name.

87. At Exhibit RCJA 3, Mr Allen sets out a chronology of events from 2005 onwards. I will not record it all, but I note:

- In September 2005, Mr Innes met Mr Carruthers as the latter was interested in promoting a Bonzo Dog Doo-Dah Band reunion concert.
- In January 2006 “the band” made a collective decision to perform. He provides a letter from Classic Rock to Mr Ash, enclosing his contract to perform. On a list of performances, I note that Mr Carruthers is identified as executive producer.
- A letter from April 2006 from Mr Carruthers to “Everybody”, proposing a further 10 date tour. Stratford is identified as the business from whom this letter is on behalf. A further letter dated June 2006, again to “Everybody” from Mr Carruthers (but on the letter headed paper of Stratford), refers to this tour, but that it is now to be 12 dates instead of 10; it also refers to the BBC taking the reunion concert for broadcast.
- Also provided are the notes of a February 2008 “BONZO SUMMIT MEETING” attended by: Innes, Slater, Kerr, Nowell, Smith, Carruthers, and a Mr Gary Russell. It discusses some of the concert issues that are ongoing. The notes indicate that Stratford would continue to manage the group and attempt to recoup its past investment from future management fees on the standard 15%.
- An email from Mr Carruthers dated 15 June 2008 at the top of which the Bonzos are identified as: Slater, Spear, Nowell, Ash, Smith and Kerr. Mr Carruthers identifies himself as manager. It notes that Mr Innes is not in a position to perform in November, but later thanks him (on behalf of his fellow Bonzos) for his work in organising the reunion and getting an album together – the door is left open for him to return at any time, either as a member or guest performer. I note that he clearly did return because he is listed as a “Bonzo” for the April 2015 concert at the Koko venue, and two subsequent concerts during the Christmas period that year.

- A letter from Mr Carruthers to “Neil [Innes], Rod [Slater], Sam [Ash], Vernon [Nowell], Bob [Kerr] and Larry [Smith] relating to the Koko concert in April 2015. Reference is made to the 6 “Bonzos” getting a decent appearance fee.

88. Mr Slater recounts the approach from Mr Carruthers in 2005 for the anniversary (and subsequent) concerts with various special guests including Mr Kerr, who he describes as a transient ex-member of the band who resigned in 1966. The offer from Mr Carruthers was agreed to in return for remuneration. He says that at no time was the ownership of the name discussed.

89. Both Mr Fry and Mr Edmondson say that they were guests and were performing for the band they knew, not any new band formed by Mr Carruthers.

90. Mr Welch states his opinion that a promoter such as Mr Carruthers cannot claim rights in the band’s name. He does not, though, give any evidence of a factual nature regarding the relationship that was in play.

91. Mr Livesey recounts that he was approached by Mr Innes in 2015 with a view to singing with the band at the Koko concert. He agreed to do so and adds that he was working for the band not Mr Carruthers; he does, though, say that Mr Carruthers paid him in cash after the event. He says that after 2 further shows in December that year, Mr Innes decided to take a break. In March 2016, Mr Carruthers asked him to sing over the Koko recording. He says he spoke to the band who agreed that this was OK. His contract (for £100) was with Coda Publishing who subsequently released the recording. Mr Livesey then spends time setting out events from later in 2016 and his falling out with Mr Carruthers (Mr Livesey says that this was to do with transport arrangements for a 2016 tour), however, as this is from after the relevant date there is no real need to discuss this here.

92. Mr Glasson has been in a number of bands which have featured members of the Bonzo Dog Doo-Dah Band. This includes “Three Bonzos and a Piano” and “Almost the Bonzo Dog Doo-Dah Band”. He says Mr Carruthers has never objected to this and that the bands were run by themselves. Mr Glasson says he performed with members of the Bonzo Dog Doo-Dah Band at the Koko venue in April 2015 and as far as he was

aware he was performing for Mr Carruthers not Party B. He adds he was not a member of the band, but a supporting musician.

93. In his further evidence accepted at the hearing, Mr Davies (for Party B) states that after the Koko show (in April 2015) he made it clear to all the potential participants of a series of concerts planned for later that year, that the tour was conditional upon the hitherto unregistered mark being formally registered at the IPO by Party B. He says this was agreed by Mr Innes. He says he also spoke to: Ash, Kerr, Slater, Smith and Nowell who confirmed that they had no claim on the ownership of the mark and that it [Party B] was free to protect its investment by registering the mark. He says, given the investment to be made, it was a condition that the unregistered mark be assigned to it. I have already outlined the evidence refuting this from: Innes, Slater, Smith and Nowell.

94. The following summary sets out my view on these matters:

- i) Mr Carruthers conceived of the idea of a 40th anniversary concert. He also created the figurative mark.
- ii) Mr Carruthers met with Mr Innes (a member of the band since at least 1965) to discuss the prospect of an anniversary concert.
- iii) There is insufficient evidence to show that Mr Carruthers individually spoke to the rest of Party A (and Mr Kerr) to get them on-board or whether Mr Innes spoke to them.
- iv) Irrespective of the above, all of Party A agreed to participate, as did Mr Kerr. They were paid on an individual basis by Classic Rock for performing on the night, and that they would receive other royalties.
- v) Through 2006 and 2007 the band comprised Party A plus Mr Kerr. I regard any other individuals (such as Mr Edmondson/Mr Fry) to simply be guest members/special guests as opposed to fully fledged members of the band.

- vi) The letters and documents in relation to the various arrangements support the proposition that the band members were seen as a band, as opposed to individuals who were ad-hockley and separately being brought together by Mr Carruthers.
- vii) There was another hiatus after 2007/2008, but further activity took place in 2015, particularly the concert at the Koko venue in April that year. The band's line-up at this time was: Innes, Slater, Ash, Nowell, Smith and Kerr; thus without Mr Spear, who had retired from the band in 2008. I note that on a flyer for the event only five persons are listed, but on a subsequent DVD release of the concert, all six are said to have featured.
- viii) Mr Livesey & Mr Glasson also appeared at Koko, but I again regard them as guest musicians. Whilst it could be argued that there is a conflict of evidence between them as to who they were "working for" (the former saying that he was working for the band, the latter for Mr Carruthers), I do not take Mr Glasson's evidence as anything other than a reflection that Mr Carruthers engaged him to perform [as a guest musician] as opposed to Party B.
- ix) I do not accept that Mr Davies had conversations with Mr Innes et al after the Koko concert about the registration of the mark by Party B. I found it a little surprising that Mr Davies left his evidence on this to be filed only two days before the hearing, and there is counter-evidence from the relevant members of Party A that strongly refute Mr Davies' evidence. In the absence of anything in corroboration, I do not accept Mr Davies' evidence.
- x) Mr Innes left the band after the Christmas 2015 concerts, thus, when Party B's trade mark was filed in October 2015 the band's line-up was: Innes, Slater, Nowell, Smith, Ash & Kerr.

The passing-off claim

95. The law of passing-off is relevant to invalidation proceedings because the provisions of section 47(2)(b) of the Act provide that a trade mark may be invalidated if it was registered in breach of section 5(4)(a). Section 5(4)(a) of the Act reads:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

(b)...

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

96. It is settled law that for a successful finding under the law of passing-off, three factors must be present: i) goodwill, ii) misrepresentation and, iii) damage. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

97. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), where the Court stated:

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

98. For this ground of invalidation to succeed, the use of Party B's trade mark must have been capable of being restrained when it was filed, namely on 2 October 2015. Goodwill must exist at this date.

99. It might also have been necessary to consider the position at an earlier date if Party B has used the mark before then, reflecting the requirement to show that such restraint was also capable of action when the behaviour complained of (the use of the mark) first commenced. Whilst this would place a requirement on Party B to also show that it acquired the business of its predecessor in title (Mr Carruthers/his companies), this has the potential to become moot when one considers Party A's position that Mr Carruthers was (through one or other of his companies) merely promoting or managing the band, which, consequently, means that the use from 2005 was, effectively, use by the band.

100. One of the primary arguments pursued by Mr Panayi was that of the disparate and ever-changing nature of the band over the years, coupled with the length of time it was dormant for prior to its resurrection. I accept that this is an important point. However, by 1966 the band had a more settled line-up (Party A, Mr Stanshall and Mr Kerr, possibly with one other member), and by 1967 it was just Party A and Mr

Stanshall at which point it signed a new recording agreement to release its first album. Mr Nowell and Mr Ash also subsequently left before the remaining 5 members (Innes, Slater, Spear, Smith and Stanshall) released further albums. The last (pre-2005) album was in 1972, with a long gap to a further single in 1992. There were, though, compilation albums and press articles which in my view clearly kept both the name The Bonzo Dog Doo-Dah Band, and Bonzo Dog Band, in the public consciousness. I note that in Mr Panayi's skeleton he refers to some of the press cuttings as showing that there may have been further personnel changes, but this is not what the witnesses have said.

101. I come to the very clear view that at the point in time when Mr Carruthers contacted Mr Innes in 2015 to pitch the idea of a 40th Anniversary concert, there was at the very least a residual goodwill associated with both the names The Bonzo Dog Doo-Dah Band and Bonzo Dog Band (the public would see these as interchangeable names, references to the same band that started in the 1960s). I accept that simply being in the consciousness of the public is not sufficient to establish a protectable goodwill, but the nature of the goodwill is such that members of the public would expect goods and services offered under those names to be from the band they knew.

102. That goodwill still existed in 2005 is clearly apparent from the desire of Mr Carruthers to promote an anniversary concert, and to do so with as many members of the band as possible. I agree with Mr Allen's submission that there would be no point in doing so if there was no attractive force to bring in custom.

103. Who owned that goodwill is a more difficult point. Mr Slater states that the six individuals who make up Party A have operated as a partnership since 1962 and have exercised control over the name. He says that appearances at concerts etc. is based on availability of such members. However, this not borne out in the evidence, at least not prior to 2005, which, instead, exemplifies a typical band scenario where the band has simply continued as the same band when members leave. I agree with Mr Panayi that Party A have not acted as a partnership since 1962, not least because not all of them were in the band when it first formed, but, as importantly, some of them clearly left (in 1967/1968).

104. Both sides have referred to the partnership issue and whether a partnership at will can be inferred. On the basis of the evidence before me, the situation, at least prior to 2005, was more akin to that described by Mr Hobbs QC in *The Animals* (BL O-369-13) where he said:

“7. So far as anyone can tell from the evidence on file in the present proceedings, the group was an unincorporated association of individuals with no contractual or other arrangements governing the relationship between and among its members.....

8. The evidence on file does not suggest that there has ever been a realisation or division of assets on dissolution of the group. There is also nothing in the evidence to suggest that the members of the group used the name THE ANIMALS with the licence or consent of anyone else. On the assumption that they used it as of right and in the absence of any basis in the evidence on file for either side to claim otherwise it seems to me that the goodwill and reputation built up and acquired by the group operating as THE ANIMALS should for the purposes of this dispute between these parties in these proceedings be taken to have belonged to ‘the last men standing’ in 1983: cf CLUB SAIL Trade Marks [2010] RPC 32 at paragraphs [26] to [28]. Burdon, Price, Valentine, Steel and Chandler will on that basis have been collectively entitled to control the use of the name THE ANIMALS in relation to live and recorded performances going forward from there.

105. In my view, the band’s residual goodwill in 2005 would have been owned by the last men standing which, on what I have taken from the evidence, would have been: Innes, Slater, Spear & Smith (Mr Stanshall having died, and Mr Nowell and Mr Ash having left). This last man standing principle is why the circumstances surrounding the coining of the mark in the first place is not greatly significant.

106. The trading activities from 2006 onwards would have re-energised that goodwill. The activities would have changed the goodwill from being residual in nature, to that of an ongoing band. Members of the public would have been going to the 2006 concerts to see the band. It is not the case, in my view, that the new activities created

some form of new goodwill divisible from that associated with the band. I do not accept Mr Carruthers' submission in writing that the new use has a different distinctive character – the public would see it as one and the same. I accept that Classic Rock (and Mr Carruthers) did much of the leg work. However, they cannot claim any goodwill associated with the name of the band. The evidence is not clear and precise regarding the nature of the relationship between the band and Mr Carruthers. I suspect it was a relatively informal one. However, regardless of the role of Mr Carruthers (through Classic Rock, and later Stratford) as a producer and/or manager, the goodwill generated through the activities of the band under its name naturally flows to the band. This is because the public would regard the band as responsible for the quality of the music and entertainment provided under its name. For the position to be otherwise there would have to be clear evidence of an agreement, whether express or implied, that the goodwill generated by the trading activity under the name of the band would belong to Mr Carruthers or one of his companies. There is no such evidence. This is all so irrespective that the figurative mark was created by Mr Carruthers. Whilst this may give Mr Carruthers the right to prevent third parties (including the band) from copying and using the figurative mark without his permission, it does not follow that he has the right to use (and register) that mark if it otherwise interferes with the interests of others, because, as it applies here, that figurative mark contains the name of the band.

107. That the band was still regarded as the band is highlighted by the documentary evidence provided by Mr Allen, including the letters from Stratford and the notes of the Bonzo Summit meeting. I also note the reference in the latter to Stratford working on a 15% remuneration basis. I also note that in Mr Smith's 2007 agreement with Stratford, it refers to "The Artist pka THE BONZO DOG DOO-DAH BAND ("the Artist")".

108. The consequence of this is that any goodwill associated with the band and its name in the post-2005 period flows to the band. Thus, such use can be relied upon by the band not Party B. The question in terms of restraint under the law of passing-off need only be judged as of 2 October 2015. Such notional use, and whether Party A could restrain it, would be, by way of example, if Party B had used the name without the consent of Party A for performances with other musicians instead of the band. This finding also deals with the written submissions from Mr Carruthers which mentions

honest concurrent use and acquiescence; this does not apply because it was, essentially, the bands use, albeit put into play by Mr Carruthers.

109. The make-up of the band changed from the first reunion concert in 2006, to the last (pre-relevant date) concert in Koko in 2015. My finding earlier was that at this point the band comprised: Innes, Slater, Nowell, Smith, Ash and Kerr; thus without Mr Spear.

110. Much has been made by Party B of the fact that Party A, the six (prior to Mr Ash's death) individuals who say they were a partnership, were not a partnership at all, and certainly not a partnership at the relevant points. As I touched on earlier, this point has some significance in a passing off-claim given that the claimant must be the owner of the claimed earlier right. However, I also note from the *Animals* case that Mr Hobbs stated:

“31. It was, as I have said, open to the opponent as one of ‘the last men standing’ to invoke the law of passing off for the protection of the goodwill and reputation to which they were collectively entitled.”

111. The claim has been invoked, on the evidence before me, by five of the last men standing (Mr Innes, Mr Slater, Mr Nowell, Mr Ash & Mr Smith) measured at the relevant date. I do not think it matters that Mr Kerr is absent from the claim, or that the claim included an individual who was not in the band at the relevant date. Nor do I think it matters that Party A have identified themselves as a specific partnership. It would be wrong in my view to deny these claims on such a basis.

Misrepresentation & damage

112. The relevant test for misrepresentation was dealt with in *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, where Morritt L.J. stated:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

113. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing-off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if

he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

114. Unlike much of the rest of this decision, this is a fairly straightforward matter. Whilst the registered mark is stylised, it prominently features the name of the band. The mark is registered for goods and services which directly relate to the activities of a band. It is inevitable that members of the public would believe that the goods are services are those of the band. Misrepresentation and damage clearly follow.

115. The invalidation succeeds under section 5(4)(a) of the Act.

Section 3(6) - Bad faith

116. Section 3(6) of the Act provides for the refusal of a trade mark "...if or to the extent that the application is made in bad faith". A summary of the law was provided by Arnold J in the *Red Bull*² case, as follows:

"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 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* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v*

² *Red Bull GmbH v Sun Mark Ltd & Anr* [2013] ETMR 53

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 Kunststoffe 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)".

117. Party B's position is that it filed the mark to protect its investment and that, in any event, it (or more accurately its claimed predecessor) created the figurative mark which it filed. Party A's position is that Party B had no right to file the mark because the rights in the name belong to the band; it was highlighted in submission that the trade mark may be used to prevent the band from performing or recording under its own name. They also claim that they did not really know who Party B was at the time.

118. This is no evidence that the band and Party B (or Mr Carruthers) had any form of falling out before the mark was filed. There is evidence that the relationship may have soured in 2016 (I particularly note the evidence from Mr Livesey in this regard), but there is nothing in this which casts light backwards.

119. Nevertheless, I still find that filing the application was an act of bad faith. Unless there is an agreement to the contrary (which I have found there was not), or unless the band is created by a record company (which it was not), persons or businesses who engage with a band in the way that Party B (and before it Mr Carruthers/his companies) has, should not be registering trade marks the effect of which would be to put them in complete control of the name of the band they represent and which would have the potential effect of preventing the band from undertaking the activities it should be free to do under its own name. I fully accept that Mr Carruthers has invested time and money into the various activities mentioned, and I also accept that Party B would have done likewise. However, honest people in the trade observing acceptable standards of behaviour would do so by relying on the remuneration from such activities to recoup their investment. If they were concerned about not gaining sufficient remuneration then some form of exclusive representation agreement should have been agreed. The use of the trade mark system is not the correct mechanism for the protection they seek, even if Mr Carruthers designed the figurative elements of the mark. The ground under section 3(6) also succeeds.

Outcome of invalidation claim

120. The invalidation succeeds on both grounds. The registration is deemed never to have been made.

THE OPPOSITION TO PARTY B's TRADE MARK

121. I can deal with the opposition quickly. The grounds based on sections 5(2) and 5(3) fail because the earlier mark relied upon by Party B is invalid. The ground based on section 5(4)(a) fails because Party A are not the owners of any relevant goodwill.

Outcome of opposition proceedings

122. The opposition proceedings fail, which means that Party A's application may proceed to registration.

123. I note in passing that I have not detailed every aspect of the evidence. If I have not included anything it is simply a reflection that it takes matters no further forward.

COSTS

124. I hereby set a period of 28 days (from the date of this decision) for both sides to make written submissions on costs, which, ordinarily, would be made in favour of Party A as the successful party.

125. Costs are normally based on a scale of costs (see TPN 2/2016), however, given that Party A has not been represented during these proceedings, they must complete a pro-forma (which will be provided with the covering letter to this decision), which is intended to highlight the amount of time expended. If this results in a claim above the scale, a full explanation as to why off-scale costs are to be awarded should be provided.

126. If Party B submits that it should receive costs, notwithstanding that it has been unsuccessful in the proceedings, it should likewise complete the pro-forma (and

provide an explanation for any claimed off-scale costs) as, other than the hearing, it too has been unrepresented.

127. The appeal period for this decision and any decision on costs, will be set when I issue a supplementary costs decision/order.

Dated this 30th day of October 2019

Oliver Morris

For the Registrar,

the Comptroller-General