

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1502341 BY
TREADWELL'S DRIFTERS INC
TO REGISTER A TRADE MARK IN CLASS 41**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 47459
BY WILLIAM HENRY LEWIS**

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**IN THE MATTER OF Application No 1502341
by Treadwell's Drifters Inc to register a trade mark
in Class 41**

And

**IN THE MATTER OF Opposition thereto under
No 47459 by William Henry Lewis**

BACKGROUND

1. On 21 May 1992 Treadwell's Drifters Inc. of 462 Liberty Road, Englewood, New Jersey, United States of America applied to register the mark **DRIFTERS** in Class 41. Following examination, the mark was accepted and published for the following services:

“Music entertainment services; concert services; publication services; publication of music; distribution and production of musical works; provision of recording studio facilities; rental of sound recordings and musical reproducing apparatus; arranging and conducting of conferences, exhibitions and seminars, all relating to all the aforesaid; consultancy services relating to the aforesaid; agency services for performing artists; all included in Class 41”.

2. The application is opposed by William Henry Lewis. The opponent has filed a very detailed Statement of Grounds providing information on the composition of the various musical groups in which the word DRIFTERS has been a significant feature. The basis of the opponent’s objections will become clearer later in this decision, however, objections are said to arise as follows:

1) under Section 11 of the Act, as the use of the mark would be deceptive and would be disentitled to protection in a Court Of Justice.

2) under Section 17(1) of the Act as the applicant can not claim to be the proprietor of the mark DRIFTERS either as filed, or generally.

3. The applicants filed a counterstatement which, while including a number of admissions, consists in essence of a series of denials. I note that with their counterstatement the applicants also filed Form TM21, in which they ask for the specification of services of the application to be limited to:

“Music entertainment services”.

4. The opponent asks for the Registrar to exercise her discretion in his favour and to refuse

the application, while the applicants say that there are no reasons why such discretion should be exercised. Both sides seek an award of costs in their favour and both sides filed evidence. The matter came to be heard on 3 April 2001. The applicants were represented by Mr Butler of Frank B Dehn & Co. The opponent, Mr Lewis, did not attend. It transpired that he was unwell on the day. He telephoned the Trade Marks Registry three days afterwards to so inform them. His request for another hearing date to be fixed was turned down.

5. By the time the matter came to be heard the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later part of this decision are references to the provisions of the old law.

Opponent's evidence-in-chief

6. The opponent's evidence consists of a Statutory Declaration by William Henry Lewis dated 28 July 1998. Mr Lewis' declaration contains a number of views as well as information on events or facts which are after the material date in these proceedings. The points I take, however, from the evidence are as follows:

- that he is a recording artist and entertainer with over forty years experience in the United Kingdom
- that he is a citizen of the United States of America who lives in England and who performs under the name "Billy Lewis"
- that in the summer of 1965 he first joined a musical group which appeared and recorded under the name THE DRIFTERS. He left in 1967 when he was conscripted into the United States Army
- that in 1974 he met Faye Treadwell in New York, that she had a group in England touring under the name THE DRIFTERS and she invited him to join them. Mr Lewis states that Mrs Treadwell paid for him to join the group in England who were on a promotional tour for Arista Records. At that time the group consisted of Johnny Moore, Clyde Brown, Butch Leake and Mr Lewis
- that in the period 1974 to 1980 he visited the United Kingdom twice a year for two tours each year. Throughout this period he says that we (which I take to mean the members of the group) were paid in cash by Mrs Treadwell. He adds that (we) never had any written contracts
- that at the end of the second tour in 1980 he decided that he was not coming back [to the United Kingdom] and gave notice to that effect; he returned to New York and for the next two years performed as both an actor and a singer
- that in 1982 he was contacted by Mrs Treadwell who, in 1983, brought together a new group consisting of Bill Fredricks, Lewis Price, Ray Lewis and

Mr Lewis. He explains that Mrs Treadwell had arranged a one month booking for the group to appear at the Sahara Hotel in Las Vegas under the name THE DRIFTERS. The booking was due to commence in November 1983 but the booking lasted for less than a week, as action was taken by a Mr Larry Marshak (who owns the name THE DRIFTERS in the United States) to prevent them from appearing under that name. Exhibit WHL1 consists of a copy of a registration certificate relating to a United States trade mark registration for the words THE DRIFTERS in the name of Larry Marshak. The registration date appears to be 3 January 1978 and the mark is registered in respect of: "Entertainment services, namely a singing group in Class 41". There is also attached to the registration certificate what appears to be an open letter written on the letter headed paper of a company called RCI Management Inc of Floral Park, New York and dated 24 March 1993 in which Mr Marshak comments as follows:

"To whom it may concern - I am the holder of the US Federal trademark #1,081,338 and the manager of the recording and performing group in the name of the Drifters for the past twenty years. I additionally hold the trademark in Aruba as well as many other countries abroad"

- that in 1982 or early 1983 Henry Seller (Manager) and Dereck Block (Booking Agent) assembled together Johnny Moore, Clyde Brown, Joe Blunt and Ben E King and they appeared under the name THE DRIFTERS in the United Kingdom for two tours each year during the period 1983 to 1986. This group he states had no connection with Mrs Treadwell or her company, Treadwell's Drifters Inc
- that in March 1986 Ben E King left the above group and the United Kingdom tours were dropped. At this time Mrs Treadwell assembled Lewis Price, Ray Lewis, Jonah Ellis and himself. From 1986 to 1989 they returned to do two tours of the United Kingdom each year. Mr William Lewis (the opponent) left that group in October 1989
- that the opponent currently appears under the name "Billy Lewis' Drifters" and has given approximately 400 performances under that name; that he has also appeared under the name "The sound of the American Drifters" at a hotel in Dungannon in February 1995. Exhibit WHL2 which relates to this is after the material date in these proceedings
- that the first people to appear under the name THE DRIFTERS were: Clyde McPhatter, Bill Pinckney, Andrew Thrasher and Gerhart Thrasher. That Clyde McPhatter was drafted in 1954 approximately a year after the group had started and was replaced by Johnny Moore - at which time the group was under contract to Atlantic Records. By 1958 the group was not doing as well and Atlantic Records formed a new group called "The New Drifters" which consisted of Ben E King, Charlie Thomas and three others. Atlantic Records released Clyde McPhatter, Bill Pinckney, Andrew Thrasher and Gerhard

Thrasher from their contract. Mr Lewis considers that they were free to continue to use the name THE DRIFTERS; Bill Pinckney still does so in Las Vegas independently of Mrs Treadwell

- that Robert Pratt who is a Manager and Promoter based in Glasgow, with no connection with Mrs Treadwell or her company, has “for a few years” been arranging performances under the name “The sound of the Drifters”
- that the applicants instituted passing off proceedings against him but these have not been pursued.

Applicants’ evidence-in-chief

7. The applicants evidence consists of a Statutory Declaration by Stuart Hammond dated 28 May 1999. Mr Hammond explains that he is a partner in the firm of Judge Sykes Frixou who are the applicants’ Solicitors. He states that he is authorised to make the declaration on the applicants’ behalf adding that the facts contained in his declaration are either within his own knowledge or have been supplied to him by Fayrene Treadwell the Managing Director and proprietor of Treadwell Drifters Inc.

8. Mr Hammond begins by referring to exhibit SPGH1 which consists of a copy of a book entitled “Save the last dance for me - The musical legacy of the Drifters, 1953-1993”. The book was written by Tony Allan with Faye Treadwell and was published by Popular Culture Inc, of Ann Arbor Michigan, United States of America; it carries a copyright date of 1993. Although after the material date in these proceedings, the book (as its name suggests) does purport to refer to the history of the musical group known as THE DRIFTERS. It also in Mr Hammond’s view includes the circumstances in which ownership of the group and the entitlement to the goodwill attaching to the name THE DRIFTERS was acquired by the late George Treadwell the deceased husband of Mrs Treadwell through the Drifters, Inc. I will refer to this publication later in response to the comments in Mr Lewis’ declaration.

Mr Hammond makes the following points:

- in so far as Mr Lewis refers to belonging to a group with Bill Pinckney, Mr Hammond refers to exhibit SPGH2 which consists of a copy of an injunction dated 9 March 1970 obtained by The Drifters, Inc against Mr Pinckney in the General Court of Justice, Superior Court Division in North Carolina to prevent him using the name THE DRIFTERS
- in so far as Mr Lewis refers to the forming of a group in 1983 with Ray Lewis, Mr Hammond notes that Mr Ray Lewis has contractually acknowledged the applicants’ entitlement to use the name THE DRIFTERS. Exhibit SPGH3 consists of copies of agreements between the applicants and Mr Ray Lewis (dated 1980 and 1992) to this effect
- in so far as Mr Lewis refers to tours in the United Kingdom in 1982 or early 1983 by groups comprising Johnny Moore, Clyde Brown, Joe Blunt and Ben E King, the applicants obtained injunctive relief against these individuals. A copy

of the Court Order sealed 25 March 1986 is provided at exhibit SPGH4

- in so far as Mr Marshak is concerned, although at the time Mr Lewis' declaration was signed Mr Marshak owned the registration of the trade mark THE DRIFTERS in the United States referred to, Mrs Treadwell informs him that she has been successful in the United States in establishing that Mr Marshak's trade mark was obtained improperly. Mrs Treadwell is currently engaged in deleting it from the Register and replacing it with a registration of her own
- that in so far as Mr Lewis himself is concerned, he has in Mr Hammond's view contractually acknowledged the applicants' entitlement to the name THE DRIFTERS and in this regard he refers to exhibit SPGH5 which consists of what appears to be an agreement between Mr William Lewis the opponent and the applicants dated 25 March 1979. That said, Mr Hammond acknowledges that Mr Lewis disputes that the signature on the document is his
- with reference to the passing off action mentioned by Mr Lewis, Mr Hammond states that the purpose of this application is to prevent others from abusing the substantial goodwill and reputation enjoyed by the applicants in the name and the group THE DRIFTERS which has been touring England and Wales regularly since 1976. Exhibit SPGH6 consists of the applicants various international touring activities between 1954 and 1992
- that as the result of an assignment dated 25 June 1976, all the rights title and interest in and to the use of the name THE DRIFTERS was assigned by "The Drifters Inc," to Treadwell Drifters Inc. Exhibit SPGH7 confirms this to be the case
- that the applicants are entitled to various royalties from the record companies Atlantic Recording Corporation (now Warner Brothers) and Bell/Arista Records (now BMG) in respect of THE DRIFTERS recordings listed in appendix 3 to exhibit SPGH1, following the departure of Mr McPhatter in 1954/55.

Applicants' additional evidence

9. This consists of a Statutory Declaration by Fayrene Treadwell dated 8 June 1999. It confirms that Mrs Treadwell is the proprietor of the applicant company and that she is authorised to speak on that company's behalf. She explains that she has read the declaration of Mr Hammond and confirms that in all respects its content is true.

10. That concludes my review of the evidence filed in these proceedings, insofar as I consider it relevant.

DECISION

11. I deal with the ground of opposition based upon Section 17(1) first because I think that may be the key to this dispute. Section 17(1) states:

17. - (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.

12. I take the objection under this head to mean that Mr Lewis believes that the applicants cannot claim to be the proprietors of the trade mark DRIFTERS because (i) it is a body corporate which is not able to give a musical performance and (ii) that the goodwill in the trade mark rests with the individual members of the group known as the DRIFTERS. In seeking to determine the matter of proprietorship I have regard to the views of Morritt LJ in AL BASSAM Trade Mark [1995] RPC 511:

"Accordingly it is necessary to start with the common law principles applicable to questions of the ownership of unregistered marks. These are not in doubt and may be shortly stated. First the owner of a mark which had been used in conjunction with goods was he who first used it. Thus in *Nicholson & Sons Ltd.'s Application* (1931) 48 R.P.C. 227 at page 253 Lawrence L.J. said

"The cases to which I have referred (and there are others to the like effect) show that it was firmly established at the time when the Act of 1875 was passed that a trader acquired a right of property in a distinctive mark merely by using it upon or in connection with his goods irrespective of the length of such user and of the extent of his trade and that such right of property would be protected by an injunction restraining any other person from using the mark."

Second the right to the used mark as an indication of the origin of the goods could not be assigned separately from the goodwill of the business in which it had been used for that would have been to assign the right to commit a fraud on the public, cf. *Pinto v. Badman* (1891) 8 R.P.C. 181, 194. Third, in the case of an unused mark the person with the best right to use it was the designer or inventor. cf, *Hudson's Trade Marks* (1886) 3 R.P.C. 155 at pages 160 and 163.

The trademark legislation has included and still includes provisions dealing with what might be regarded as use for the purpose of acquiring a trademark. See for example ss 75 Patents, Designs and Trade Marks Act 1883 and section 31 Trade Marks Act 1938. Moreover all the trademark legislation from 1875 to 1938 has contained a greater or lesser prohibition on the assignment of the mark separately from the associated goodwill. See for example section 2 Trade Marks Registration Act 1875 and section 22 Trade Marks Act 1938. Likewise all of them have contained provisions requiring the rights of rival claims to be determined by the court. See for example section 5 Trade Marks Registration Act 1875 and section 12(3) Trade Marks Act 1938.

In my view it is plain that the proprietor is he who satisfies the principles of the common law to which I have referred. Accordingly in the case of a used mark, as in this case, the owner or proprietor is he who first used it in relation to goods for the purpose indicated in the definition of trade mark contained in section 68 which I have already quoted."

13. For completeness the relevant part of Section 68 states:

68.- (1) In this Act, unless the context otherwise requires, the following expressions have the meanings hereby assigned to them respectively, that is to say:-

"trade mark" means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section thirty-seven of this Act".

14. From the evidence (of both sides) it seems to me that there has been a musical group known as the DRIFTERS for over forty years. The individual members of the group have changed over that time, for a number of reasons. However, the common factor throughout most of that period has been the control exercised first of all by George Treadwell and later by Faye Treadwell through the Drifters Inc and subsequently Treadwell's Drifters Inc. Mr Lewis was a member of the group in the sixties and acknowledges in his evidence that he was subsequently engaged from time to time (and for varying periods) by Mrs Treadwell to perform as part of the group known as THE DRIFTERS (1974-1980, two tours per year in the United Kingdom; 1983 for an engagement in Las Vegas; 1986-1989 two tours per year in the United Kingdom). I also note that Mr Lewis states that at times Mrs Treadwell paid the members of the group in cash and there were no written contracts. The only evidence I have of the origins of the trade mark is the book 'Save the Last Dance for me - The musical legacy of the Drifters 1953-1993'. Though reluctant to place too much weight on this publication, because it was written in part by the applicant who is not unbiased, I do not dismiss it even though published after the material date. This is because it sets out facts relating to the coining of the name THE DRIFTERS, which was not challenged and in many respects it corroborated what is said already in evidence. The name THE DRIFTERS was first used in 1953 and the group was managed by George Treadwell. Individual members of the group came and went (as confirmed by Mr Lewis) but throughout the period since then George Treadwell, his widow or their successors in business have continued to use and promote the name THE DRIFTERS in connection with entertainment services provided by a musical group of that name.

15. The evidence indicates that they have taken action to prevent others using that name both in the United Kingdom and in the United States of America. There are the injunctions granted by the Courts preventing the use of the name by former members of the group. And although after the relevant date in these proceedings, the applicants claim to have removed from the register in the United States the registration of the trade mark THE DRIFTERS owned by

Larry Marshak and are seeking to register their own trade mark in that jurisdiction.

16. Taking all of the above into account, I reach the view that the applicants and their predecessors in business have used and protected this unregistered trade mark in such a way as to ensure that it is a badge of origin of the services they provide. As far as I can ascertain Mr George Treadwell as manager of the group was the first to use the term THE DRIFTERS in that way and his successors in business have continued to do so. Thus the applicants in my view can rightfully claim proprietorship of the trade mark they seek to register. The grounds of opposition based upon Section 17(1) is therefore dismissed. The fact that the applicants are a body corporate is not a material factor. It is they who are the proprietors of the trade mark and use it in relation to the services covered by the application for registration.

17. The opponent's grounds of opposition also state:

"7. The applicant has never used the mark DRIFTERS and had at the date of application no bona fide intention that it should be so used. Any use by the applicant has always been in the form THE DRIFTERS. The definite article is part of the name which is recognised by the public and contributes to its distinctiveness so that THE DRIFTERS has a different meaning to DRIFTERS. The applicant therefore has no claim to be the proprietor of the trade mark DRIFTERS under the Trade Marks Act 1938 Section 17(1)."

18. I do not regard this as a serious objection. The fact that the mark sought to be registered is DRIFTERS rather than the full name of the musical group THE DRIFTERS does not mean that they have either not used the word DRIFTERS solus or do not intend to. In that connection I note that in the agreements exhibited by Mr Hammond between individual members of the group and the applicants, the terms THE DRIFTERS and DRIFTERS have both been used. Also, in the context of the general use of the term eg 'have you been to a DRIFTERS' concert?' or 'have you a DRIFTERS CD?' the term DRIFTERS solus must be used frequently.

19. The next ground of opposition is based upon Section 11 which states:

"11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design."

20. The opponent's objection is found as follows:

"6. The group of performers who have been giving performances in the UK for the applicant is different from any of the known groups of performers (a) to (c) in paragraph 5. For that reason, use made of the mark "THE DRIFTERS" by the applicant is deceptive and confusing and its mark is disentitled to protection in a court of justice (Trade Marks Act, 1938, Section 11). The mark also offends against Section 11 because:

- (a) of the concurrent existence of reputations associated with the different groups of performers set out in paragraph 3 and maintained by the continued sale and use of their recorded musical works, at least some of said reputations pre-dating anything done in the UK by the applicant; and
- (b) of the definite article THE in the name THE DRIFTERS which implies uniqueness for a designated group of performers whereas the true position is that there is no such uniqueness.

21. Mr Lewis seems to be suggesting that because the musical group the DRIFTERS has been composed of different performers over the years, and the composition in the United Kingdom has been different to that of the group in the United States, then it would be misleading if the current applicants were to be granted registration. In my view there is no evidence to suggest that this is likely to happen. Given the number of different individuals who have appeared in the group over the years it seems to me that the public will not expect THE DRIFTERS to consist of any particular individual or individuals but perhaps to have a particular 'sound' or 'theme'. Therefore I do not hold that use by the applicants of DRIFTERS in connection with the services now sought "music entertainment services" is likely to cause deception or confusion of the public in whole or in part. That ground of opposition is also dismissed.

22. The opposition having been unsuccessful the applicants are entitled to a contribution towards their costs. I therefore order the opponent to pay to them the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31ST day of May 2001

M KNIGHT
For the Registrar
the Comptroller-General