

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION UNDER NUMBER 12012
BY PETER BYFORD**

AND

**FOR A DECLARATION OF INVALIDITY IN RESPECT
OF TRADE MARK NUMBER 2150052
IN THE NAMES OF GRAHAM OLIVER & STEVE DAWSON**

TRADE MARKS ACT 1994

IN THE MATTER OF an application under number 12012 by Peter Byford for a Declaration of Invalidity in respect of trade mark number 2150052 in the names of Graham Oliver & Steve Dawson

DECISION

1. Trade mark No. 2150052 is in respect of the mark SAXON and was registered in Classes 9, 16 and 41 in respect of:

Class 9 Nautical, surveying, photographic, cinematographic, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

Class 16 Bookbinding material; photographs; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks; printed matter relating to a musical band; but not including any such goods relating to, or bearing representations of, Saxons.

Class 41 Providing of training; presentation of live performances; musician services; organisation of musical concerts; production of musical shows; sporting and cultural activities.

2. The registration stands in the names of Graham Oliver & Steve Dawson

3. By an application dated 12 July 2000, Peter Byford applied for the registration to be declared invalid on the following grounds:

Under Section 3(6) because the application to register the mark was made in bad faith.

Under Section 5(4)(a) by virtue of the law of passing off.

4. The registered proprietors filed a counterstatement in which they deny the grounds on which the application has been made. The registered proprietors and the applicant for revocation both ask for an award of costs in their favour.

5. Both sides have filed evidence in these proceedings. The matter came to be heard on 11 June 2002, when the applicant was represented by Mr Andrew Norris of Counsel, instructed by Gersten & Nixon, their solicitors, and the registered proprietors by Mr Rupert Withers of Assassination Music Promotions, the manager of the registered proprietors' group.

6. A considerable amount of the evidence filed in these proceedings consists of copies of documents filed in proceedings in the High Court, launched by Mr Oliver against Peter Byford, Nigel Glocker, Paul Quinn and Timothy Carter in December 1997. Whilst some of the issues in the statement of claim presented to the High Court mirror those of these proceedings, inter alia, the ownership of the goodwill in the name SAXON, the court proceedings have been discontinued, and other than the evidential value of the documents, has no bearing on this case.

Applicant's evidence

7. This consists of a Statutory Declaration dated 11 April 2001 from Peter Byford, of Chestnut House South, Penny Hill, Holbeach, Nr Spalding, Lincolnshire. Mr Byford says that he is one of the members of the group known as SAXON, and had previously been responsible for its administration. Mr Byford confirms that his statement is made from his own knowledge and records that relate to the group to which he has full access.

8. Mr Byford refers to proceedings in the High Court launched by Graham Oliver (one of the registered proprietors) against the current members of the group, claiming it had been dissolved when he left, seeking a declaration to that effect and money in respect of its assets as at the date that he left. Exhibit PB1 consists of Witness Statements filed by Mr Byford in those proceedings, which gives a synopsis of Mr Byford's career and the following details relating to SAXON:

- Mr Byford came up with the name SAXON some time between the band being offered a recording contract in 1978 and the release of the album under that name in the winter of 1979,
- the album "Wheels of Steel" released in 1980- the band agreeing to share the money earned equally,
- Peter Gill left the band in 1982,
- in 1980-81 the band share £30,000 from a publicity deal with Axis Music Limited,
- the album "Innocence is no excuse" released with the earnings being apportioned according to creative input,
- Steve Dawson sacked some time after 1986 and was replaced by Paul Fasker-Johnson,
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- Paul Fasker-Johnson sacked in 1988. He subsequently attempted, unsuccessfully, to sue the group and have the “partnership” dissolved,
- SAXON stopped performing 1988 - 1989,
- SAXON re-established in 1989-1990,
- from 1992 the band members performed as sole traders, not as a “partnership” with individual members signed to publishing companies, and receiving income directly,
- Graham Oliver dismissed from Saxon at end of 1994 and started new band Son of a Bitch but still uses or associates himself with SAXON,
- in 1996, CBH Records obtained an injunction to prevent Graham Oliver using the name SAXON, although he continued to use the name in various forms including “SAXON; the early years” Oliver/Dawson SAXON. Some evidence of confusion from members of the public that had attended a performance believing it to be Mr Byford’s SAXON, but had found it to be the OLIVER/DAWSON SAXON.

9. In a supplementary Witness Statement dated 25 May 2000, Mr Byford recaps on some of his earlier statement, and refers to Mr Oliver’s attempts to interfere with his groups’ contractual arrangements with various venues at which they were scheduled to perform. He goes on to refer to the trade mark SAXON said to be owned by Graham Oliver, which Mr Byford says is causing his group substantial damage. Exhibit PB1 (to the supplementary statement) consists of a copy of an e-mail dated 16 April 2000 from a member of the public complaining that he had attended a concert advertised as SAXON but found that it was Graham Oliver and Steve Dawson’s SAXON.

10. Returning to the Statutory Declaration. Mr Byford restates that when Mr Oliver left SAXON he went on to perform and release recordings under the name “Son of a Bitch”. He also says that when they left, neither Mr Oliver nor Mr Dawson made any claims to the ownership of the name SAXON, and that the “original” SAXON continued to perform under that name. He notes that when Mr Oliver commenced proceedings against SAXON in 1997 he made no claim to the name SAXON. Mr Byford comments on events that he says illustrate a lack of integrity on behalf of Graham Oliver, and further recounts the attempts made by Mr Oliver to interfere with the groups’ performances. Exhibit PB2 consists of a copy of an e-mail from Total Concept Management, referring to, and attempting to arrange a concert for the Oliver/Dawson SAXON and stating that use of the name SAXON would result in legal action, and a letter from the same organisation to a venue at which SAXON were booked to appear, informing them that this was not the original SAXON “partnership” and threatening an injunction. Mr Byford says that it is through these letters that his group found out about the trade mark registration.

11. Mr Byford says that it is well known that when a member leaves, the group continues to perform under the same name. He refers to an exchange of correspondence with Mr Oliver

and Mr Dawson's in July 1997, copies of which are shown at exhibit PB3. The letter from Mr Byford's solicitors mentions Mr Oliver and Mr Dawson having started a group under the name Son of a Bitch, but also using the name SAXON. The response from Mr Oliver's solicitors admits that they are performing under the name "Son of a Bitch", but that they consider that their past associations with the group gave them the right to use the name SAXON. Mr Oliver's solicitors describe the band as a partnership and that as the name formed part of the goodwill of the partnership, the former members retained the right to use the name.

12. Mr Byford goes on to refer to the merits of his case, in particular, on the ground of passing off, referring to exhibit PB4 as evidence of goodwill. The exhibit consists of numerous press articles and copies of documents relating to recording sales and tours, many of which mention Mr Oliver and Mr Byford. Mr Byford goes on to say that royalties from recordings are distributed directly to the band members and do not form part of the bands assets, but from the evidence it is clear that that was not the situation at the start.

13. Mr Byford refers to exhibit PB5 which consists of correspondence from fans that had attended a SAXON concert and had been confused or disappointed to discover that it was Graham Oliver calling himself SAXON. He says that Mr Oliver is trying to have it both ways; by seeking an account of his share of the groups' assets including its goodwill, but also claiming to be the proprietor of the name. Mr Byford says that the assets either belong to the group as a whole and to which Mr Oliver may be entitled to a share, or that the assets are owned by present and former members of the band which entitles Mr Oliver and Mr Dawson to register the mark. He concludes saying that at the time that the application was made, both Mr Oliver and Mr Dawson did not know who owned the mark, and had made no attempt to prevent Mr Byford's group from using the name.

Registered proprietors' evidence

14. This consists of a Witness Statement dated 19 December 2001, and comes from Rupert Withers, manager of the band Oliver/Dawson SAXON.

15. Mr Withers outlines some of the history of SAXON following its formation in 1972, Mr Oliver and Mr Dawson being two of the founder members.. He refers to exhibit F which consists of a copy of a letter dated 26 January 1982 from Gibson, Wilkinson & Co, addressed to Steve Dawson. The letter refers to the "cessation of the SAXON partnership".

16. Mr Withers refers to the allegations that Mr Dawson and Mr Oliver, through various agencies, had attempted to stop use of the name SAXON by Mr Byford, saying that exhibit A being one instance where the reverse is the case. Mr Withers also refers to a letter dated 16 February 2000 (exhibit B) in which he makes it clear that the band is to be promoted as OLIVER DAWSON SAXON. Exhibit C appears to be a jewel case insert for a CD entitled Re:// Landed, again referring to OLIVER DAWSON SAXON. He says that the letter from TCM attributed to Graham Oliver was sent to venues without the knowledge or consent of the band. Mr Withers says that the letter exhibited by Mr Byford was sent by Mr Oliver, on behalf of the band, to a trader retailing items bearing images related to the band, and that this was done because the trader was infringing the copyright owned by EMI, details of which can be seen in a letter shown as exhibit G.

17. Mr Withers says that it is clear that contrary to the evidence of Mr Byford, Graham Oliver and Stephen Dawson have not been passing themselves off as the band SAXON. He refers to exhibit H which consists of a letter expressing an opinion from counsel that advertising themselves as OLIVER DAWSON SAXON (with sufficient prominence given to OLIVER DAWSON) did not amount to passing off. The letter also gives an opinion on the legal status of SAXON prior to, and after Mr Oliver's departure, namely, that it was a partnership at will.

18. Mr Withers goes on to say that in the late 90's, Mr Oliver, Mr Dawson and Mr Peter Gill (another of the founder-members of SAXON) with two others, performed and released a recording under the name Son of a Bitch, the original name of SAXON. He continues saying that since Mr Oliver's departure, 15 albums have been released featuring the original partnership, or line-ups featuring Mr Oliver and Mr Dawson, mainly as re-releases, compared to 3 albums released by Mr Byford. Mr Withers says that this goes to show that the "classic" SAXON is as important, if not more so, than the current bands, and that all of the original partners have each signed an agreement to release a new album of archive material.

19. Mr Withers says that the name SAXON had been registered on advice following the lapsing of the registration of SAXON as a company name, the certificate of which is shown as exhibit E. He says that the application to register the mark was made in good faith and with the full knowledge of the original partnership, and had been done on behalf of and to protect the rights of the "original" partnership, a claim that he repeats at various stages of his statement.

20. Much of the following paragraphs give an account of how Mr Withers and his advisors see the position under the law, concluding that this should be determined as if the group were a partnership, and that by trading as OLIVER DAWSON SAXON, Mr Oliver's group could not be found to be passing themselves off as the "original" SAXON. He goes on to give his views and opinions on the ongoing dispute between Mr Byford and Messrs Oliver and Dawson, much of which, in the absence of conclusive evidence, has little or no relevance to these proceedings.

21. Mr Withers disputes the relevance of the trading position of the band in the 1980's, saying that it is clear from the evidence that both Mr Oliver and Mr Dawson were involved with the band for some or all of that time, and that as shown by exhibit I, in the time since their (and Mr Gill) leaving, the sales of recordings from the band has diminished.

Applicant's evidence in reply

22. This consists of a Witness Statement dated 25 February 2002 from Peter Byford.

23. Much of Mr Byford's statement is either opinion, gives his version of past events, including the High Court action, or his views on the activities of Mr Oliver and Mr Dawson, most of which are either denied or contradicted in the registered proprietors' evidence. In the absence of evidence or cross examination I do not consider that such information has any real relevance in determining the question over the registration of the name SAXON as a trade mark, and whilst I have noted the content I do not propose to summarise it in detail.

24. Mr Byford notes that Mr Oliver and Mr Dawson have performed under the name OLIVER DAWSON SAXON, commenting that this is at odds with their claim to have a legitimate interest in the name SAXON and is clearly only to assist their bargaining position. He says that the renewed interest in the bands' back-catalogue is a result of the success of his own band, and also directly benefits Mr Oliver and Mr Dawson who are entitled to a share of the royalties.

25. Mr Byford disputes that the original SAXON was a partnership, saying that even if it were, it would have been dissolved each time a member leaves, resulting in a separate goodwill but with a right to use the name SAXON. He says that he, nor other members of his band were aware on the application to register the name as a trade mark, and that the fact they were advised by their legal advisers to do so is further evidence that they did so as a result of the dispute.

26. Exhibit PB1 consists of a quantity of material, such as features on the performances and recordings of SAXON (Mr Byford's) play-lists from radio stations, all directed at showing that the band is, and has been active. Exhibit PB2 consists of an exchange of e-mails concerning what appears to be a copy of an advertisement promoting a performance of SAXON, said to be the OLIVER DAWSON SAXON, although this is not stated on the poster. Exhibit PB3 consists of a letter confirming that Walker Morris no longer represents Mr Oliver in proceedings before the United Kingdom Trade Mark Registry.

27. That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

28. As a preliminary issue Mr Norris questioned whether Mr Withers had the right to appear before the tribunal. The basis of the objection is that the Trade Marks Registry falls within the Courts and Legal Services Act 1990 (CLSA), under Section 27 of which, only a litigant in person (proprietor, opponent, applicant) or a suitably qualified professional may address the court, or in this case, the tribunal. I referred Mr Norris to Section 82 of the Trade Marks Act 1994, which is as follows:

Trade mark agents

“82. Except as otherwise provided by rules, any act required or authorised by the Act to be done by or to a person in connection with the registration of a trade mark, or any procedure relating to a registered trade mark, may be done by or to an agent authorised by that person orally or in writing.”

29. Even though the section is headed Trade mark agents, there is nothing in the wording that restricts the representation in proceedings before the registrar to a person who habitually and professionally acts as an agent in proceedings involving trade marks. No authorities directed to the point were drawn to my attention. In accordance with Rule 52 of the Trade Marks Rules 2000, a Form TM33 had been filed notifying the registrar that Mr Withers was authorised to act as the registered proprietors' agent.

30. I informed Mr Norris that notwithstanding the CLSA, a hearing before the Registrar is not the Court and has always been considered and intended to be a more informal arena for the resolution of disputes, and I was not prepared to deny the applicant the opportunity of a fair hearing. On the principles of natural justice it must, within reason, be open to a party to use a representative of his choosing. After advising Mr Withers of the requirements placed upon him in presenting his case, I directed that he should be allowed to make submissions on behalf of the applicant for invalidation.

31. Turning to the ground under Section 5(4)(a). That section reads as follows:

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

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

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.”

32. It has been established (see ATTABOY [0/156/97]) that the position in relation to a claim for passing off should be considered as at the date of application. However, in his evidence Mr Byford refers to the passing off as having commenced shortly after Mr Oliver departed from the group in January 1995, nearly three years prior to the date on which the application to register SAXON was made. The Act itself makes no mention of the date at which the matter must be considered. However Section 5(4)(a) is based on Article 4.4(b) of the Directive (89/104/EEC) which reads as follows:

"4. Any Member State may furthermore provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:

(a)

(b) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark and that a non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark;" (my emphasis)"

33. I have not been asked to look at the matter as at the time the act of passing off is said to have first occurred. However, if the applied for mark is also in use at that date, then that use also needs to be taken into account in order to determine whether, for instance, an antecedent or concurrent right exists, and if that is the case the test may require consideration of the position at the earlier time too.

34. Mr Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* case (1998 RPC 455) set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature
- (b) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

35. To the above I add the comments of Pumphrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, and others* (the *Reef* case) [2000] RPC 19, in which he said:

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

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

36. That a reputation and goodwill exists in the name SAXON does not seem to be in dispute; it is the ownership of that which is in contention. Mr Byford says that any reputation and goodwill remains, and always has remained with the “original” group, whereas Mr Oliver contends that the “original” group constituted a partnership and that in the absence of any agreement to the contrary, each member owned and retained a share of the assets of the band, including any reputation and goodwill, seemingly regardless of the length of time that had elapsed since their departure from the band.

37. Many of the facts of this case are not disputed. In 1978 a group of musicians performing under the name Son of a Bitch changed the name of the group to SAXON. The members at that time were Graham Oliver, Paul Quinn, Steve Dawson, Peter Byford and Peter Gill. The re-naming was at the behest of their then record company, and it is Mr Byford who says that

he came up with the name SAXON, a claim that is not disputed. When asked Mr Norris accepted that at the time SAXON came into existence it probably constituted a partnership at will.

38. The group released its first recording, entitled SAXON in 1979. This was followed by a second album entitled Wheels of Steel in 1980, that achieved some 250,000 in sales and was backed up by a series of live performances. Mr Byford says that when the album was being written it was agreed that the income derived should be split equally amongst the band members, and that each was paid a basic salary, initially at £600 per month. Another album followed six months later under the title Strong Arm of the Law. Nothing is said about the financial arrangements so I can only assume that they remained the same.

39. Mr Byford says that between 1980 and 1983 SAXON did an extensive sell-out tour of Europe, achieving record sales of over 1 million. During this time, Peter Gill left SAXON (1982), the band signed to another company with each member receiving a lump sum of £6,000 as well as their salary which by that time had risen to £1,000 per month. Further albums followed; Crusader (1984), and Innocence is no excuse (1986) from which the royalties were split according to the creative input. Individual salaries were still being paid.

40. In 1986, Steve Dawson was sacked from SAXON and replaced by Paul Fasker-Johnson who was sacked in 1988. Tim (Nibbs) Carter joined SAXON in 1988/9. Mr Byford gives the impression that by this time the band were not recording, and apart from a small tour of the United Kingdom were all but inactive. However, he later says that in this period the band had signed another record contract and released the album Solid Ball of Rock, had set up a limited company to manage the bands finances, and appointed a tour manager.

41. Mr Byford also says that after 1990, he, Graham Oliver, Nigel Glocker, Paul Quinn and Timothy Carter performed together (presumably as SAXON), but by 1992 the band were effectively operating as sole-traders with each member being paid directly by the promoters and responsible for preparing their own accounts, and taxed separately. Mr Byford also says that in 1991 a new publishing deal paid royalties individually to the group members.

42. Mr Oliver appears to have been dismissed from the group in January 1995, and went on to form a group under the name "Son of a Bitch", but according to Mr Byford's evidence, which has not been disputed, promoting itself as, or by reference to SAXON. From the evidence it would appear that this association was by use of various names, including Oliver/Dawson SAXON, SAXON-Son of a Bitch tour and SAXON- the early years. Mr Byford says that Mr Oliver's group had attempted to perform under the name SAXON, but that "on each occasion we managed to stop him doing this by letters which warned of legal action...". The applicant also make reference to the style of script used by Mr Oliver's group, saying that it is identical to that used by the "original" group. The evidence shows that from its early days the "original" SAXON had represented the word SAXON, for example, on the covers of sound recordings and promotional posters, in a form of Gothic script with a stylised letter "S". The evidence, in particular exhibit C to Mr Wither's statement, show that Mr Oliver's group uses the same style.

43. Mr Oliver and Mr Dawson (another member of Son of a Bitch and founder-member of SAXON) claim not to have performed as SAXON, but as OLIVER DAWSON SAXON, which they say that they are legitimately entitled to use as it distinguishes them from the original SAXON. Exhibit C referred to above consists of what appears to be an insert for a CD jewel case, and whilst it is indeed attributed to OLIVER/DAWSON SAXON, the words OLIVER/DAWSON are somewhat less prominent than the word SAXON, and could be overlooked, and particularly so given the style of font in which SAXON is shown.

44. So where does this leave us? There is some dispute as to whether the group SAXON constituted a partnership, or was a group of sole traders working together. Whatever is the case, I do not consider that the answer affects the rights to the name SAXON.

45. In the *Al Bassam* trade mark case [1995] RPC 17, Morritt L.J. looked at the question of proprietorship of an unregistered trade mark in the following terms:

“Accordingly it is necessary to start with the common law principle applicable to the question of the ownership of unregistered trade 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 of 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 such right of property would be protected by an injunction restraining any other person from using the mark.”

46. There is no suggestion any other person had previously used the name independently of the group, the earliest established use is by the group. On the basis of the above case the group would be regarded as the proprietor. However, as an unincorporated body the rights in the name rest with each individual member at the time of first use.

47. As to whether at the time of its formation the group SAXON constituted a partnership. It would seem that there was an open-ended intention that the group would operate for the profit of its individual members. I have no evidence of there being an agreement establishing partnership or regulating its operation, matters were seemingly left on an informal basis. If I were to accept that at its formation the group SAXON constituted a partnership at will, would this affect the proprietorship question? In my view the answer is no. The operation of a partnership is governed by the Partnership Act 1890, Section 20.(1) of which states the following:

“20.-(1) All property and rights and interests in property originally brought into the partnership stock or acquired whether by purchase or otherwise, on account of the firm, or for the purposes and in the course of the partnership business, are called in this Act partnership property, and must be held and applied by the partners exclusively for the purposes of the partnership and in accordance with the partnership agreement.”

48. It would seem, therefore, that although Mr Byford’s claim to be the originator of the name SAXON is not disputed, this does not, in itself, give him any rights to the name. It was

brought into the “partnership” for the purpose of it carrying on its business, and in the absence of any agreement to the contrary, would be regarded as partnership property with the rights being jointly owned by the individual members of the partnership, that is, Graham Oliver, Paul Quinn, Steve Dawson, Peter Byford and Peter Gill.

49. The position, therefore, is regardless of whether SAXON were a group of sole traders operating under a common name, or a partnership at will, the rights in the name SAXON and the goodwill accrued, would be owned by each individual member of the group, in the case of the founder-members, from the time that the name was first used. As members of the group departed and were replaced, each new member would accrue rights in the name, but only from the date that they joined. The departing member would retain their rights, that is, unless through action or inaction they somehow severed themselves from that right.

50. Having established that Mr Byford, Mr Oliver and Mr Dawson had rights originating from the same date, what is the position at the relevant date. Mr Dawson departed from the group in 1985 and did not have any active involvement with the name SAXON for over a decade. That he was a founder-member of the original group would be a fact known to long term fans, and may have become known to those who supported the group even after his departure, but so would the fact that he had left the group have been common knowledge. Re-issues and back-catalogue issues of recordings on which Mr Dawson had performed may have contributed to the maintenance of some of his goodwill, but the evidence relating to such events is scant. I would therefore conclude that by the time he became involved with Mr Oliver, a decade later, Mr Dawson’s rights to the goodwill in the name SAXON are likely to have diminished, but not dissipated.

51. The position with Mr Oliver is somewhat different. He was involved with SAXON until 1995, and approaching only three years prior to 6 November 1997, the relevant date in these proceedings. Between 1995 and November 1997, Mr Oliver performed with a group by the name of “Son of a Bitch”, but promoting itself as, or by reference to SAXON, including Oliver/Dawson SAXON, SAXON-Son of a Bitch tour, SAXON- the early years, and even attempted to do so under the name SAXON solus, but was prevented by threat of legal action. As I have previously mentioned, the applicant refers to the style of script used by Mr Oliver’s group, namely a form of Gothic font with a stylised letter S which is identical to that used by the “original” group, a fact that cannot have escaped the public and heightened the association, which was no doubt the intention.

52. On these facts I do not consider that Mr Oliver could be considered to have severed his contact with his rights in the name and goodwill of the “original” SAXON, and accordingly, at the time that he made the application, he had every right to claim to be, if not “the”, then certainly “a” proprietor of the mark. The position would not be any different if considered at an earlier date. That Mr Oliver’s group sought to differentiate themselves from the “original” SAXON appears to have been on advice whilst matters were being determined. I do not consider that in doing so he relinquished his rights, nor that I can infer from this that he was acknowledging the weakness of his claim. The fact that Mr Byford’s group may be considered as the “original” band or have been using the name on its own for a longer period

of time does not take away this right. Likewise there was no reason why other members of the group could not have made an application to register the name, but if challenged their right to do so would have subject to the same scrutiny as Mr Oliver's has been.

53. The provisions of Section 5(4)(a) allow for a proprietor of an earlier right in relation to the trade mark to prevent the use of a later trade mark. The problem for the applicant is that he has a right to the goodwill in the name SAXON, but from the same date as the registered proprietor, and consequently, cannot succeed in a claim for passing off under Section 5(4)(a). The ground is dismissed accordingly.

54. This brings me to the ground under Section 3(6). That section reads as follows:

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

55. In the case of *Gromax Plasticulture v Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J said the following in regards to bad faith:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes 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. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

56. In the *Demon Ale* trade mark case [2000] RPC 345 , Geoffrey Hobbs QC, sitting as the Appointed Person said:

*“I do not think that Section 3(6) requires the applicants to submit to an open-ended assessment of their commercial morality. However, the observations of Lord Nicholls on the subject of dishonesty in *Royal Brunei Airlines Sdn Bhd v Philip Tan* [1995] 2 AC 378 (PC) at page 389 do seem to me to provide strong support for the view that a finding of bad faith may be fully justified even in a case where the applicant sees nothing wrong in his own behaviour.*

These observations recognise that the expression “bad faith” has moral overtones which appear to make it possible for an application for registration to be rendered invalid under Section 3(6) by behaviour which otherwise involves no breach of any duty, obligation, prohibition or requirement that is legally binding upon the applicant.”

57. Mr Withers repeatedly says that the trade mark was registered for the benefit of all of the “original” group, a statement that could be taken to be at odds with some of the evidence. That evidence may well be disputed, but it has not been established as being false. But even if

Mr Oliver and Mr Dawson had not registered the mark for the good of all, could the act of doing so be said to be an act of bad faith?

58. On the facts before me, it is my view that Mr Oliver, and arguably, Mr Dawson, had as much right to claim to be the owners of the mark in suit, albeit not exclusively, to seek to register the mark in their own names and to prevent use of the mark by third parties. However, what is good for one is good for the other. I consider that Mr Byford also had the right to regard the trade mark as his own, and to seek register it in his own name, should he so wish. The problem now is that Mr Oliver has got there first. Taking all factors into account I do not consider that in making the application to register the trade mark Mr Oliver acted in bad faith, and the ground under Section 3(6) also fails.

59. The application having failed, the registered proprietors are entitled to an award of costs. I therefore order the applicant to pay to the registered proprietors the sum of £1,500 as a contribution towards their costs. This sum 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 8th day of November 2002

**Mike Foley
for the Registrar
The Comptroller General**