

o/0140/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE TRADE MARK APPLICATION NO. 3834929

BY BRINSLEY FORDE

TO REGISTER THE FOLLOWING TRADE MARK

**ASWAD**

AND

OPPOSITION THERETO UNDER NO. 438539 IN THE NAME OF

DENNIS ANTHONY ROBINSON

AND

IN THE TRADE MARK APPLICATION NO. 3836580

BY DENNIS ANTHONY ROBINSON

TO REGISTER THE FOLLOWING TRADE MARK

**ASWAD**

AND

OPPOSITION THERETO UNDER NO. 439808 IN THE NAME OF

BRINSLEY FORDE

## **Background and pleadings**

1. This case relates to a dispute between band members concerning the right to use the name of the band ASWAD, which has had a changing line up of members during its lifetime.

### **Opposition no. 438539**

2. On 30 September 2022, Mr Brinsley Forde applied to register ASWAD as a trade mark numbered 3834929, in the UK. It was accepted and published for opposition purposes on 14 October 2022 for the following goods and services:

Class 9: Music recordings; Musical recordings; Musical video recordings; Downloadable music files; Downloadable digital music; Musical sound recordings; Prerecorded music videos.

Class 35: Merchandising; Inventorying merchandise; Product merchandising; Business merchandising display services; Display services for merchandise; Product merchandising for others; Preparing promotional and merchandising material for others.

Class 41: Music concerts; Musical performances; Music publishing and music recording services; Music performances; Music recording; Music production; Music publishing; Musical entertainment; Music festival services; Musical education services; Live musical concerts; Live musical performances; Music publishing services; Musical entertainment services; Performance of music; Musical instruction services; Live music concerts; Live music performances; Music production services; Music group services; Music transcription services; Musical performance services; Music composition services; Music concert services; Live music services; Music competition services; Musical concert services; Recording of music; Live music shows; Production of music; Publication of music; Publishing of music; Music entertainment services; Music performance services; Music mixing services; Organisation of musical competitions; Arranging of musical events; Rental of musical instruments; Arranging of musical entertainment; Organisation of musical concerts; Production of music concerts.

3. On 10 January 2023, Mr Dennis Anthony Robinson opposed the application under section 5(4)(a) of the Trade Marks Act 1994 (“the Act”) relying on the unregistered sign ASWAD which he contends he has used throughout the UK and worldwide since 1975 for goods and services in classes 9, 35 and 41 (as set out further below). In support of his claim, Mr Robinson contends:

“Aswad are a British Reggae group who have been performing since the mid 1970s. [Brinsley Forde] was a member of the group together with Mr Anthony Robinson and Angus Gaye until [Brinsley Ford] left in 1996. Since 1996 the group have extensively toured the UK as Aswad and released further albums and records in both the UK and Germany. [Brinsley Forde] has not performed as a member of Aswad for a period of 26 years but following the death of Angus Gaye on 2 September 2022, has now filed an application ... to register a trademark in the name of Aswad.

As a result of its activities in the last 26 years, Aswad has a significant reputation and goodwill in the United Kingdom and worldwide. Should [Brinsley Forde] attempt to pass himself off as Aswad, this would constitute a misrepresentation to the public that the goods and services offered by [Brinsley Forde] are the goods and services of Aswad as had been the case for the last 26 year.... [resulting in] damage caused to Anthony Robinson who for an uninterrupted period of 46 years has owned, performed as the group known as Aswad. The damage will be caused by reason of the erroneous belief engendered by [Brinsley Forde]’s misrepresentation that the source of the goods and services are the same source offered by Aswad. Accordingly, any use of [Brinsley Forde]’s trademark would be contrary to law, particularly of passing off.”

4. Mr Forde filed a defence and counterstatement denying Mr Robinson’s claim and putting him to strict proof. In summary he claims that he is the founding member of ASWAD and has never passed ownership of the name or trade mark to Mr Robinson nor has he ceased to own or use the name, which has been uninterrupted and continuous for forty-nine years.

**Opposition no. 439808**

5. On 6 October 2022, Mr Robinson applied to register ASWAD as a trade mark numbered 3836580, in the UK. It was accepted and published on 23 December 2022 for the following goods and services:<sup>1</sup>

Class 9: Downloadable digital music; Downloadable musical sound recordings; Music recordings; Musical video recordings; Downloadable video recordings featuring music; Musical recordings in the form of discs; Pre-recorded CDs featuring music; Pre-recorded DVDs featuring music; Musical sound recordings.

Class 35: Merchandising; Product merchandising; Preparing promotional and merchandising material for others; Product merchandising for others; Business merchandising display services; Inventorying merchandise; Display services for merchandise.

Class 41: Music concerts; Live music concerts; Musical performances; Live musical performances; Music publishing and music recording services; Music recording; Music production; Musical entertainment; Music festival services; Musical education services; Musical entertainment services; Performance of music; Musical instruction services; Music composition services; Music concert services; Live music services; Music competition services; Musical concert services; Recording of music; Live music shows; Production of music; Publication of music; Publishing of music; Music performance services; Music mixing services; Organisation of musical competitions; Arranging of musical events; Rental of musical instruments; Arranging of musical entertainment; Organisation of musical concerts; Production of music concerts.

6. On 20 March 2023, Mr Forde filed opposition proceedings against the application under section 5(4)(a) of the Act, relying upon his unregistered sign ASWAD which he says he has used throughout the UK and worldwide since 1974 for the same list of goods and services as per his application outlined in paragraph 2.

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<sup>1</sup> The goods and services specification are identical to those relied upon for his section 5(4)(a) claim.

7. In support of his claim, he states that:

“ASWAD are a British reggae group, which has been performing since the mid-1970’s, has released over 30 albums, and received two Grammy nominations.

[Mr Robinson’s] claim to own or use the name ASWAD would be contrary to law because Brinsley Forde MBE... is the founding member of ASWAD; the name and band was [his] creation and [he] has never passed ownership of the name or trademark to [Mr Robinson], nor has he ever ceased to own or use the name.

[...]

As a result of Brinsley Forde’s hugely significant creation of and contribution to the band, ASWAD has a significant reputation and goodwill throughout the UK and worldwide, which is based predominantly on Brinsley Forde’s image and presence within the band. Fans and supporters of the band see Brinsley Forde and ASWAD and intrinsically one of the same. Perhaps an indication of this is Brinsley Forde being appointed Member of the Order of the British Empire in 2015 for services to the arts. The central part of Brinsley Forde’s nomination was recognition by esteemed colleagues across the music industry that ASWAD was a creation of Brinsley Forde, and an acknowledgement of what his creation had brought to the reggae industry in Britain. No other participating members of ASWAD have received such personal recognition for ASWAD’s success.

[...]

Should ... Anthony Robinson, obtain the name ASWAD and try to pass himself alone off as ASWAD, this would undoubtedly constitute a misrepresentation to the public that the goods and services offered by [Anthony Robinson] are the goods and services of ASWAD as formed by Brinsley Forde since 1974, and continued as such for almost fifty years. In the event that [Anthony Robinson] attempts to supply goods and services in the name of ASWAD, severe damage will be caused to Brinsley Forde MBE, who for an uninterrupted period of forty-nine years has owned and performed as the group ASWAD. The damage will be caused by reason of the erroneous belief engendered by [Anthony Robinson]’s misrepresentation that the source of [his] goods and services are

the same source as those offered by ASWAD. Accordingly, any use of the [Anthony Robinson]'s trademark would be contrary to law, particularly the law of passing off.”

8. On 23 June 2023, Mr Robinson filed a defence and counterstatement denying the section 5(4)(a) claim and putting Mr Forde to strict proof. Whilst he accepts that Mr Forde was and always has been a founding member of ASWAD it is said that he left the band in 1996 and has not performed as a member of the band for over 26 years, with the exception of a one-off gig in 2009. Further, he contends that Mr Forde's application for a trade mark only came as a result of Mr Angus Gaye's (the third member of the band) death in September 2022.

9. The proceedings were consolidated on 29 June 2023 and the parties were notified by way of letter on that date.

### **Evidence and representation**

10. Both parties filed evidence. Mr Robinson's evidence consists of his witness statement dated 25 August 2023 and the witness statement of Les Spaine dated 26 October 2023 accompanied by one exhibit marked LS1. Mr Forde's evidence consists of two witness statements. The first dated 28 August 2023 accompanied by exhibits marked 'ITEM A-L' and the second dated 30 October 2023.

10. A hearing was requested and held before me on 15 May 2024 by video conference at which Mr Forde represented himself and Mr Robinson was represented by Ms Stephanie Wickenden (counsel) instructed by EBL Miller Rosenfalck. Both parties filed skeleton arguments/written submissions prior to the hearing.

### **Preliminary issues**

#### **Bad faith**

11. Whilst both parties referred to a claim of bad faith in their respective statements accompanying their pleadings, neither have formally brought a claim under section 3(6) of the Act. Ms Wickenden confirmed at the hearing that Mr Robinson was not pursuing any bad faith claim nor making an application to amend his pleadings to introduce this ground. Mr Forde confirmed that he was not making any comparable application. Consequently, I shall disregard any submissions advanced in relation to

bad faith by either party and determine the matter on the ground of opposition as pleaded by both, namely that brought under section 5(4)(a) only.

#### General Observations as to the respective allegations

12. Other than the parties' respective accounts of their recollection of events, which in some parts is over 50 years old, the documentary evidence to support their positions is rather sparse. Neither side made any request to cross examine the other and so this decision is taken based on the witness statements and the limited documentary evidence before me. Mr Forde and Mr Robinson's accounts as to how the band was formed, the membership of the original line-up, who was responsible for bringing the band members together and how they knew each other in the early years, differs. However, whilst there have been some discrepancies and inconsistencies with various dates from both sides, for the most part, the parties' accounts as to who the members of the band were at the relevant points in time, do not differ greatly.

13. Further, the basis of Mr Forde's claim originates from his misplaced belief that he has a greater entitlement to the name ASWAD purely because he is the founding member and in his view the creator of the band. However, as per settled caselaw a founding member has no greater entitlement to the name over the other members, purely based on this fact alone. I will address this in greater detail below.

14. Throughout the parties' evidence, both rely on discussions they have had with third parties who have not provided witness statements in these proceedings. These discussions with third parties are what is called hearsay evidence. Whilst this type of evidence is generally considered inadmissible in legal proceedings, it is admissible in civil proceedings and proceedings before the Registry. In so far as this evidence is concerned, however, the weight I place on it and its relevancy will still need to be assessed when making any findings of fact.

#### Evidence

15. Given the nature of the respective claims to the unregistered sign/name ASWAD, I shall consider the evidence filed collectively, in order to determine finding of facts and what each party's position was as at the relevant dates. I hasten to add that I have read and considered all the evidence and submissions (both oral and written) relating

to these proceedings, but I shall only refer to them to the extent that I consider necessary.

### **Mr Robinson's evidence**

16. Mr Robinson's statement sets out the background of the membership and use of the name ASWAD and the ownership of the goodwill.

17. He states that the parties were members of a band that performed under the name ASWAD ("the band"). The band was formed in or around 1972. Whilst Mr Robinson did not form part of the original lineup, he was involved with the band periodically from the start and played on the demo tape sent to Island Records which ultimately resulted in a record deal being signed with them in 1976. He accepts that he was not a signatory to this original record contract. The band's first album titled 'Aswad' was released in 1976. The lineup of the band at this time was George Oban, Angus Gaye, Brinsley Forde, Donald Griffiths and Courtney Hemmings.

18. Shortly after the release of the band's first album, Courtney Hemmings left the band and Mr Robinson replaced him.

19. In 1978, the band released their second album 'Hulet'. Shortly after the release of this album, George Oban left, and the following year so too did Donald Griffiths.

20. From this point onwards the three official members of the band consisted of Mr Forde, Mr Robinson (aka 'Tony Gadd') and Mr Gaye (aka 'Drummie'). This combination of members recorded music, performed and toured under the name ASWAD in the proceeding years. Whilst enjoying some commercial success they did not achieve any national chart hits and so were subsequently dropped by their record label.

21. In 1985 the band appointed a new manager namely Mr Les Spaine. He was said to have taken the band in a new direction and negotiated a new record deal with Island Records. It is said that from the mid 1980's onwards, the band enjoyed its most commercially successful period. In respect of financial matters, each member enjoyed equal rights irrespective of who wrote the songs. Royalties were and continued to be paid equally between all members for music released during their membership. The band released an album called 'Distant Thunder' from which the single 'Don't Turn Around' was released, scoring the band a number one hit in the national Top 40 charts.

Mr Robinson states that Mr Angus Gaye provided the lead vocals to this song which created some tension with Mr Forde, as ordinarily he was the lead vocalist.

22. In 1991, the band parted company with Mr Spaine. The group continued to perform and record as a trio releasing the singles 'Shine' and 'Give a Little Love', both of which scored in the top 10 UK charts in or about 1994. In 1995 whilst recording the video for their song 'One Shot Chiller' Mr Forde decided that he wanted to leave the band to pursue solo ventures. Whilst he played and sung on the recording, he did not participate in the video accompanying the single. Despite trying to persuade him to stay, Mr Robinson states that Mr Forde left the band in 1996 before the single was released. Mr Robinson states that this was the last single released by ASWAD featuring Mr Forde. Shortly after Mr Forde's departure, Mr Spaine was re-hired as the band's manager (which I understand to be in or around 1996/1997).

23. Mr Robinson states that when Mr Forde left, they agreed to go their separate ways, with Mr Forde performing as a solo artist under his own name and Mr Gaye and Mr Robinson carrying on with ASWAD, continuing to perform, record and tour under the name. In so far as Mr Robinson and Mr Gaye were concerned, this position continued for the next 26 years. Throughout this whole period, Mr Forde had not expressed any desire to rejoin the band or perform under the guise ASWAD.

24. After Mr Forde's departure the band only came together on two occasions. The first in 2000, to receive a Lifetime Achievement Award at the MOBO<sup>2</sup> awards ceremony. The second in 2009 when they performed together in a one-off tribute concert held for Island Records' 50<sup>th</sup> anniversary. Mr Robinson states that the invitation to perform at the tribute concert was sent to Mr Spaine as the band's manager and it was Mr Robinson and Mr Gaye who extended an invitation to Mr Forde to reunite for the performance. During the performance and after the band had performed as ASWAD, it is said that Mr Forde continued to perform some songs in his own name, reinforcing that he remained a solo artist and was not a member of ASWAD.

25. After 2009, ASWAD (consisting of Mr Gaye and Mr Robinson) continued to perform and release records up until Angus Gaye's death in September 2022. When Angus

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<sup>2</sup> Music of Black Origin.

Gaye became ill his son Solomon Gaye covered his vocals, although it is said that Solomon Gaye had played with the band since 1994.

26. Mr Robinson denies that the 37 albums listed by Mr Forde were written exclusively by him. During each iteration of the band each member was given equal writing credits, and an equal share of the royalties which continues to this day. From 1976 to 1996 Mr Forde, Mr Robinson and Mr Gaye each shared the royalties equally for their contributions. From 1996 onwards, any new ASWAD compositions were credited and royalties paid to Mr Gaye and Mr Robinson.

27. Mr Robinson denies that ASWAD have made any use of the image of Mr Forde in promoting ASWAD since he left in 1996.<sup>3</sup> Any images of Mr Forde appearing after 1997 was always in the context of being a former member and none were used by ASWAD directly.

#### **Mr Spaine's witness statement**

28. Mr Spaine states that he is the Chief Executive Officer of Spaine Music Company Ltd. He states that he became ASWAD's manager in 1985. He confirms that the members of the band at this time were Mr Forde, Mr Gaye and Mr Robinson. Before being their manager, the band had enjoyed limited success, and by the time of his appointment they had lost their record deal with Island Records. He confirms that a new record deal was re-negotiation in 1986, and it was this period that was the band's most successful, with a run of hit singles and albums earning them international acclaim. He confirms that the single 'Don't Turn Around' was released in 1988 and became a number one hit in the UK national charts.

29. Mr Spaine states that following tensions within the band, Mr Forde left in 1996 and "made it quite clear that he wished to pursue a solo career".<sup>4</sup> It is said that his departure was widely reported in the media. Mr Spaine "produces a bundle of documents" at LS1 in support of this claim.

30. These documents consist of an extract taken from Wikipedia relating to the band ASWAD. Within this document the text confirms that Mr Forde left in 1996 "due to spiritual reasons".<sup>5</sup> The Wikipedia entry accords with Mr Robinson's iterations of the

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<sup>3</sup> Paragraph 28.

<sup>4</sup> Paragraph 5.

<sup>5</sup> Para 7 Pages 1-4 of exhibit LS1.

band and the history and background regarding the release of music. Mr Spaine confirms that Mr Forde only performed with ASWAD on one more occasion after this date, namely at the 'Island Anniversary Concert' in May 2009. This was a concert to mark the label's 50 year anniversary and included a week of concerts featuring Island's artists past and present.

31. Mr Spaine produces an extract of an interview given by Mr Forde in May 2009 to the publication 'The Voice/The Gleaner'<sup>6</sup> referring to ASWAD reuniting for Island's 50<sup>th</sup> anniversary.<sup>7</sup> Within the article Mr Forde is referred to as *"former Aswad member Brinsley Forde' reuniting with his band mates Drummie Zeb<sup>8</sup> and Tony Gad<sup>9</sup> for their first performance in almost 10 years, following Forde's split from the band in the mid-90s"* and *"..much loved singer says he's looking forward to joining forces with his former group members once again."* Mr Forde confirms that *"[he hasn't] played with the other members of Aswad for nearly 10 years now..."*. When asked 'why did you decide to leave the group?' Mr Forde replies *"My way of life is Rastafarian and I think the time just came for me to tread a different path"*. When asked 'was it a bad break up?' he continues (my emphasis) *"No. We were fortunate that we made a lot of decisions when times were good, so we didn't have the kind of break-up where we were all arguing or going through major problems. I signed over the rights [to the name Aswad] when I left, so it was all fine...The work we did together remains positive and the legacy remains positive. And who knows what may happen in the future?"* When asked *"Could the reunion be permanent?"* Mr Forde replies *"It's not something I see on the cards right now. But if it's meant to be, it will be. We all worked together on a Dennis Brown project some time ago - after we'd broken up- so there's no bad blood."*

32. After Mr Forde departed, Mr Spaine states that ASWAD continued to release new songs and albums and perform all around the world with great success. He refers to ASWAD's Facebook page which "presently has 5.2 thousand followers".<sup>10</sup> Further he states that the band under the name ASWAD has toured extensively in the last 26 years, playing at prestigious venues such as London's Royal Albert Hall. He confirms

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<sup>6</sup> The Voice is a subsidiary of The Gleaner Company Limited and is said to be Britain's leading Black newspaper.

<sup>7</sup> Exhibit LS1 pages 5-9.

<sup>8</sup> Mr Gaye.

<sup>9</sup> Mr Robinson.

<sup>10</sup> Paragraph 10.

that they (meaning Mr Gaye and Mr Robinson) have played thousands of gigs and built up a great deal of goodwill. Mr Spaine confirms that Solomon Gaye, although not a member of the band, took over lead vocals when his father became ill and has continued to do so after his death.

33. A list of “Aswad date sheets” dated between 2017 and 2024 is produced showing details of some of the dates where ASWAD have performed as a duo.<sup>11</sup> This list includes over 100 gigs/festivals/events in and around the UK, Europe, New Zealand, Dubai, and Guadeloupe. The list includes bookings at the following venues:

Butlins Skegness (February 2017), Cheltenham Racecourse (June 2017), Common People Festival Oxford (May 2018), Under the Bridge, Chelsea (October 2018), Tredegar Park, Newport (July 2018), Summer Solstice Festival Barnet (June 2019), BEC Arena, Manchester (November 2019), Pontins Southport March 2020, Letchworth Music Festival (July 2021), Silverstone Classic Towcester (July 2021), Reggae Land Milton Keynes (July 2022) and Butlins Bognor Regis (November 2022).

Date sheets for 2022, 2023 and 2024 are also produced showing the various ongoing obligations/bookings that the band were committed to. Mr Spaine states that the band performing under the name ASWAD continued to fulfil its contractual obligations after Mr Gaye’s death and refers to the sold out performance held at the Shepherd’s Bush Empire on 1 October 2022 as an example of this.

34. Mr Spaine refutes a number of Mr Forde’s claims particularly in relation to:

- the payment of royalties which he states were and always have been shared equally between the members.
- Mr Forde has always been acknowledged as a founding or ex member since his departure.
- Mr Forde has never during the 26 years since leaving the band attempted to register the trade mark in his own name or communicated his desire to do so.
- Mr Forde did not notify Mr Spaine of his intention to apply for the trade mark following Mr Gaye’s death. Mr Forde has played no party in ASWAD’s continuing success for the past 26 years.

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<sup>11</sup> Exhibit LS1 page 5.

## **Mr Forde's evidence**

35. Mr Forde's first witness statement is dated 28 August 2023. He provides background information as to the formation of the band and its membership at various times to include the periods referred to by Mr Robinson. Although there are some differences in the recollections of the parties, Mr Forde's account as to the relevant membership of the band and the dates the various members joined and departed on the whole accords with that of Mr Robinson.

36. Mr Forde confirms that the band was founded in the 1970s but also confirms that it released over 30 albums during its history and received two Grammy nominations.

37. Mr Forde states that he is "the founding member" of the band and the name ASWAD and the band is his creation. He provides an account of the reasons and ethos behind the band name. He states that Mr Robinson was not present when his creation began and was not a member of the original lineup when they signed the first record deal with Island Records in 1976, nor when they recorded the first album. He is emphatic in his view that Mr Robinson did not play on the demo tape sent to Island Records. Mr Forde produces a copy of extracts of the original recording contract dated 3 February 1976 (first record contract).<sup>12</sup> I note that Mr Robinson's name appears on this first contract, although he has not signed it. Mr Forde produces images of album covers and promotional material released at this time to confirm that Mr Robinson was not part of the original lineup or a signatory to the first contract.

38. Mr Forde confirms that the band under the name ASWAD supported Burning Spear's UK tour in 1977 and at this time they had two hit singles. He confirms that a live recording of the first show in London was released as an album namely Burning Spear Live. Later that year the band travelled to Jamaica to record at HJ's recording studio and played their first international performance in Caesar's Place, New Kingston. A rear cover image of the artwork of the album Burning Spear Live dated 1977 is produced. He states that Mr Robinson's name does not appear on the line up of the band at this time.

39. Mr Forde confirms that Mr Hemmings left the band on their return from Jamaica. He appears to confirm that Mr Robinson had been used as a session musician but

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<sup>12</sup> Exhibit Item B.

after Mr Hemmings left “he [became] an official full time member of Aswad... as a bass player.”<sup>13</sup> Mr Forde states that the timeline provided by Mr Robinson regarding when he joined is “simply untrue and unsubstantiated” and that “he wasn’t present until a few years into us being established”. Whilst Mr Forde states that there was evidence by way of interviews given by Mr Robinson over the years to support this, none are provided.

40. It is said that from the mid 1970’s onwards ASWAD went on to build a significant reputation and goodwill throughout the UK and worldwide which he states was based predominantly on his image and presence within the band. He states that his image is constantly used on promotional material for the band’s performances and that “*fans worldwide see me and ASWAD as one of the same*”. He states that the “*official Facebook fan page which is one of the largest promotional platforms for the band contains my image in numerous places. My image is also used to advertise their shows on Spotify etc. Worldwide true lifetime fans of the band and musicians influenced by the band say ASWAD and Brinsley Forde, are one and the same, one simply does not exist without the other.*”<sup>14</sup>

41. In support of this statement, he states that he received a Lifetime Achievement Award at the MOBO awards in 2000 and was also awarded an MBE in 2015 for services to the arts. It is said that a central part of this nomination was recognition by esteemed colleagues across the music industry that ASWAD was his creation.

42. In so far as the evidence that he left the band, he replies that his presence within the band has never ceased, and he has aided each member financially over the years. He states that in “1983 the bands publishing with April Music ended and he changed the Island publishing deal to reflect their previous April Music deal which became EMI and now Sony Music, where he first shared [his] royalties with [his] band members”. At exhibit ITEM D an extract of pages taken from the Music Publishing Contract between ASWAD and Island Records dated 5 October 1983 is produced. The preamble of the contract refers collectively to “Brinsley Forde, Angus Gaye, Tony Robinson (pka “ASWAD”) c/o Michael Campbell” as the writers and sets out the

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<sup>13</sup> Paragraph 14.

<sup>14</sup> Paragraph 17.

agreement regarding the grant and assignment of the copyright of the albums to Island Records. I note that Mr Robinson was a signatory to this contract.

43. Mr Forde states that his continued and uninterrupted use of ASWAD is further evidenced from a list of names of albums which he produces at para 20 of his statement. He states that approximately 85% of ASWAD songs were written by him and the other 15% were either covers or collaborations between all members.<sup>15</sup> I note that the first twenty-nine albums listed are dated between 1976 and 1997. Mr Forde acknowledges that Mr Robinson wrote four ASWAD albums dated between 1999 and 2009. In relation to the 2009 tribute concert, he states that the invitation from Island Records was sent to him and he was the one that invited the others to reunite.

44. Mr Forde states that many recent album releases have featured and used his images, to include Universal Masters Collection 1999, Gold 2020 Don't Turn Around Album 2006, Complete BBC Sessions 2008, Live at Rockpalast 2017 and Live at the BBC 2017.

45. In 2022, following Mr Angus Gaye's death, Mr Forde states that he "took the decision to solidify the ownership of my creation to ensure the legacy of ASWAD was maintained" by applying for the trade mark which he did as the sole creator of ASWAD and his belief that he continued to be a fundamental part of the band's success over the last five decades. He states that he has owned, performed and supplied goods and services in the name ASWAD for an uninterrupted period of forty-nine years.

46. He states that he put the parties on notice of his intended application and contacted Mr Spaine as to his intention to register the trade mark. (This is denied by Mr Spaine and Mr Robinson).

47. Mr Forde explains that Mr Robinson is mistaken regarding the sharing of royalties between all the members of the band in 1979. He states that the Album covers and single labels produced at 'ITEMS H1, 2, 3 and 4' clearly show that each song bore his name as the writer after the song title. He states that it wasn't until 1981 that he took the decision to share the royalties between all the members of the band in recognition of the contribution made by the other members to the success of the band. He believes he was entitled to take the lion's share but chose not to. He refers briefly to

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<sup>15</sup> Exhibit ITEM N.

unsuccessful disputes over the years where former members who have played a minimal part in the band have sought to claim royalties to which they were not entitled. No further details are provided.

48. Mr Forde produces email correspondence between himself and Major Reggae Recording and publishing companies as recently as 2021 discussing the shares and ownership rights over recent and historical ASWAD material. The document consists of a screenshot of four emails titled "Label Simba vs VP records". The emails are dated January 2021 and appear to relate to a query regarding the division of publishing rights relating to music titled "13 dead".<sup>16</sup> This document is said to show that Mr Forde has been at the forefront of ASWAD matters since its creation until present day.

49. Mr Forde explains that after Mr Gaye's death he had tried to arrange a tribute concert in honour of Mr Gaye which did not go ahead. It is said that he performed a "personal tribute to Angus Gaye at a small London venue". No further details are provided, as to whether he performed under the name ASWAD or in his personal capacity.

50. He states that his image was used to advertise a concert as recently as May 2023 on Spotify and new commercial releases. He states this strengthens the fact that his name is synonymous with ASWAD's promotion and successfully engages with fans. Mr Forde states that he had spoken to Mr Solomon Gaye regarding his application to register the trade mark and that he was not surprised given that it was Mr Forde who started ASWAD. Mr S Gaye told Mr Forde that he accepted he was not a permanent member of the band and was simply a session musician. Promotional images are produced in support dating from 1976.<sup>17</sup> However, it is not clear what these images are purporting to show, to draw any conclusions from them.

51. Mr Forde challenges Mr Robinson's claim that his image has not been used to promote the band and states that his image is the one that fans, promoters and the music industry, as a whole, see as synonymous with the ASWAD brand. He produces images of the following album covers by way of illustration:<sup>18</sup>

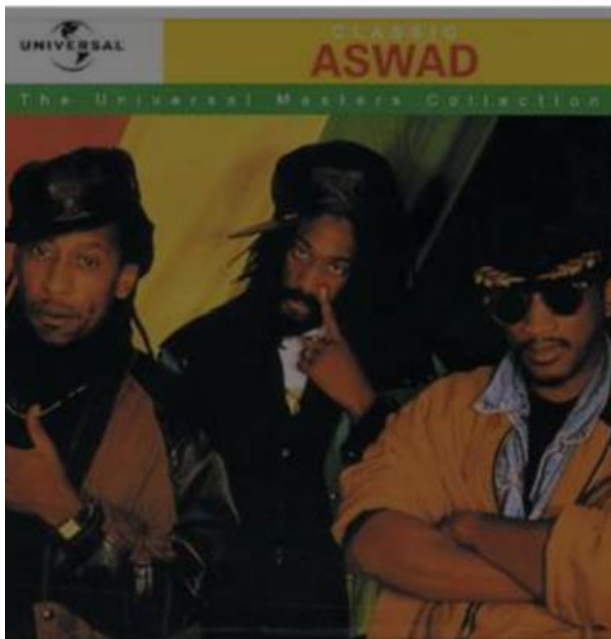
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<sup>16</sup> Exhibit ITEM M

<sup>17</sup> Exhibit ITEMS K1 and K2.

<sup>18</sup> Exhibits ITEMS J2 – J5.

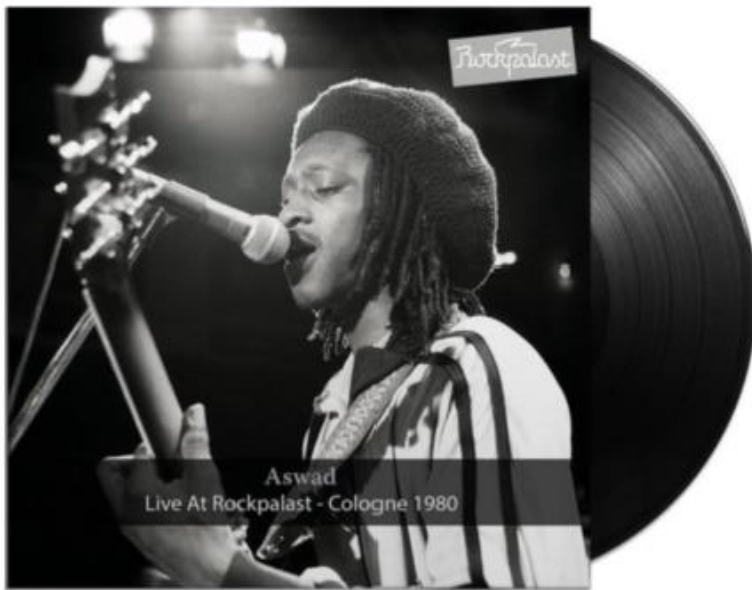
EVIDENCE ITEM J2: 1999 album release The Universal Masters Collection



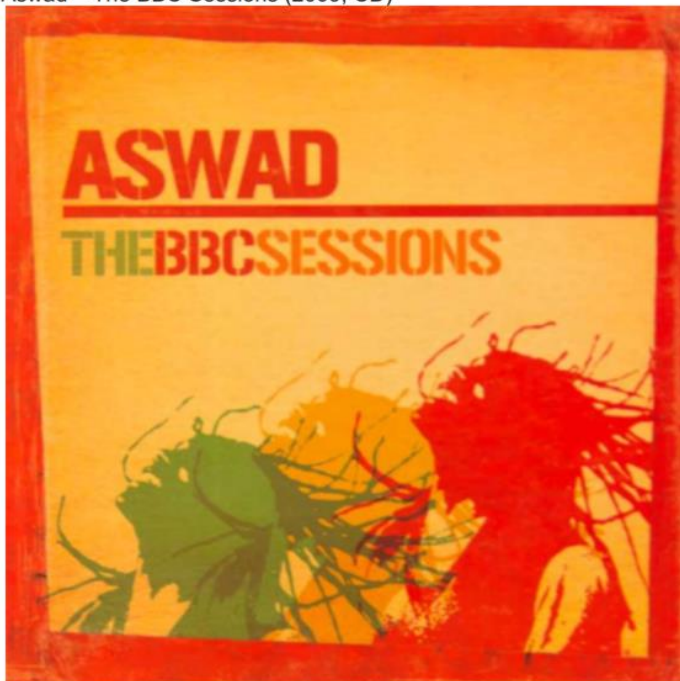
EVIDENCE ITEM J3: 2020 album release Aswad Gold



EVIDENCE ITEM J4: Album release Live at Rockpalast



EVIDENCE ITEM J5:  
Aswad – The BBC Sessions (2009, CD)



52. Mr Forde’s second statement dated October 2023 serves to predominantly refute parts of Mr Robinson’s evidence and to reaffirm the evidence he gave in his first statement as to his recollection of events.

## **Various iterations of the band and findings of fact**

53. I consider it appropriate at this stage to outline the various lineups of the band at the relevant periods to include any findings of fact based on the evidence filed as to the membership of the band at any given time.

### 1972-1976 - First Iteration

54. The parties agree that the band was formed in or about 1972 performing under the name ASWAD with both Mr Gaye and Mr Forde being founding members. The band entered into a record deal with Island Records and signed their first recording contract on 3 February 1976. The signatories of that first contract were Angus Gaye, Brinsley Forde, George Oban, Donald Griffiths and Courtney Hemmings. I find that these individuals formed the original line up of the band credited with all recordings at this time. The contract appears to confirm that the advance and royalties were split equally between these signatories. There is no evidence to support Mr Forde's claim that he was paid 85% of all royalties to reflect his share of the writing credits. Whilst it is accepted by both parties that Mr Robinson was not a signatory to this contract, I find that his presence in the band at this time was sufficiently established to have been named on the draft contract. I find that Mr Robinson was regularly performing with the band during this early period but was not a permanent member of this first iteration when a record deal was signed.

### 1976-1979 – Second iteration

55. At some point during this period, Courtney Hemmings departed, and it is accepted that he was replaced by Mr Robinson. The parties agree that the membership of the band consisted of Angus Gaye, Brinsley Forde, George Oban, Donald Griffiths and Mr Robinson when the second album Hulet was released in either 1978 or 1979.<sup>19</sup> George Oban departed in either 1978 or 1979, after the release of this second album. Donald Griffiths departed the following year (1979/1980). Whilst Mr Forde disputes that Mr Robinson was named on the Burning Spears album in 1977 and had not been a member since 1976, he accepts that he was listed as a performer on the Hulet album. The Wikipedia entry dates the release of the Hulet album as 1978 and that Mr

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<sup>19</sup> There are inconsistencies by Mr Forde in his evidence when this was and he lists both dates in his evidence. In exhibit H4 he dates the album as 1979 but at exhibit ITEM N he lists the album as being released in 1978.

Robinson as having joined in 1976. The image of the vinyl record Hulet (reproduced below) is dated 1979. I am satisfied that Mr Robinson was a member of the second iteration of the band by at least 1979, if not before.



### 1979-1996 - Third iteration

56. The parties agree that the membership of the band consisted of Mr Gaye, Mr Robinson and Mr Forde during this period. The contract in 1983 shows that the three “writers” were paid equally c/o Mr Campbell. At some point between 1983 and 1986 the band was dropped by Island Records. Mr Spaine became the band’s manager in 1985 and a new contract was signed in 1986. From 1986 onwards the band enjoyed their most commercially successful period continuing to perform under the name ASWAD and releasing music to include albums and singles and scoring UK chart hits with songs such as ‘Don’t Turn Around’ and ‘Shine’.

### 1996 – 2022 - Fourth iteration

57. The membership of the band during this period consisted of Mr Gaye and Mr Robinson.

58. I find that Mr Forde did in fact leave the band in 1996 to pursue a solo career. This is supported by the unchallenged evidence of Mr Robinson and Mr Spaine on this point, the Wikipedia entry and the interview Mr Forde gave in 2009 where he is described as a former member and discusses having left the band some 10 years prior. I make this finding notwithstanding that Wikipedia entries are open to amendment and therefore may not be accurate. According to the interview, Mr Forde

not only left the band, but he stated that he had relinquished his rights to the name ASWAD when he left and agreed for the remaining two members to continue performing and recording under the name. I do not find that the evidence produced by Mr Forde supports his claim that he was a member of the band for an uninterrupted period of forty-nine years.

59. There is no suggestion from the evidence filed by either party, that the band ceased or disbanded after Mr Forde's departure. Mr Robinson states that the band continued to perform from 1996 onwards and there has been no serious challenge to this evidence by Mr Forde. Mr Spaine provides evidence of performance dates in and around the UK and worldwide from 2017 to 2022. I find that the band consisting of Mr Gaye and Mr Robinson continued to record and release music, perform and tour under the name ASWAD up until Mr Forde's death and had contractual obligations extending beyond 2022. Mr Forde concedes that four new ASWAD Album recordings credited to Mr Robinson were released in 1999, 2002 and 2009.<sup>20</sup> I accept that the royalties and income generated during this time were split between Mr Gaye and Mr Robinson solely. Although other musicians played with the band, including Mr Soloman Gaye, there is no indication that they were anything other than session musicians, paid per performance.

60. Contrary to Mr Forde's claim, the release of music during 1996-1997 where Mr Forde appeared on the recordings, is not inconsistent with his departure from the band. It is entirely reasonable for a band when producing an album to use material created some time before the release date, to include material when Mr Forde had been a member of the band. Even if I am wrong in so far as Mr Forde's departure having formally taken place in 1996, then it would have occurred by at least 1999, being 10 years before the reunion in 2009 according to the interview he gave. Regarding the albums Mr Forde lists as having been released after 1996, said to demonstrate his continued membership in the band, they are no more than remastered re-issues or re-releases of previously recorded music when he was a member. They do not demonstrate Mr Forde's continuing membership of the band post 1996, albeit that I accept these releases would assist in keeping the name ASWAD alive in the minds of the UK consumer, and Mr Forde's former association with the band. I note,

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<sup>20</sup> Paragraph 20 of Mr Forde's first statement.

however, that they also serve to maintain Mr Robinson and Mr Gaye's association with the band, as this music was of recordings when they were also members.

### The 2009 Reunion

61. Whomever was approached to invite ASWAD to play at the Island Records anniversary concert, the parties agree that the band reunited and performed at this concert in May 2009, but I do not find that this was a permanent reunion. Mr Forde did not consider it as such either, as confirmed in the interview he gave at the time, nor did he consider that it would lead to the band reforming permanently.

62. The receipt of a MOBO lifetime achievement award in 2000 and the presentation of an MBE in 2015 are also not indications that Mr Forde was a member of the band in 2000 and 2015. In my view the former is nothing more than recognition of the band's contribution to music during their third iteration and the latter of Mr Forde's contribution to music and the arts generally.

### Credit for the songs

63. Despite Mr Forde's evidence that he wrote 85% of the songs and received royalties in this proportion, this is not reflected in the evidence produced. The first and second contracts setting out the financial agreement as between the record company and the members supports Mr Robinson's understanding that royalties were split equally between the members during each iteration. I accept, therefore, that each member received equal shares in royalties for recordings and income generated by the band during the period they were members, irrespective of who in fact wrote the songs. The emails to which he refers at exhibit ITEM M relate to enquiries and clarification over the payment and division of publishing rights to music titled "13 dead". These emails do not show that Mr Forde continued to assume responsibility and be at the forefront of all ASWAD matters as claimed, merely clarifying the division of rights as per his entitlement.

## **Decision**

### **Section 5(4)(a)**

64. Section 5(4)(a) of the Act states 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, where the condition in subsection (4A) is met,

aa)...

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”.

65. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

66. 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 as follows:

“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).”

67. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation<sup>1</sup> among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source<sup>2</sup> or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

## Relevant date

68. In terms of the relevant date for assessment of this ground, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,<sup>21</sup> Mr Daniel Alexander QC,<sup>22</sup> sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*:<sup>23</sup>

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

69. The relevant dates in respect of each parties’ claims are the filing dates of the respective applications for registration, namely 30 September 2022 and 6 October 2022. Given that both parties claim prior use of the respective sign, for either’s claim to succeed, the use must have been capable of being restrained at these dates due to pre-existing goodwill. Given the nature of the dispute, it is clear that both sides claim to have an interest in the sign ASWAD and the date of the behaviour complained of is likely to be earlier than the respective filing dates.

## Goodwill

70. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217:

“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.”

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<sup>21</sup> BL O-410-11

<sup>22</sup> As he then was.

<sup>23</sup> BL O-212-06

## My approach

71. There can be no dispute from the evidence that the band under the name ASWAD has goodwill. The evidence filed clearly shows that the band has through longevity of use, geographical spread and its commercial success, generated goodwill in the name since the 1970s. The strength of that goodwill would have been at its height during the late 1980s to mid-1990s with chart success and the release of hit songs and albums. Although the strength of that goodwill may have diminished over time from its heyday, there is no suggestion that the band disbanded, ceased or that the goodwill in the name had dissipated completely. Mr Forde does not appear to challenge Mr Robinson's evidence that the band continued to perform, tour and record music after the 1990s. Therefore, it is not necessary for me to consider whether goodwill in the name ASWAD existed and has survived up until the relevant dates. I am satisfied that the evidence shows that it has. Further, there does not appear to be any dispute that the goodwill was generated in respect of the activities of the band in line with the specifications of the goods and services of the respective parties' applications as outlined earlier in my decision. It is clear that the issue to be determined is the ownership of the goodwill, which will determine who can bring a claim in passing off against the other. Given that the respective claims overlap, I shall deal with the assessment as to the ownership of goodwill collectively.

72. I have already outlined the iterations of the band, where at various times members have departed and joined. The joining and departing of band members and the effect this has on the ownership of goodwill at any given time has been considered by various authorities.

73. In *Byford v Oliver*,<sup>24</sup> (Saxon Trade Mark), Laddie J explained that, without a contract or agreement, the members of a band or group who perform for consideration are likely to constitute a partnership-at-will. This means that the assets of the band/group, including its goodwill and therefore rights to its name, are partnership assets to which each member is normally entitled to an undivided share. In relation to the legal position when members leave the band, Laddie J said (my emphasis):

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<sup>24</sup> [2003] FSR 39

“25. Absent special facts such as existed in *Burchell*, the rights and obligations which arise when a group of musicians, performing in a band as a partnership, split up can be explained as follows. It is convenient to start by considering the position when two, entirely unrelated bands perform under the same name. The first performs from, say, 1990 to 1995 and the second performs from 2000 onwards. Each will generate its own goodwill in the name under which it performs. If, at the time that the second band starts to perform, the reputation and goodwill of the first band still exists and has not evaporated with the passage of time (see *Ad-Lib Club Ltd v Granville* [1972] R.P.C. 673) or been abandoned (see *Star Industrial Co Ltd v Yap Kwee Kor* [1976] F.S.R. 256) it is likely to be able to sue in passing off to prevent the second group from performing under the same name (see *Sutherland v V2 Music* [2002] EWHC 14 (Ch); [2002] E.M.L.R. 28 ). On the other hand, if the goodwill has disappeared or been abandoned or if the first band acquiesces in the second band's activities, the latter band will be able to continue to perform without interference. Furthermore, whatever the relationship between the first and second bands, the latter will acquire separate rights in the goodwill it generates which can be used against third parties (see *Dent v Turpin and Parker & Son (Reading) Ltd v Parker* [1965] R.P.C. 323). If the first band is a partnership, the goodwill and rights in the name are owned by the partnership, not the individual members, and if the second band were to be sued, such proceedings would have to be brought by or on behalf of the partnership.

26. The position is no different if the two bands contain common members. If, as here, they are partnerships at will which are dissolved when one or more partners leave, they are two separate legal entities. This is not affected by the fact that some, even a majority, of the partners in the first band become members of the second. A properly advised band could avoid the problem that this might cause by entering into a partnership agreement which expressly provides for the partnership to continue on the departure of one or more members and which expressly confirms the rights of the continuing and expressly limits the rights of departing partners to make use of the partnership name and goodwill. This is now commonplace in the partnership deed for solicitors' practices.”

74. Further in *Burdon v Steel*, BL O/369/13, (THE ANIMALS), Mr Geoffrey Hobbs QC (as he was then), sitting as the Appointed Person, stated:

“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. The evidence omits to explain how the business they carried on together was set up and managed...

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.

[....]

33. 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. The fact that the applicant was also one of ‘the last men standing’ did not enable him to lay claim individually to the whole of the benefit of their goodwill and reputation by registering THE ANIMALS as his trade mark for live and recorded performances. The evidence on file does not show that he was free by virtue of devolution or dissipation or on the basis of any relevant authorisation or consent to apply for registration of the trade mark in this own name.”

75. What this means is that each iteration of the band acquires its own goodwill independently of each other. Taking account of what Mr Hobbs stated in *The Animals*,

there is no suggestion that the band used the name ASWAD with consent from anyone or that the assets were realised and divided when members left. Consequently, the goodwill generated by the band ASWAD will be taken as being owned collectively by the members of each new iteration, in absence of any agreement to the contrary. Whilst two contracts have been produced in evidence by Mr Forde, these govern the relationship between the record company and the musicians and are not contracts governing the relationship between the members themselves. The contracts, therefore, have little relevancy to the issue of ownership of goodwill, other than affirming the division of the publishing rights and the royalties to be shared amongst the band members. There is no evidence to demonstrate that Mr Forde received an 85% split of the royalties in line with his writing credits as alleged. Neither is there any evidence of an agreement having been made by the band members that would suggest Mr Forde was entitled to claim the goodwill in his sole name or the lion's share of it.

#### Mr Forde's goodwill

76. In so far as Mr Forde's section 5(4)(a) claim is concerned, whether he owned goodwill at the relevant dates will determine whether he has a basis for being able to oppose Mr Robinson's application for registration on any common law right. Other than a brief reunion for a one-off gig in 2009, Mr Forde had not performed with the band since his departure in 1996. The partnership consisting of Mr Gaye, Mr Robinson and Mr Forde was dissolved upon his departure at this date. Following my earlier finding, any entitlement to a share of the goodwill would only arise as a result of his former membership. Mr Forde claims that because his name is synonymous with ASWAD and his connection to the band as "the founding member" is so strong, that his reputation and goodwill in the name subsists to this day.

77. The position regarding the rights of former members was considered by Mr Hobbs where he referred to the general rule as stated by Plowman J. in *Pompadour Laboratories Ltd v. Stanley Frazer* [1966] RPC 7 at p.10, namely:

"As I understand the law it is clearly settled that a defendant who formerly had a connection with the plaintiffs business, but has ceased to do so, although entitled to inform the world that he formerly had that connection, is not entitled to state that he still has such a connection if that in fact is not the case."

78. The rights of former or founding members, therefore, are to be distinguished from the rights of existing members of an ongoing alliance or as the last man standing regarding proprietorship of the collectively owned goodwill.

79. The evidence shows that whilst Mr Forde may have had an entitlement to bring a claim relying on his share of the goodwill in 1996 or possibly in 2009, he did in fact abandon his rights to the name when he departed the band. Even if it could be said that the reunion in 2009 demonstrated that he had not abandoned his goodwill and was an intention or an attempt to resume the original membership this was short-lived. His comments made clear that the reunion was not permanent or something that he saw on the cards. By his own admission in the interview referred to earlier, he “signed over the rights [to the name Aswad] when [he] left” and that a permanent reunion with his former band members was not on the cards at the time “but if it’s meant to be, it will be”. Whilst a resumption of a partnership does not necessarily have to be imminent in order to show that he had not or did not intend to abandon his rights, the mere possibility of ‘resumption if circumstances should ever change’ is not enough.<sup>25</sup> Mr Forde has not shown that he had any real intention of resuming the partnership after 1996 when he left the band to pursue a solo career the first time, nor after the brief reunion in 2009. Neither has he shown that he has actively built up any goodwill in the name ASWAD in his own name (or collectively) after either of these dates. I do not find that the acceptance of an MBE or the receipt of the MOBO award demonstrates anything other than recognition of his contribution to the band when he was still a member. The MOBO award was in fact an award honouring all three members of the third iteration of the band, which included Mr Gaye and Mr Robinson.

80. Furthermore, I find that Mr Forde acquiesced in allowing the partnership of Mr Gaye and Mr Robinson to continue without challenge. He made no attempt to prevent this partnership from continuing to use the name either after he left in 1996 or after the brief reunion in 2009. Mr Gaye and Mr Robinson continued to tour, perform and record new music under the name ASWAD for over twenty-five years and Mr Forde has not sought to challenge this until now. The albums that are said to have been released in 1999, 2008, 2017 and 2020 are remastered reissues of previously recorded music or live performances. Even if these could be said to potentially assist in keeping Mr

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<sup>25</sup> *Kark v Odhams* [1962] R.P.C.163

Forde's residual goodwill claim alive, I do not consider they assist Mr Forde. Not only do I not have any evidence regarding how many copies were sold or income generated to be able to assess the extent of consumers' awareness in the name ASWAD on these dates, but also any goodwill that would have been generated from these sales, would have been shared with Mr Robinson and Mr Gaye.

81. Dealing with Mr Forde's entitlement to bring a claim in passing off, I do not find that the evidence shows that he owned goodwill at the relevant dates. Whilst he may have been entitled to claim a share of the goodwill in the partnership at the time when it was dissolved in 1996 and possibly later in 2009, he chose not to do so. I find that not only did he abandon his right to any claim to the shared goodwill in 1996 or failing that 2009, he also acquiesced in allowing the fourth iteration of the band consisting of Mr Gaye and Mr Robinson to continue using the name.

82. Even if I am wrong in this regard, and he could be said to have residual goodwill arising from his former membership, he would not have been able to bring a claim in his sole name in any event, as it has not been shown that he owned the goodwill himself. The claim in his sole name is founded on his belief that he solely owns the band's goodwill as the founding member and creator of the band. As explained at paragraph 25 of *Byford v Oliver* referred to earlier in my decision, where an asset (which includes goodwill) is owned by a band partnership, any attempt to sue another party, whether or not those parties contain common members, must be brought in the name of, or on behalf of, the partnership. Mr Forde has not brought the proceedings in the name of, or on behalf of, the 1976-1996 or 2009 partnerships. Given that Mr Robinson and Mr Gaye were members of the partnerships at the time, the proprietorship of any earlier right vests in all three members and not Mr Forde alone. Accordingly, Mr Forde had no individual claim to the goodwill in the band as at 1996, 2009 or at the relevant date in order to be able to oppose Mr Robinson's application based on common law rights.

83. Mr Forde was at great pains to point out that ASWAD is synonymous with himself. Even if I found this to be the case it would only be in part, as I consider that the name would equally be associated with Mr Robinson and Mr Gaye. If the band's fans and those in the music industry associate Mr Forde as a founding member of ASWAD, they would equally know that he had left in 1996. This argument does not assist Mr Forde,

therefore. The fact that Mr Forde is ‘a’ or even ‘the’ founding member of the band does not entitle him to lay claim individually to the whole benefit of the goodwill by applying to register the mark for himself.<sup>26</sup>

84. As at 6 October 2022, Mr Forde has not been able to establish goodwill, without which his claim falls at the first hurdle and his opposition under section 5(4)(a) fails.

#### Mr Robinson’s goodwill

85. Moving on to consider Mr Robinson’s claim and whether he is entitled to oppose Mr Forde’s earlier application. The position for Mr Robinson is different. I am in no doubt having assessed the evidence, that after Mr Forde’s departure, Mr Gaye and Mr Robinson continued to use the name ASWAD for twenty five years and consequently this partnership generated and owned the goodwill after Mr Forde’s departure. The ownership of the goodwill would have continued to be held in both parties’ names up until Mr Gaye’s death. Upon his death the partnership, as with all the other partnerships preceding it, dissolved. In the short period between dissolution and Mr Forde applying for his trade mark, the goodwill would still have existed and would not have dissipated. Taking account of the case law cited, I consider that upon Mr Gaye’s death, the goodwill generated by the partnership consisting of Mr Gaye and Mr Robinson would have passed upon the rules of succession to Mr Robinson on the basis of the last man standing principle as outlined by Mr Hobbs in *Williams and Williams v Canaries Seaschool SLU* (Club Sail Trade Mark).<sup>27</sup> At paragraph 27 he stated as follows:

“I consider that the starting point for the purposes of analysis in the present case is the general proposition that the goodwill accrued and accruing to the members of an alliance such as I have described is collectively owned by the members for the time being, subject to the terms of any contractual arrangements between them: *Artistic Upholstery Ltd v. Art Forma (Furniture) Ltd* [2000] FSR 311 at paragraphs 31 to 40 (Mr. Lawrence Collins Q.C. sitting as a Deputy High Court Judge). When members cease to be members of an ongoing alliance they cease to have any interest in the collectively owned goodwill, again subject to the terms of any contractual arrangements between

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<sup>26</sup> Saxon Trade Mark *ibid.*

<sup>27</sup> O/074/10

them; see, for example, *Byford v. Oliver* (SAXON Trade Mark) [2003] EWHC 295 (Ch); [2003] FSR 39 (Laddie J.); *Mary Wilson Enterprises Inc's Trade Mark Application (THE SUPREMES Trade Mark)* BL O-478-02 (20 November 2002); [2003] EMLR 14 (Appointed Person); *Dawney Day & Co Ltd v. Cantor Fitzgerald International* [2000] RPC 669 (CA); and note also the observations of Lord Nicholls of Birkenhead in *Scandecor Development AB v. Scandecor Marketing AB* [2001] UKHL 21; [2002] FSR 7 (HL) at paragraphs [42] to [44]. This allows the collectively owned goodwill to devolve by succession upon continuing members of the alliance down to the point at which the membership falls below two, when 'the last man standing' becomes solely entitled to it in default of any other entitlement in remainder: see, for example, *VIPER Trade Mark* (BL O-130-09; 13 May 2009) (Appointed Person, Professor Ruth Annand)."

86. It is clear from this decision, that the last man standing principle is not confined to unincorporated associations and this principle would apply equally to partnerships of the kind relating to the band ASWAD. In absence of any agreement as between members, partnerships are governed by the Partnership Act 1890 which confirms dissolution of the partnership upon death.<sup>28</sup> Upon dissolution, there is nothing within section 42 of the Partnership Act to prevent goodwill passing to the successor of the previous partnership, unless it can be shown that a departing member or their estate have required the assets to be realised and split (at the time of dissolution). Given that I have nothing before me to show that either have occurred, the goodwill that existed in the names of Mr Robinson and Mr Gaye as the members of the relevant partnership at the time, would pass to Mr Robinson as the last man standing. Consequently, Mr Robinson is entitled to rely upon the goodwill that passed to him through succession and is entitled to bring a claim against Mr Forde as the last man standing.

### **Misrepresentation and damage**

87. The relevant test for misrepresentation can be found in *Neutrogena Corporation and Another v Golden Limited and Another*,<sup>29</sup> in which Morritt L.J. stated that:

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<sup>28</sup> Section 33.

<sup>29</sup> [1996] RPC 473

“47. 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.”

88. The requirements for damage in passing off cases are described in *Harrods Limited v Harrodian School Limited*,<sup>30</sup> 48 by Millett L.J., as follows:

“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.”

89. With regard to proof of damage, I bear in mind the decision in *WS Foster & Son Limited v Brooks Brothers UK Limited*,<sup>31</sup> in which Mr Recorder Iain Purvis QC stated:

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<sup>30</sup> [1996] RPC 697

<sup>31</sup> [2013] EWPC 18

## “Damage

55 Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant's unregistered mark. Mr Aikens accepted that if there was a misrepresentation in the present case, then he had no separate case on damage. I hold that damage is inevitable, at least in the sense recognised in *Sir Robert McAlpine v Alfred McAlpine* [2004] RPC 36 at 49 (the ‘blurring, diminishing or erosion’ of the distinctiveness of the mark).”

90. Having found that Mr Robinson owned the goodwill, it follows that any use of the name ASWAD by Mr Forde for goods and services of the kind as applied for, would mislead a substantial number of members of the public into purchasing those goods/services believing that they were Mr Robinson's. This would give rise to a misrepresentation and damage is easily foreseeable.

91. I find that Mr Robinson's claim under section 5(4)(a) succeeds in its entirety.

## **Final remarks**

92. Mr Robinson's claim succeeds, subject to appeal, application no. 3834929 in the name of Mr Forde shall be refused registration.

93. Mr Forde's claim fails, and subject to appeal, trade mark registration number 3836580, in the name of Mr Robinson, shall proceed to registration.

## **Costs**

94. Mr Robinson has been successful and is entitled to a contribution towards his costs based on the scale published in Tribunal Practice Notice 2/2016. Taking account of this scale I award costs to Mr Robinson on the following basis:

Preparing and considering the notice of opposition and preparing a counterstatement and statement of grounds:	£500
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Preparing evidence and considering the other side's evidence:	£1000
Preparing for and attending a hearing:	£800
Official Fee:	£200

96. I order Mr Brinsley Forde to pay Mr Dennis Anthony Robinson the sum of £2,500 as a contribution towards his costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

**Dated this 17<sup>th</sup> day of February 2025**

**Leisa Davies**

**For the Registrar**