

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 93508

IN THE NAME OF ERIC VICTOR BURDON

TO TRADE MARK APPLICATION No. 2355587

IN THE NAME OF JOHN STEEL

DECISION

Introduction

1. This is an appeal from a decision of the Registrar of Trade Marks relating to the question whether one of the original members of a disbanded musical group is entitled to register the name of the group as his trade mark despite objection from another of the original members of the group. The decision under appeal was issued by Mr. George Salthouse on behalf of the Registrar under reference BL O-311-08 on 18 November 2008. I understand that there have in the past been extended negotiations with a view to settling the dispute, but that the parties were in the end unable to reach a compromise.

The Animals

2. In 1963 five musical performers began working together as members of a group called **THE ANIMALS**. They were: Eric Burdon (vocalist), Alan Price (keyboard), Hilton Valentine (guitar), John Steel (drums) and Chas Chandler (bass). Alan Price left the group in 1965. He was replaced by Mick Gallaher, who was himself quite quickly replaced by Dave Rowberry. John Steel left the group in March 1966. He was replaced by Barry Jenkins. The members of the group at the time when it broke up in September 1966 were: Eric Burdon, Hilton Valentine, Chas Chandler, Dave Rowberry and Barry Jenkins.

3. The original members of **THE ANIMALS** (Burdon, Price, Valentine, Steel and Chandler) reunited to play two sell-out shows for a charity fund-raiser at Newcastle City Hall in December 1968. They reunited again in 1975 to record an album entitled 'Before We Were So Rudely Interrupted'. In 1983 they reunited to record a studio album ('Ark') and a live album ('Rip It To Shreds') and they toured together in America, Hawaii, Japan, France and England. In England they performed at the Wembley Arena and at two sell-out concerts at the Royal Albert Hall.

4. **THE ANIMALS** (identified as Burdon, Price, Valentine, Steel and Chandler) were by invitation enrolled in the Rock and Roll Hall of Fame at the Ninth Annual Induction Dinner for that event held in New York in January 1994. On 11 May 2001, **THE ANIMALS** (again identified as Burdon, Price, Valentine, Steel and Chandler) were inducted into Hollywood's RockWalk hall of fame. A plaque combining

handprints and signatures of all four surviving members with a memorial for Chas Chandler (who had died on 17 July 1996) was added to the display in the hall of fame at the Guitar Center on Sunset Boulevard.

5. In a poll of UK Channel 4 viewers **THE ANIMALS'** recording of 'The House of The Rising Sun' was voted number 14 all time favourite single for the purposes of a television programme called 'The 100 Greatest Singles Ever' which was broadcast in January 2001 and repeated in December 2001 and again in 2003.

6. The goodwill and reputation built up and acquired by the group through live performances and via sales and broadcasting of their recorded performances did not cease to exist in the aftermath of its members' last collaboration in 1983. The name and fame of **THE ANIMALS** lived on through use in commerce with protective effect as recognised in such cases as Mary Wilson Enterprises Inc's Trade Mark Application (THE SUPREMES) [2003] EMLR 13 and Maslyukov v. Diageo Distilling Ltd [2010] RPC 21. As John Steel confirmed in a witness statement filed at the Trade Marks Registry in 2004, the goodwill and reputation generated by the group under and by reference to the name **THE ANIMALS** was perpetuated in various ways: recordings of their performances continued to be sold and played (on radio and television and in film and advertising soundtracks) all over the world; they were the subject of several books published over the years; works from the repertoire they made famous were performed frequently at public concerts. The goodwill and reputation generated by the activities of the group continued to be an asset the benefit of which was effectively owned by whoever had the legal right to protect the name **THE ANIMALS** by

preventing others from using it without permission in relation to live and recorded performances.

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. There is no explanation of the various contractual arrangements that must have been put in place with third parties for commercialisation of their live and recorded performances under and by reference to the name **THE ANIMALS**. The situation with regard to the collection and distribution of recording artist, public performance and music publishing revenues in respect of works in their repertoire is also not explained. The lack of information in relation to all these matters extends into and through the period in which the goodwill and reputation generated by the group under and by reference to the name **THE ANIMALS** was perpetuated in the various ways mentioned above.

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.

9. The question which then arises in the circumstances of the present case is whether any of them abandoned their rights. The right to prevent others from trading under or by reference to a particular name exists independently of registration both at common law and in equity as explained by Lord Parker of Waddington in AG Spalding Bros v. AW Gamage Ltd (1915) 32 RPC 273. Foster J. observed in British Leyland Motor Corporation v. Armstrong Patents Co. Ltd [1982] FSR 481 at p.492 ‘*It is extremely difficult in my experience to divest oneself of a legal right*’. The outcome of the Procol Harum case Fisher v. Brooker [2009] UKHL 41 can be said to confirm the force of that observation. The evidence on file in the present case does not appear to me to establish that any of ‘the last men standing’ abandoned their rights. It basically indicates that none of them took exception to any one or more of the others of them participating in the operation of what I shall for want of a better expression call ‘heritage’ groups. Whether their tolerance led to a devolution or dissipation of the UK goodwill and reputation which belonged to them collectively as members of **THE ANIMALS** in 1983 is a separate question.

The 'heritage' groups

10. A group headed by Eric Burdon appears to have operated under and by reference to the name **ERIC BURDON AND THE ANIMALS** from late 1966 to sometime in 1968. He also headed a group which was operating in 2002 under and by reference to the name **ERIC BURDON AND THE NEW ANIMALS**. By 2003 the name of the group appears to have changed to **ERIC BURDON AND THE ANIMALS**. The evidence on file provides no basis for any assessment of the extent to which these groups delivered live or recorded performances. Nor does it show that their activities impacted on public perception in a way or to a degree that was effective to result in devolution or dissipation of the UK goodwill and reputation which belonged to 'the last men standing' in 1983.

11. Peter Barton of Rock Artist Management became agent/manager for what he refers to as John Steel's band in late 1993 and he became a member of the band in 2002. The line up of the band has changed over time. Its members have included John Steel and other former members of **THE ANIMALS**. John Steel remains a member. Hilton Valentine was one of the original members. He emigrated to the US in 2001. Dave Rowberry joined in September 1999. He died in June 2003. Mick Gallaher joined the band not long afterwards and appears to have remained a member since then.

12. In a witness statement dated 20 February 2008 Peter Barton confirms that when he became involved with John Steel's band it was touring the world as **ANIMALS II**.

He produced as Exhibit PB 4 a copy of a contract dated 12 May 1994 in which the band was identified as *'The Animals 2'*, albeit with the '2' crossed out in one of the two places where the name appeared on the first page of the document. His evidence in narrative form was that 'In some of the contracts the band was called THE ANIMALS, but at that time the band was largely known as ANIMALS II'.

13. The name of the band was subsequently changed to **ANIMALS AND FRIENDS**. In a witness statement dated 18 February 2008 John Steel stated that 'For about 4 years, until the death of John Rowberry in June 2003, we traded as The Animals. We had 3 members of the original 1965/66 line up of The Animals in the band' and 'We currently perform and record largely as Animals & Friends, although we are often billed (by the venue) as The Animals, even when contracted as Animals & Friends'.

14. So far as I can see from the evidence, the line up of John Steel's band has never included more than 2 of 'the last men standing' and the only period in which there were 3 members of the original 1965/66 line up of **THE ANIMALS** in the band was from September 1999 (when Dave Rowberry joined) to 2001 (when Hilton Valentine emigrated to the US). Exhibit EVB 5 to the witness statement of Eric Burdon dated 27 March 2006 is a download from Peter Barton's Rock Artist Management website. This states that 'The concept of Animals and Friends began in the Spring of 2000. ... Due to the pedigree of the current band members the band was re-named Animals and Friends ... The final ingredient's to this rock & roll cocktail was of course original Animal members, Dave Rowberry and John Steel. Animals and Friends were born. The band

toured extensively and in the winter of 2001 went into Lisa Stansfield's studio to record the debut Animals and Friends Album "Instinct". Friends had been called and recording started'.

15. There is in the light of the statements in that downloaded document some uncertainty as to when exactly John Steel's band ceased to be named **ANIMALS II** and when exactly it was re-named **ANIMALS AND FRIENDS** '*due to the pedigree of the current band members*'. The naming and name changes matter because they signify an acceptance that the band was appropriately called **ANIMALS II** rather than **THE ANIMALS** even when 2 of 'the last men standing' (John Steel and Hilton Valentine) were in the line up and that it was not appropriately called **THE ANIMALS** once the point had been reached at which there was only 1 of 'the last men standing' (John Steel) in the line up.

16. The lack of sufficient pedigree to justify simple use of the name **THE ANIMALS** was noted in a June 2004 BBC commentary by Jake Jakeman on the release of the **ANIMALS AND FRIENDS** 'Instinct' album (Exhibit EVB 6):

Who: Don't get fooled by The Animals tag. Basically there's only one original member - drummer John Steel. And you could argue The Animals without Eric Burdon, Alan Price and Chaz Chandler isn't really the Animals at all.

What's the point then?: In fairness this is billed as Animals and Friends ... and Friends there are by the bucket load - Paul Jones, Rick Wakeman, Rod Argent, Eric Bell and the late Noel Redding are all credited with contributing to the album.

17. Added to which there was The Spotted Dog incident in 2006. Stephen Haddlesey was from April 2006 to June 2007 the tenant of a pub and club called The Spotted Dog in Willesden. The club had a 500 person capacity for live events. He approached a booking agency called Alive Network with a view to finding a live act. Among the listings on their 'Superstars artist roster' were **ANIMALS & FRIENDS** and **THE ANIMALS**. He chose **THE ANIMALS**. Exhibit SH 2 to his witness statement dated 2 July 2007 is a copy of the Entertainment Booking Contract in which Alive Network confirmed his booking of **THE ANIMALS** for an event date of 20 September 2006. Exhibit SH 3 is a download of 5 September 2006 showing the promotional entry on The Spotted Dog website for that event. Beneath the caption '*LIVE Here on 20th September 8.00PM. Buy tickets online*' it displayed a panel juxtaposing the heading *THE ANIMALS. Includes their hit single 'House of the Rising Sun'* with full face photos of Eric Burdon taken in modern times which Mr. Haddlesey had imported from his (Eric Burdon's) official website.

18. Mr. Haddlesey was not at all happy when he subsequently became aware that the agency was proposing to fill the booking by sending him **ANIMALS & FRIENDS** rather than **THE ANIMALS** he thought he had booked. He cancelled the engagement and 'when explaining to customers who had purchased tickets and refunding money it was clear that had the event gone ahead without Eric we would have quite literally had a riot on our hands and [it] would have been devastating for the integrity of The Spotted Dog in future promotions'.

19. For their part, John Steel and Peter Barton confirm in their witness statements that they cancelled the booking of **ANIMALS & FRIENDS** for The Spotted Dog on 19 September when they found out how the event was being promoted. In his witness statement dated 18 February 2008 John Steel confirmed that his band never attempts to pass itself off as the original band **THE ANIMALS**. In the context of the evidence noted in paragraphs 11 to 18 above, it appears to me to be both correct and recognised by John Steel that *'the pedigree of the current band members'* of **ANIMALS & FRIENDS** is not sufficient to justify simple use of the name **THE ANIMALS** for his band as constituted since 2001 or thereabouts.

20. I consider that the gap between the names **THE ANIMALS** and **ANIMALS AND FRIENDS** is small but real enough, if honestly and fairly maintained, to put down a marker that the latter is the name of a 'heritage' group, that is to say an offshoot rather than the full successor in line of title to the business of **THE ANIMALS** as recognised and remembered by people who were or had become acquainted with the work of the group originally called by that name. I think the same is just about true of the gap between the names **THE ANIMALS** and **ANIMALS II** on the basis that the latter is apt to connote the opening of a new chapter. However, I do not accept that John Steel's band has at any time during the period I have referred to above been entitled to hold itself out as being the full successor in line of title to the business of **THE ANIMALS** as would, in my view, have been the effect of his calling it simply **THE ANIMALS**.

21. The question is then whether the goodwill and reputation which belonged to ‘the last men standing’ in 1983 devolved or dissipated as a result of his doing so for however long he did. The parties’ professional representatives helpfully provided me with schedules and notes which made it easier than would otherwise have been the case to identify and correlate the instances of naming shown in the documents exhibited to the witness statements of John Steel and Peter Barton. The documents relating to the UK spanned the period May 1994 to November 2007. There appear to have been less than 5 documents showing the band being referred to simply as **THE ANIMALS** between May 1994 and November 2002 with none of the references being contained in documents which could confidently be taken to have been (or been repeating information) issued by the band with reference to itself. This is not a sufficient body of evidence upon which to base a finding that the band called itself **THE ANIMALS** in a way or to a degree that was effective to result in devolution or dissipation of the UK goodwill and reputation which belonged to ‘the last men standing’ in 1983.

The contested application for registration

22. On 11 February 2004, John Steel applied under No. 2355587 to register **THE ANIMALS** as a trade mark for use in relation ‘*CD’s, musical recordings*’ in Class 9 and ‘*musical live performances*’ in Class 41. He thereby sought to acquire the right by virtue of registration to prevent others from using **THE ANIMALS** as an indication of trade origin in relation to goods and services of the kind for which the designation had

long been remembered and recognised as synonymous with the work of the group originally called by that name.

The objections to registration

23. The application for registration was opposed by Eric Burdon on 17 June 2005 upon the grounds: (1) that it should be refused in its entirety for having been made in bad faith (Section 3(6) of the 1994 Act); (2) that it should be refused in its entirety for encompassing use of **THE ANIMALS** in a context and manner which at the date of the application for registration he was entitled to prevent by virtue of the law of passing off (Section 5(4)(a) of the 1994 Act). The fact that he pursued the latter ground of objection to registration in the absence of Alan Price, Hilton Valentine and the personal representatives of Chas Chandler as parties to the proceedings was not, in itself, a bar to his raising it: CLUB SAIL Trade Marks [2010] RPC 32 at paragraph [29].

24. The objection under Section 3(6) was quite poorly defined. The thrust of it was in the averment that ‘the Applicant still incorrectly purports to be the exclusive owner to rights in the name of **THE ANIMALS** whereas this is not the case’. Both objections were pursued and defended without recourse either to cross-examination or any application for disclosure of documents to make good the evidential deficiencies I have noted above.

The Hearing Officer's Decision

25. The objection to registration under Section 3(6) was rejected by the Hearing Officer on the basis stated in paragraphs [55] and [56] of his Decision:

55) To my mind the facts of this case are not on all fours with the Saxon case, in fact quite the reverse. In the instant case the mark was, to all intents and purposes dormant for twenty-seven years at least, if one ignores the half hearted reunions which yielded a total of five concerts and two albums. It is noteworthy that no sales figures for the albums were provided nor attendance figures for the concerts. It is I believe, reasonable to assume that they were not particularly well received otherwise the financial rewards would have led to more concerts to support the albums. The claim that the opponent is being restrained "from doing that which he currently does" also bears some analysis. There is no evidence that the opponent has ever sought to use the mark in suit. All of the evidence of his activities since 1966 shows an aversion to being associated as a member of The Animals group. The nearest he comes to using the mark is "Eric Burdon and The Animals" identifying himself as separate to the backing group. Even this use only began some time after the use of the mark in suit by the applicant. I have already found that the goodwill generated by the original band called The Animals during the period 1966-1968, topped up by later activities, had totally dissipated by 1993, and even allowing for the further events was still absent in 2004.

56) The opponent had, at the relevant date, no rights in the mark in suit, other than those he has obtained via his registration in the USA, which, from the evidence provided in this case, have a shadow of doubt cast over them. I find that the applicant did not file the application in bad faith. The ground of opposition under Section 3(6) therefore fails.

26. He rejected the objection to registration under Section 5(4)(a) on the following basis:

40) To my mind, the goodwill accrued by the band during the period 1963-1966 would have long dissipated by 11 February 2004, the date of the application, despite the minor top ups provided by the half hearted reunions, re-releasing of the same song on two occasions, featuring on an advertisement and two films and being inducted into a museum in the USA. The opponent seems to contend that he is, at least in his own mind, a rock and roll legend whose mere existence serves to keep the goodwill in the original band alive. He is I am afraid mistaken. His counsel described him as “the charismatic lead singer and songwriter who has captivated the hearts and imagination of generations upon generations of teenagers the world over” and also stated that “No-one remembers the drummer”. As to the former, this was not borne out by the evidence provided and with regard to the latter I trust that she does not encounter Ringo.

41) As no goodwill existed in the mark in suit as at the date of the application the ground of opposition under Section 5(4)(a) fails.

27. He ordered the opponent to pay £5,932 as a contribution towards the applicant’s costs of the proceedings in the Registry. £3,782 of that amount was awarded in respect of the costs of an abandoned hearing which the opponent had, in principle, agreed to pay.

The Appeal

28. The opponent appealed to an Appointed Person under Section 76 of the 1994 Act contending in substance that the Hearing Officer had erred fundamentally in his

assessment of the objection under Section 5(4)(a) by proceeding upon the mistaken basis that no goodwill existed in the mark **THE ANIMALS** as at the date of the contested application for registration (11 February 2004). There was no appeal in respect of the Hearing Officer's rejection of the opponent's objection to registration under Section 3(6) of the Act. The applicant defended the Hearing Officer's decision on the basis that it was either correct for the reasons he had given or at least open to him to reach the conclusion he did on a reasonable appreciation of the evidence on file.

Decision on the Appeal

29. I am satisfied that the Hearing Officer failed to appreciate that 'cessation of production of goods or provision of services does not necessarily mean that there has been a cessation of business capable of sustaining goodwill, still less a destruction of the existing goodwill': Maslyukov v. Diageo Distilling Ltd [2010] RPC 21 at [80] per Arnold J. That led him to assess the objection under Section 5(4)(a) from an incorrect perspective, with the result that he made no effective determination of the issues relating to goodwill (existence and ownership), misrepresentation and damage presented by John Steel's application to register **THE ANIMALS** as his trade mark for live and recorded performances.

30. I have already explained why I consider that the evidence on file: (1) confirms the existence of a goodwill and reputation accrued and accruing to the persons collectively entitled as 'the last men standing' in 1983 to control the use of the name **THE ANIMALS** in relation to live and recorded performances; (2) fails to show any

devolution or dissipation of that goodwill and reputation over the period from 1983 to 2004; and (3) points to simple use of the name **THE ANIMALS** for John Steel's band as constituted since 2001 or thereabouts being apt to give rise to the mistaken belief that it is the full successor in line of title to the business of the group originally called by that name.

31. There is clearly room for actionable misrepresentation in the closing of the gap between the names **THE ANIMALS** and **ANIMALS AND FRIENDS** for live and recorded performances. In Saunders v. Sun Life Assurance Co. of Canada [1894] 1 Ch 537 Stirling J. decided that the defendant was not entitled use the name 'The Sun' or 'the Sun Life' without the addition of the words 'of Canada' even though the evidence showed that the additional words were naturally dropped for the sake of brevity. Oliver LJ observed in My Kinda Town Ltd v. Soll [1983] RPC 407 at 425 that a trader cannot legitimately build upon and increase the potential for confusion between two businesses 'in such a way that confusion becomes worse confounded'. The objectionable nature of such conduct was, in principle, accepted by reference to those citations in Budweiser Trade Marks [2000] RPC 806 (CA) at 915, 916 (Peter Gibson LJ) and 924 (Ferris J); Judge LJ agreed (p.920). The judgment of Mann J. in Sir Robert McAlpine Ltd v. Alfred McAlpine Plc [2004] EWHC 630 (Ch); [2004] RPC 36; is a clear endorsement of the principle that there can be liability for passing off as a result of closing of the gap between two names.

32. John Steel's application for registration envisaged use of **THE ANIMALS** as a trade mark for live and recorded performances provided or produced either by him or

with his consent independently of the others of ‘the last men standing’ and irrespective of the existence or absence of any connection in the course of trade or business between them and the performances thus provided or produced. That was apt to result in misrepresentation to the effect I have indicated above. Misrepresentation to that effect was by its very nature liable to damage the economic value of the UK goodwill and reputation of the business signified by the name **THE ANIMALS**.

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.

Conclusion

34. The Appeal is allowed and the objection to registration under Section 5(4)(a) is upheld in relation to the entirety of the contested application for registration. The Hearing Officer’s decision as to costs is set aside save in so far as it provided for payment by the opponent to the applicant of £3,782 in respect of the costs of the abandoned hearing.

35. I understand that the parties are content for me to deal with the costs of the opposition, in the Registry and on appeal by making an award in accordance with the usual practice in inter partes proceedings before the Appointed Person. On that basis I direct the applicant to pay the opponent (£5,500 minus £3,782 therefore) £1,718 as a contribution towards his costs of the proceedings at first instance and on appeal. The sum of £1,728 is to be paid within 21 days of the date of this decision.

Geoffrey Hobbs QC

9 September 2013

Anna Edwards-Stuart instructed by Wynne-Jones, Lainé & James LLP appeared on behalf of the opponent.

Michael Edenborough QC instructed by Mewburn Ellis LLP appeared on behalf of the applicant.

The Registrar was not represented at the hearing and took no part in the Appeal.