

O-311-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2355587
BY JOHN STEEL
TO REGISTER THE TRADE MARK
THE ANIMALS
IN CLASSES 9 & 41**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 93508
BY ERIC VICTOR BURDON**

BACKGROUND

1) On 11 February 2004, John Steel applied under the Trade Marks Act 1994 for registration of the trade mark THE ANIMALS in respect of the following:

In Class 9: “CD’s, musical recordings.”

In Class 41 “ Musical live performances.”

2) On 17 June 2005 Eric Victor Burdon filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent performs under the names/trade marks THE ANIMALS (the Band) / ERIC BURDON and THE ANIMALS and has these names registered in the USA under numbers 76524982 and 76524983. He has spent his career as a lead singer and songwriter of these bands and was inducted into the Rock n’ Roll Hall of Fame in 1994.

b) The applicant was a member of the Band but was never given any ownership rights in respect of the name of the Band. The applicant initially sought to register a series of five marks in respect of a very wide range of goods in Classes 9 and 41. There was never a realistic likelihood of the marks being used on such a range of goods and services and thus there was no bona fide intention of using the mark on the specification requested. The application therefore offends against Section 3(6) of the Trade Marks Act 1994.

c) Initially the applicant sought to include his own name (John Steel) as part of one of the marks in the series. By associating his name with the name of the Band the applicant purported that he was the owner of exclusive rights in and to all the marks in the series when he does not own any rights in the name of the Band. Even when the series was reduced to a single mark “THE ANIMALS” the applicant still purports to be the owner of rights in the name of the Band. The application therefore offends against Section 3(6) of the Trade Marks Act 1994.

d) The opponent claims that the mark in suit is a very well known mark internationally and famous as being associated with the opponent. As such the mark in suit should be refused under Section 5(4)(a) and Section 56 of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the opponent’s claims, and put the opponent to strict proof regarding the assertions made regarding use and reputation.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 18 June 2008 when the opponent was represented by Mr Halstead of Messrs Wynne-Jones, Laine & James. The applicant was represented by Ms Arenal of Mewburn Ellis LLP. However, this hearing was adjourned at the request of the opponent, as the opponent wished to rely upon the contents of the examination file but had not filed this as part of their evidence. The

opponent's Trade Mark Attorney, Mr Halstead, stated that he believed that the examination file was automatically included as part any opposition case. To the best of my knowledge this has never been the case, it has always been accepted that only papers filed as part of the evidence could be relied upon at a hearing and taken into account in the decision. The opponent accepted that they would pay the applicant's costs for the abandoned hearing. The hearing reconvened on 10 July 2008, with the opponent now represented by Ms Edwards-Stuart of Counsel instructed by Messrs Wynne-Jones, Lains & James, whilst the applicant was again represented by Ms Arenal of Mewburn Ellis LLP.

OPPONENT'S EVIDENCE

5) The opponent filed two witness statements. The first, dated 27 March 2006, is by Eric Victor Burdon. Mr Burdon states that the group known as The Animals originated in Newcastle-upon-Tyne and was formed in 1963. He states that he was one of the original members along with John Steel (drums), Alan Price (keyboard), Bryan (Chas) Chandler (bass guitar) and Hilton Valentine (lead guitar). Mr Burdon states that John Steel was the first to leave the Band in 1965 and initially, at least, worked outside the music industry. He also states:

“2) I was inducted into the Rock & Roll Hall of Fame in 1994 following a career as lead singer and songwriter of the band known as The Animals (“the Band”), latterly often referred to as Eric Burdon and The Animals, although with varying emphasis on the prominence of the element “Animals”, as can be demonstrated in exhibit EVB1 hereto..”.

6) Mr Burdon states that he performs under both The Animals and Eric Burdon and The Animals in the UK, USA and elsewhere. He states that he believes that his name is “to a very large extent, synonymous with the name/mark THE ANIMALS”. He refers to the worldwide concerts at exhibit EBV3 as evidence of his fame and also his induction into the Rock & Roll Hall of Fame. He states that he has worldwide goodwill and reputation “which is closely associated with THE ANIMALS as a name/mark within the music industry and the music-loving public, including the UK”. He states that this reputation extends to providing entertainment services in the nature of live performances as well as sound recordings and other pre-recorded materials related to these activities.

7) Mr Burdon corrects two minor errors from the statement of grounds. He states that the USA trade marks are pending applications and that the Band was formed in 1963 not 1961 as originally stated. He states that the negotiations between the parties basically consisted of an offer from the applicant that if the opposition were withdrawn then Mr Burdon could use the name THE ANIMALS with his own name whilst the applicant would retain all rights to the mark in suit. He states that he deemed this offer as unacceptable. At exhibit EVB4 he provides copies of the correspondence.

8) Mr Burdon states that the applicant uses the term “The Animals II” in relation to his band in much of the evidence filed in support of the application. He states that the applicant's group is a “tribute band”. Also used is the term “Animals & Friends”. Mr

Burdon states that both of these names are capable of misleading the public into thinking that it is the original Band accompanied by a few friends.

9) Mr Burdon repeats his assertion that he has an association and reputation with the Band and repeats his claim to have been inducted into the Hall of Fame. However, I note that it was the Band and all of its members who were so honoured which includes the applicant.

10) I now summarise the exhibits filed:

- Exhibit EVB1 includes a photocopy of a backstage pass dated 2 August 2003 for “Eric Burdon and the Animals” at the Paramount Theatre. Also included in this exhibit is a copy of a page from the Amazon website, dated 30 November 2005, offering the album *The Best of Eric Burdon & The Animals*; also *The Best of Eric Burdon & The Animals, 1966-1968*; *Absolute Animals 1964-1968* by The Animals; *The Complete Animals* by The Animals; and *Animalisms* by The Animals.
- Exhibit EVB2: This shows evidence of the US Trade Mark applications that Mr Burdon holds. These are number 76524983 THE ANIMALS in relation to goods in Class 9 and services in Class 41, and 76524982 ERIC BURDON & THE ANIMALS in relation to goods in Class 9 and services in Class 41. This states that The Animals and Eric Burdon & The Animals has been used since 2002, elsewhere other dates are claimed.
- Exhibit EVB3: This shows pages from Mr Burdon’s website which details the various shows worldwide for 2004 and 2005. There is an advertisement on one side of the page which reads “Eric Burdon and The Animals wear Antik Denim”. It only shows one show in the UK.
- Exhibit EVB4: This shows correspondence between the parties with an offer of settlement which would allow both parties to use the mark in suit proposed by the applicant.
- Exhibit EVB5: consists of information regarding the applicant from the website of its managing agent. There the group is referred to as “Animals and Friends”. It also details a number of concerts played which appear to be quite modest in terms of the venues and include most parts of the UK and mainland Europe.
- Exhibit EVB6: This consists of a review on a BBC website by Jake Jackman in respect of the album “Instinct” by “Animals & Friends”. The reviewer starts off “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.”

11) The second witness statement, dated 2 July 2007, is by Stephen Haddlesey who, between 20 April 2006 and 20 June 2007 was the tenant of a pub and club called The Spotted Dog in London. He states that he booked bands for live music events. He

states that he contacted Alive Networks and booked The Animals amongst others. Whilst in the case of some bands the agency informed him that original lead singers were no longer with the band in the case of the Animals they did not mention this. He states that he asked if Eric Burdon was in the band and was told that he was. He states that he downloaded images from the Eric Burdon website and began using these as part of the promotion. When advised by the opponent's trade mark agent that Mr Burdon was not part of the band Mr Haddlesey was upset and cancelled the concert. He states that the website of the agency lists "The Animals" and "Animals and Friends". He thought he was getting the former which he took to include Mr Burdon and had indeed specifically asked about. He states that when refunding money to a number of his customers they made it clear to him that they did not care who was in the band so long as Mr Burdon was there. Mr Haddlesey includes at exhibit SH1 a copy of the Alive Network which shows the bands available and includes both "The Animals" and "Animals and Friends". I note that the second name on the list is Alan Price, and later Eric Burden [sic]. Exhibit SH2 is a copy of the booking contract with Alive Network which shows the band name as "The Animals".

APPLICANT'S EVIDENCE

12) The applicant filed a witness statement, dated 2 April 2007. Mr Steel states that he first performed under the mark in suit in December 1963 and states that he has during the past fourteen years toured Europe, the Far East and the USA performing under the mark in suit. Mr Steel makes comments regarding the evidence of the opponent, much of which I do not find of assistance in reaching my decision. I shall not refer to such comments unless I find that they may be of assistance to me. Mr Steel states that he left the Band in March 1966 and states that by September 1966 the Band "had ceased to exist in its original form". He states that in late 1966 a new band was formed which was called *Eric Burdon and The Animals* and/or *Eric Burdon and the New Animals*. He claims that the original band from 1963-1966 was only known as The Animals and was never referred to as Eric Burdon and The Animals.

13) Mr Steel states that it was the group known as The Animals which was inducted into the Rock & Roll Hall of Fame not Mr Burdon. All the members of the original band (Messrs Price, Chandler, Valentine, Steel and Burdon) were inducted, although the opponent chose not to attend the ceremony.

14) Mr Steel confirms that it is his intention to use the mark in suit on all the goods and services included in the application. He also states that he was a founding member of the Band in 1963 and that the Band ceased to exist in 1966. Since then he states that he has performed with former members of the Band under the name THE ANIMALS and that the opponent was well aware of this.

15) Mr Steel claims that he has used the mark in suit in the UK for the past fourteen years and he contrasts this with the absence of use of the mark in the UK by the opponent. Mr Steel points out that the opponent performs under the name "Eric Burdon" and that the opponent's website is ericburdon.com. Mr Steel states that the opponent's last two albums were in the opponent's own name i.e. "Eric Burdon My Secret Life" and "Eric Burdon Soul Of a Man". Mr Steel contrasts this with his use of the mark in suit. He points out that his band performs in the UK regularly. He

provides copies from his tax returns which show details of concerts played in the UK during 1994-2004. There are 594 concerts shown in this ten year period.

16) Mr Steel states that starting in 1993 his band had two original members, himself and Hilton Valentine. From September 1999 they were joined by former Animals performer Dave Rowberry until his death in June 2003. He was replaced by Mick Gallagher who had joined the original Band in 1965 after Alan Price quit. Mr Gallagher was in turn replaced by Dave Rowberry until 1966.

17) Mr Steel states that Hilton Valentine and Alan Price are now basically inactive as performers, Chas Chandler and Dave Rowberry died in 1996 and 2003 respectively. Barry Jenkins (who replaced Mr Steel briefly in 1966) is also inactive. Therefore, the applicant and opponent are the only two of the original band still performing. Mr Steel states that if anyone has reputation in the UK under the mark in suit it is him, not the opponent. Mr Steel claims that the opponent has distanced himself from the name THE ANIMALS, albeit without success. Mr Steel provides a history of the opponent's career for the years 1967-1998 which shows a number of names being used. The only constant being the name ERIC BURDON and the absence of any use of the name "The Animals". He contrasts this with his own history which shows that since 1993 he has performed under the title THE ANIMALS.

OPPONENT'S EVIDENCE IN REPLY

18) The opponent filed a second witness statement, dated 22 October 2007, by Mr Burdon. He points out that between 1966 and 1993 the applicant had no connection with the music industry and was not using the mark in suit. He states that the applicant's association with the Band was only for two years and ended over thirty years ago.

APPLICANT'S ADDITIONAL EVIDENCE

19) The applicant filed a second witness statement, dated 18 February 2008. Mr Steel dismisses the evidence of Mr Haddlesey. He states that he, or his band has never been represented by Alive Network Ltd. In fact he describes the company as being a scam. He points out that they spell the opponent's name incorrectly, and that they claim to represent a number of artists who are dead. He states that they offer artists and when they get a booking they find out who represents that artist and pass the booking on in return for a commission. He states that his band is represented by Rock Artist Management. He states that work will come their way via other agents but that this is commonplace in the industry. He states that his band cancelled the concert at The Spotted Dog as soon as they became aware of the use of photographs of the Animals from the 1960s. He states:

"10. My band never attempts to pass itself off as the original band "The Animals". All our posters, flyers, merchandise and website clearly show what the band is called and who is in it. We are not, contrary to Mr Haddlesey's allegation in para.5, wrongly attempting to perform as The Animals. For about 4 years, until the death of Dave 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. We currently perform and record largely as Animals & Friends,

although we are often billed (by the venue) as The Animals, even when they contracted as Animals & Friends. I am an original member of the 1960s band The Animals and have performed under that name in the UK (and elsewhere) for many years on a regular basis.”

20) Mr Steel also comments on Mr Haddesley’s inexperience in not knowing of Zoot Money. He states that Mr Money is very well known in the music industry. He states that Mr Haddesley’s claim that there would have been a riot if the performance had gone ahead without Eric Burdon is contrary to his experience of more than a decade of performing in the UK under the mark in suit. He states that the majority of the audience are middle aged people with disposable income. He states that he is often asked what other members of the original Band are doing.

21) Mr Steel refers to the opponent’s second witness statement where Mr Burdon states that Mr Steel and his band have been performing in the UK as The Animals. At the same time the opponent confirms that he (Mr Burdon) has been performing under his own name. Mr Steel points out that the backing band for Mr Burdon is an ever changing one. At exhibit JS12 he provides a newsletter produced by Mr Burdon’s Fans which lists the number of changes to the line up Mr Burdon’s backing band. This lists five guitarists, two bass players and six drummers in a six month period.

22) The applicant also filed a witness statement, dated 22 February 2008, by Peter Barton a musician who also runs a company called Rock (Rothery) Artist Management and is also the manager of Mr Steel’s group who he names as “Animals & Friends” and “The Animals”. Mr Barton denies approaching the opponent with a request for Mr Steel to re-join Mr Burdon’s band. Conversely, he states that he has, on a number of occasions, asked Mr Burdon if he would like to perform, as a guest, with Mr Steel’s band. He states that he has represented Mr Steel since 1993, and he confirms that the concert at The Spotted Dog was cancelled by him due to the way it was being promoted. He also claims that the booking came via the Jason West Agency and not Alive Network. He provides an unsigned copy of an agreement with the Jason West Agency for this concert at exhibit PB2.

23) Mr Barton states that in 1997 he secured an American tour for “Animals II” the band featuring Mr Steel and Mr Valentine. He states that the band was headlined as The Animals. He confirms that in 1998 Dave Rowberry joined the band known as The Animals, which meant that three of the members of the original band in 1966 were performing again as The Animals. He states that in 2002 Mr Burdon played six concerts in the UK, performing as “Eric Burdon and The New Animals”. Mr Barton states that this year (2008) Mr Burdon is performing as “Eric Burdon and War”.

OPPONENT’S FURTHER EVIDENCE

24) The opponent filed a witness statement, dated 20 June 2008, by Richard Ralph Halstead, his Trade Mark Attorney. This statement claimed that at exhibit RRH1 “is the whole of the Application file as supplied by the Trade Marks Registry on 20 June 2008”.

25) I have summarised those documents which I feel may be relied upon by the opponent in chronological order:

- Letter from the Registry dated 30 March 2004. This set out the initial objections to the application. Briefly these were that the marks were not a series, that there were absolute grounds of objection as the marks could serve to designate the subject matter to which the goods and services relate i.e. items relating to animals and also relative grounds objections with other marks already upon the Register being cited.
- Letter dated 9 July 2004 from the applicant's agent offering a restriction in the specification in order to overcome the absolute grounds objections. These restrictions also appear to have assisted in certain of the relative grounds objections. They also referred to the use made of the marks in suit and provided a small amount of evidence.
- Letter dated 13 August 2004 from the Registry which maintains the objections under relative grounds. It also seeks evidence of use.
- Witness statement dated 9 November 2004 by John Steel. Mr Steel states that he has been the drummer for the band known as The Animals since its formation in 1963. He provides details of the bands concerts, television appearances and hits during the years 1964-1966 when the band dissolved. He states that the songs continue to be played and sold world wide. In 1968 he states that the band reformed and played two concerts. In 1972 the single "The House of the Rising Sun" was re-released and spent six weeks in the chart reaching number 25. In 1982 this single was released again and spent 11 weeks in the UK chart reaching number 11. The band recorded an album in 1975, and again in 1983. They also toured in 1983 playing three concerts in the UK. One of their songs "We Gotta Get Out of this Place" was used in two films "Platoon" and "Good Morning Vietnam". A compilation album was released in 1990. In June 1994 the band was inducted into the Rock and Roll Hall of Fame. In 2001 the song "House of the Rising Sun" was voted into fourteenth place by Channel Four viewers as part of a programme of 100 Greatest Singles Ever. Also in this year another song featured on an advertisement for a Ford car. He states that "since 1993 the band, featuring original members Dave Rowberry, Hilton Valentine, Mick Gallagher and myself, has performed live in over 30 countries, including the UK. Performing as The Animals And Friends, we continue to promote The Animals repertoire with live performances and The Animals name through radio, television and print interviews." He states that in 2004 the band will perform, or are scheduled to perform over 160 live concerts. Attached are copies of T-Shirts showing use of "The Animals". Also there are copies of advertisements for concerts in the UK, and newspaper articles which show use of the mark in suit. These are dated in the 1990s and also in the new millennium.
- Letter from the Registry dated 25 January 2005 which states that the first three marks (Animals and Friends, The Animals and Friends, John Steel and the Animals) are acceptable prima facie. The objections to the mark "Animals" are valid as the majority of the evidence shows use of "The Animals". Lastly it states:

“Finally for the mark “The Animals”, the objections are valid. Having said this however, the evidence although borderline is sufficient to waive the section 5(2) citations and the section 3(1) objection.”

26) That concludes my review of the evidence. I now turn to the decision.

DECISION

27) At the hearing the ground under Section 3(6) relating to the width of the specification originally applied for was formally withdrawn by Ms. Edwards-Stuart.

28) I shall first deal with the ground of opposition under Section 5(4)(a) which reads:

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

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

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

29) In deciding whether the mark in question “THE ANIMALS” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation 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 feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court 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 plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(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 confusion or 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.”

30) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty Limited v. The Pub Squash Co Pty Ltd* [1981] RPC 429.

31) The relevant date caused some confusion at the hearing. Initially, it seemed to be suggested that the first use of the mark THE ANIMALS by the applicant was in 1993, based on the claims made by the applicant in his witness statement to the Registry dated 9 November 2004 (see paragraph 25, point 4 above). However, then the applicant’s witness statement, dated 18 February 2008, was relied upon. This states that “For about four years, until the death of Dave Rowberry in June 2003 we traded as The Animals”(see paragraph 19 above). Eventually however, the opponent confirmed that it was contending that the applicant had never traded under the name THE ANIMALS and so the relevant date to be considered was the date of the application 11 February 2004.

32) The question then arose as to the legal relationships of the original bands. No evidence has been filed in relation to this issue. It is clear that if they had traded as a partnership at will, then the relevant authority would be *Byford v Oliver* [2005] EWRC 295 (Ch) *SAXON*. In that decision, Laddie J. set out at paragraph 19 the position as to the ownership of any goodwill. That is that at the dissolution of the partnership (when one band member departs) the assets of the partnership should be realised and divided between them. But none of them owned the goodwill. In the instant case there would have been three distinct partnerships at will during the period 1963-1966, each owning the goodwill accruing only during the individual partnerships. If the original bands traded as independent traders, then all of the members would have acquired a discreet interest in the band name and its goodwill.

33) The opponent contended that both parties in the instant case had distinguished their new bands from THE ANIMALS. The opponent by the prefix “Eric Burdon &” and the applicant by use of the suffixes “& Friends” and “II”.

34) The opponent then attempted to broaden the opposition under Section 5(4)(a) on the basis that the applicant, Mr Steel, is applying under his own name whilst any goodwill accruing would belong to the new band and not to the applicant solely. However, this was not pleaded and although it might be covered by a 5(4)(a) ground

the pleadings were clear in referring to prior rights belonging to Mr Burdon and others. Further, if the opponent is correct that at the time of applying for the mark in suit the applicant had not used the mark then there could be no goodwill accruing to any new band. Similarly, any use by the opponent of the mark in suit cannot assist his case as any goodwill accrued by him under the mark in suit would reside in him and the other performers not the original band.

35) With these considerations in mind I turn to assess the evidence filed on behalf of the parties in the present proceedings as set out earlier in this decision.

- a) The five piece band known as The Animals was formed in 1963 and dissolved in 1966. Between these dates two members of the band left at different times and were replaced. Consequently there were three distinctive line-ups, albeit that all three groups featured three common members. These groups had a number of records in the charts and appeared on television and radio as well as featuring in newspapers and magazines
- b) A version of the band reformed in 1968 to play two concerts, and again in 1983 when they played three concerts in the UK.
- c) The song “House of the Rising Sun” was re-released in 1972 and reached number twenty-five in the charts. In 1982 the same song was released again, this time reaching number eleven in the charts. In 2001 the song was featured on an advertisement for a Ford car, although details of the precise use and whether a credit was shown with the name of the band is unclear. It is also stated that another song featured in two films “Platoon” and “Good Morning Vietnam”. Again details of these films are not provided.
- d) A version of the band recorded an album in 1975, with another album being recorded in 1983. No details as to actual band members, sales figures, distribution, publicity etc are provided.
- e) In 1994 the band, The Animals, was inducted into the Rock and Roll Hall of Fame in Ohio, United States of America.
- f) As of November 2005 the website trader Amazon was offering for sale three albums by “The Animals”, and two albums by “Eric Burdon and The Animals”.

36) There is also evidence of use of the name “The Animals” by the opponent as a suffix to his own name as in “Eric Burdon and The Animals” in relation to one concert in the UK in 2003, and one other concert in the UK in 2004/2005. The opponent has also used the title on concerts in other parts of the world, and record albums. This use has not been disputed by the applicant. Mr Burdon has also registered the trade mark “The Animals” in the USA under his own name.

37) The applicant has also provided use of the mark “The Animals” from 1993 to date. During this time the titles “Animals II” and “Animals and Friends” have also been used, seemingly at random. The opponent disputes that the mark “The Animals” has been used by the applicant or a band which he is part of prior to the date of the application.

38) For the purposes of this decision I shall not dwell on the thorny issue of the three distinct groups which clearly performed under the title “The Animals” during the period 1963-1966. Instead I shall regard them as a single entity and therefore all the goodwill accrues to this single group. Clearly, the group were famous during this time and the goodwill attained would have carried on for a period after their dissolution in 1966. When they reformed for two concerts in 1968, there would have probably been speculation regarding their long term future. However, their swift demise would have meant that such speculation was short lived. No evidence is provided regarding the public reaction to the re-release of the song in 1972, but again it would have rekindled memories of the group and refreshed slightly the bands goodwill. The release of the same song for the third time in 1982 and the band reforming for three concerts may have served to refresh the goodwill which must surely have been flagging after an absence in the charts or live performances for ten years, and some sixteen years having passed since their heyday.

39) The opponent seems to have set a great deal of store in the fact that the group were inducted into the Rock and Roll Hall of Fame in the USA. However, there is an absence of detail as to how inductees are chosen, and by whom. From my personal knowledge I am aware that other such museums have policies which mean that they deliberately target persons who current audiences would not have seen in person. Further, it is not clear quite what impact this event had on the public in the UK.

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.

42) I should also comment on the contention by the opponent that the case of *Sir Robert McAlpine v Alfred McAlpine Plc* [2004] EWHC 630 was relevant. Given the earlier assertion by the opponent that the applicant has not used the mark in suit prior to the relevant date, and the, at best, sketchy use of the mark within a larger mark by the opponent this dog doesn’t hunt. Similarly, the claim for protection of a well known trade mark under Section 56, referring to the USA trade mark registrations held by the opponent must fail as almost no use of these marks has been shown.

43) In my consideration of the position under Section 5(4)(a) above I adopted the opponent’s view that the applicant had not used the mark prior to the date of the application. The opponent clearly believed that this date provided them with a stronger case. However, it is my opinion that the applicant has shown some use of the

mark in suit beginning in 1993, albeit that the evidence is sparse and the use was clearly sporadic with the marks “Animals II” and “Animals and Friends” also being used during the same time. This would mean that I have to judge the position as of 1993. Clearly, this date is closer to the demise of the original band in 1966, however, it means that the use of a song by the band in an advertisement and two films cannot be taken into account, nor can the induction into the Rock and Roll Hall of Fame. Considering the evidence I come to the conclusion that as at 1993 there was no goodwill in the mark in suit. Therefore, the ground under Section 5(4)(a) would fail as at this earlier date.

44) I therefore turn to the ground under Section 3(6) which reads:

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

45) Section 3(6) has its origins in Article 3(2)(d) of the Directive, the Act which implements Council Directive No. 89/104/EEC of 21 December 1988 which states:

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

(c) the application for registration of the trade mark was made in bad faith by the applicant.”

46) The Directive gives no more clue as to the meaning of “bad faith” than the Act. Subsequent case law has avoided explicit definition, but has not shirked from indicating its characteristics. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J stated at page 379:

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

47) The Privy Council considered earlier authorities in *Barlow Clowes International Ltd (in liquidation) & Others v Eurotrust International Limited & Others* [2006] 1 Lloyd’s Rep 225. In particular, their Lordships considered a submission from Counsel that an inquiry into the defendant’s views about standards of honesty is required. The following passage from Lord Hoffman’s judgment sets out the position as follows:-

“[Counsel for the defendant] relied upon a statement by Lord Hutton in *Twinsectra Ltd v Yardley* [2002] 2 AC 164, 174, with which the majority of their Lordships agreed:

“35. There is, in my opinion, a further consideration which supports the view that for liability as an accessory to arise the defendant must himself appreciate that what he was doing was dishonest by the standards of honest and reasonable men. A finding by a judge that a defendant has been dishonest is a grave finding, and it is particularly grave against a professional man, such as a solicitor. Notwithstanding that the issue arises in equity law and not in a criminal context, I think that it would be less than just for the law to permit a finding that a defendant had been ‘dishonest’ in assisting in a breach of trust where he knew of the facts which created the trust and its breach but had not been aware that what he was doing would be regarded by honest men as being dishonest.

“36. I consider that the courts should continue to apply that test and that your Lordships should state that dishonesty requires knowledge by the defendant that what he was doing would be regarded as dishonest by honest people, although he should not escape a finding of dishonesty because he set his own standards of honesty and does not regard as dishonest what he knows would offend the normally accepted standards of honest conduct.”

15.....Their Lordships accept that there is an element of ambiguity in these remarks which may have encouraged a belief, expressed in some academic writing, that *Twinsectra* had departed from the law as previously understood and invited inquiry not merely into the defendant’s mental state about the nature of the transaction in which he was participating but also into his views about generally acceptable standards of honesty. But they do not consider that this is what Lord Hutton meant. The reference to “what he knows would offend normally accepted standards of honest conduct” meant only that his knowledge of the transaction had to be such as to render his participation contrary to normally acceptable standards of honest conduct. It did not require that he should have had reflections about what those normally acceptable standards were.

16....Similarly in the speech of Lord Hoffmann, the statement (in paragraph 20) that a dishonest state of mind meant “consciousness that one is transgressing ordinary standards of honest behaviour” was in their Lordships’ view, intended to require consciousness of those elements of the transaction which make participation transgress ordinary standards of honest behaviour. It did not also require him to have thought about those standards were.”

48) On the basis of these authorities it is clear that a finding of bad faith may be made in circumstances which do not involve actual dishonesty. Furthermore, it is not necessary for me to reach a view on the applicant’s state of mind regarding the transaction if I am satisfied that his action in applying for the mark in the light of all the surrounding circumstances would have been considered contrary to normally accepted standards of honest conduct.

49) In terms of the date at which the matter falls to be considered, it is well established that the relevant date for consideration of a bad faith claim is the

application filing date or at least a date no later than that (*Hotpicks Trade Mark*, [2004] RPC 42 and *Nonogram Trade Mark*, [2001] RPC 21).

50) The opponent contends that this ground has two strands:

- a) That the application was sought on the basis of a number of grossly misleading statements by the applicant; and
- b) That the application was made in the knowledge that others had a greater or at least equal right in the mark.

51) The opponent referred me to a number of sentences from the evidence provided by the applicant and his Trade Mark Attorney to the Registry during the examination stage of the application. It was contended that:

“These statements were untrue and/or misleading, as the Applicant was well aware, in that they give the misleading impression that the band The Animals still exists and is still touring and that the applicant is and always has been a member of The Animals and is currently on tour with The Animals. These statements were made to give the false impression that the Applicant had a lawful right to a monopoly in the name The Animals in relation to musical performances and recordings.”

52) The evidence clearly shows that the applicant was a founder member of the band The Animals in 1963. He played in the band until very shortly before it disbanded in 1966. He played at the subsequent reunion concerts and on the reunion albums. He then began, in 1993, to use the name for a new band which had amongst its members other members of the original band. At the date of the application, the applicant had been using the name, sporadically, for a period of eleven years and no-one else had made use of the mark in the UK. Whilst the statements did not spell out that other than a handful of reunion concerts and two albums (sales unknown) there had been a twenty-seven year gap between the original use of the mark and the use made by the applicant beginning in 1993, I do not find that the applicant or his Trade Mark Attorney mislead the Registry. Nor were the statements untrue. At worst they were lacking in substance or incomplete, but not untrue. The opposition under this strand of the Section 3(6) ground fails.

53) The opponent referred me to the *Saxon* case where at paragraphs 37-39 Laddie J. held:

“37. Mr Foley then says as follows:

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

58. On the facts before me, it is my view that Mr Oliver, and arguably, Mr Dawson, had as much right to claim to be the owners of the mark in suit; albeit not exclusively, to seek to register the mark in their own names and to prevent use of the mark by third parties. However, what is good for one is good for the other. I consider that Mr Byford also had the right to regard the

trade mark as his own, and to seek register (sic) it in his own name, should he so wish. The problem now is that Mr Oliver has got there first. Taking all factors into account I do not consider that in making the application to register the trade mark Mr Oliver acted in bad faith, and the ground under Section 3(6) also fails.”

38. As indicated above, I disagree with Mr Foley’s conclusion that Mr Oliver and Mr Dawson had a right to claim to be the owners of the mark. Furthermore, inherent in the statement that Mr Oliver “got there first”, is the recognition that ownership of the mark gave the proprietors the right to interfere with the use of the same mark by others in relation to the same goods and services. That Mr Oliver and Mr Dawson could use it to interfere, not just with other former partners in the original band, but also with the current band. As a result of the letter of March 2001 and email referred to above, it can be seen that the ability to interfere is not a hypothetical possibility.

39. As Lindsay J. said, each case must be decided on its facts. Here the proprietors have obtained registration of SAXON simpliciter even though they have no existing title to it and have done so for the purpose of interfering with the rights of others who do and have consistently used the mark. In my view this is bad faith within the meaning of the section.”

54) The opponent contends that the facts of the instant case are no different and that the applicant is seeking to restrain the opponent “from doing that which he currently does and is entitled to do”.

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.

57) As the applicant has been successful he is entitled to a contribution towards his costs. In this case I have to take into account the hearing which was aborted at the request of the opponent as they had not filed evidence which they sought to rely upon. The opponent accepted that the costs for that hearing would be awarded against them regardless of the outcome of the case. As it is I have found against the opponent on all the grounds. I also take into account the fact that the opponent sought a finding of bad faith under two strands. It is accepted that such an accusation is extremely serious and should not be made lightly. In this case neither of the strands were substantiated by the opponent in its evidence, indeed one strand was withdrawn at the second hearing. The applicant has sought its full costs for the aborted hearing of £3,782 and in addition further costs of £18,218. The opponent agreed, when requesting the initial hearing be adjourned, to pay the applicant's costs for this hearing. Recently, the opponent sought to mitigate its actions by claiming that it had made it clear in its evidence that it was relying upon the evidence filed at the examination stage. As I commented earlier, the opponent's Trade Mark Attorney was experienced enough to know that in inter-partes actions evidence has to be filed for it to be taken into account, and that the examination file does not form part of the papers available to the Tribunal.

58) Taking all of the circumstances in account I do not consider the opponent's conduct to be such that an award of full costs is justified, nor do I accept that an award beyond the normal scale is appropriate. I order the opponent to pay the applicants the sum of £3782 for the aborted hearing and a further £2,150, thus giving a total sum payable of £5,932. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18 day of November 2008

**George W Salthouse
For the Registrar,
the Comptroller-General**