

O/614/19

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3199775 BY
DANSE SOCIETY LIMITED
TO REGISTER:**

Danse Society Limited

AS A TRADE MARK IN CLASSES 9 AND 41

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 408711 BY
PAUL NASH AND MAETHELIAH L NASH**

Background and pleadings

1. Elliot Paul Wheeler applied to register **Danse Society Limited** as a trade mark in the United Kingdom on 1 December 2016. It was accepted and published in the Trade Marks Journal on 9 December 2016 in respect of the following goods and services:

Class 9

Discs (Compact -) [audio-video]; Audio compact discs; Digital music downloadable provided from MP3 internet web sites; Digital music downloadable provided from MP3 internet websites; Digital music [downloadable] provided from mp3 web sites on the internet; Audio digital discs.

Class 41

Live performances by a musical band; Entertainment in the nature of live performances by musical bands; Presentation of live performances by musical bands; Band performances (Live -); Digital music [not downloadable] provided from mp3 websites on the internet; Digital music [not downloadable] provided from the internet; Digital video, audio and multimedia entertainment publishing services; DVD and CD-ROM film production; Information services relating to entertainment; Live music concerts; Live music performances; Live music services; Live music shows; Live musical concerts; Live musical performances; Live performances by a musical band; Live stage shows; Music concerts; Music performances; Music production; Music publishing; Performance of music; Performance of music and singing; Music production; Music publishing; Performance of music; Performing of music and singing; Production of audio/visual presentations; Production of audio-visual recordings; Entertainment services for sharing audio and video recordings; Production of audio master recordings; Providing digital music [not downloadable] from MP3 internet web sites; Providing digital music [not downloadable] from MP3 internet websites; Providing digital music [not downloadable] for mp3 internet web sites; Providing digital music [not downloadable] for the internet; Providing digital music from mp3 internet web sites.

2. Mr Wheeler assigned the application to The Danse Society Limited (hereafter “the applicant”) on 13 June 2018.
3. The application was opposed by Paul Nash and Maethelyiah L Nash (“the opponents”). The opposition is based upon sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”) and concerns all the applied-for goods and services.
4. With regards to their claim based upon Sections 5(2)(b) and 5(3) of the Act, the opponents are relying upon UK Trade Mark No. 3083229: **The Danse Society**. It was applied for on 26 November 2014 and registered on 2 December 2016 in respect of the following goods and services, all of which the opponents state they are relying on under section 5(2)(b) of the Act and for all of which they claim to have a reputation:

Class 9

Photographic, cinematographic, apparatus for recording, transmission or reproduction of sound or images; recording discs; compact discs, DVDs and other digital recording media; data processing equipment, computers; computer software.

Class 25

Clothing, footwear, headgear.

Class 41

Live performances by a musical band, Musical concert services, Music composition for film radio documentary and television use, Music concerts, Music performances, Music production, Music publishing, Music publishing and music recording services, Performance of music and singing, Performing of music and singing, Production of sound and music recordings, Providing digital music [not downloadable] for the internet, Providing digital music [not downloadable] from MP3 internet web sites, Providing digital music [not downloadable] from MP3 internet websites; Providing digital music [not downloadable] from the internet,

Music entertainment services, Arranging of music shows, Digital music [not downloadable] provided from mp3 web sites on the internet.

5. The opponents claim that the distinctive parts of the marks are identical and that the goods and services covered by the applicant's specification are the same as, or similar to, goods and services covered by the earlier mark, leading to a likelihood of confusion on the part of the public. Therefore, registration of the contested mark should be refused under section 5(2)(b) of the Act.
6. Additionally, or alternatively, the opponents claim that use of the applicant's mark for all the applied-for goods or services would take unfair advantage of the reputation of the earlier mark and cause detriment to its distinctive character. They claim that:

“The opposed application is causing confusion with the public and the applicant is using our reputation to run his business which is offering the same goods and services. The applicant is also maliciously advertising his services in a way that clearly damages our business as if we were the illegitimate company.”

And

“It is causing confusion with the public because it is also accompanied by our own band biography.”

Therefore, registration of the contested mark should be refused under section 5(3) of the Act.

7. Under section 5(4)(a) of the Act, the opponents claim that use of the applicant's mark for all the applied-for goods or services is liable to be prevented under the law of passing off, owing to their goodwill attached to the sign **THE DANSE SOCIETY**, which they claim to have used throughout the UK and worldwide since 1980 for the goods and services in respect of which the earlier mark is registered.

8. The opponents also claim under section 3(6) of the Act that the application was made in bad faith, as an attempt to circumvent the decision of the Appointed Person in *The Danse Society Trade Marks*, BL O-537-16. The opponents claim that individuals involved in those proceedings are associated with the applicant.
9. The applicant filed a defence and counterstatement, denying all the grounds.
10. Both the opponents and the applicant filed evidence in these proceedings. This will be summarised to the extent that is considered necessary.
11. No hearing was requested. The applicant and opponents filed written submissions in lieu of a hearing, on 14 July 2019 and 16 July 2019 respectively. These will not be summarised but will be referred to as and where appropriate during this decision, which has been taken following a careful consideration of the papers.
12. In these proceedings, the opponents are represented by Richard R Halstead & Co Ltd and the applicant represents itself.

PRELIMINARY ISSUE

13. The opponents submit that the application should be struck out as being an abuse of process by virtue of the principle of *res judicata* “in the *Henderson vs Henderson* sense”.
14. The principle of *res judicata* and *Henderson v Henderson* abuse of process were considered by the Supreme Court in *Virgin Atlantic Airways Limited v Zodiac Seats UK Limited* [2013] UKSC 46. Lord Sumption described both principles as “overlapping ... with the common purpose of limiting abusive and duplicative litigation”.¹ Earlier in the judgment he cited the statement of Wigram V-C in *Henderson v Henderson* (1843) 3 Hare 100, 115:

¹ Paragraph 25.

“In trying this question I believe I state the rule of the Court correctly when I say that, where a given matter becomes the subject of litigation in, and of adjudication by, a Court of competent jurisdiction, the Court requires the parties to that litigation to bring forward their whole case, and will not (except under special circumstances) permit the same parties to open the same subject of litigation in respect of matter which might have been brought forward as part of the subject in contest, but which was not brought forward, only because they have, from negligence, inadvertence, or even accident, omitted part of their case. The plea of *res judicata* applies, except in special cases, not only to points upon which the Court was actually required by the parties to form an opinion and pronounce a judgment, but to every point which properly belonged to the subject of litigation, and which the parties, exercising reasonable diligence, might have brought forward at the time ... Now undoubtedly the whole of the case made by this bill might have been adjudicated upon in the suit in Newfoundland, for it was of the very substance of the case there, and *prima facie*, therefore, the whole is settled. The question then is whether the special circumstances appearing upon the face of this bill are sufficient to take the case out of the operation of the general rule.”²

15. Lord Sumption went on to consider the submission made to the Supreme Court that recent case-law has recharacterised the principle in *Henderson v Henderson* as being concerned with abuse of process more generally. He said:

“I do not accept this. The principle in *Henderson v Henderson* has always been thought to be directed against the abuse of process involved in seeking to raise in subsequent litigation points which could not have been raised before.”³

16. He also cited the judgment of Lord Bingham in *Johnson v Gore-Wood & Co* [2002] 2 AC 1, at page 31:

² Cited in paragraph 18 of *Virgin Atlantic Airways*.

³ Paragraph 24.

“Henderson v Henderson abuse of process, as now understood, although separate and distinct from cause of action estoppel and issue estoppel, has much in common with them. The underlying public interest is the same: that there should be finality in litigation and that a party should not be twice vexed in the same matter.”⁴

17. It is clear that the context in which these principles apply is that of litigation. I do not consider them to be applicable in the current situation. There is nothing in trade mark law that prevents a person from filing an application for a mark that might have any degree of similarity to a mark that has already been the subject of litigation. The opposition procedure exists to allow that application to be challenged. I therefore decline to strike out the application. As the opponents in these proceedings have filed a section 3(6) claim, I shall consider the circumstances in which the application was made, and whether it was an act of bad faith, later in my decision.

EVIDENCE

18. The opponents’ evidence comes from Mrs Maethelyiah L. Nash, the singer in the band known as “The Danse Society” since January 2011.⁵ Her witness statement is dated 5 February 2019. The applicant’s evidence comes in the form of a witness statement by Mr William Armstrong, Director of Danse Society Limited, and is dated 3 April 2019. The opponents filed evidence in reply in the form of a second witness statement by Mrs Nash, dated 3 June 2019.

19. The evidence submitted contains facts, speculation, allegations and proposals for future business arrangements, many of which are not relevant to the present proceedings. The pertinent facts that have emerged from this evidence are as follows:

⁴ Cause of action estoppel and issue estoppel are two aspects of *res judicata*.

⁵ Before her marriage to the other opponent, Mr Paul Nash, she went by the name Maethelyiah L. Pile.

- A band called “The Danse Society” was formed in January 1980. The members were Paul Nash (guitars), Steve Rawlings (vocals), Tim Wright (bass), Lyndon Scarfe (keyboards) and Paul Gilmartin (drums). The band broke up in 1987.
- A band called “The Danse Society” was formed in January 2009. The members were Paul Nash (guitars), Steve Rawlings (vocals), David Whitaker (keyboards) and Paul Gilmartin (drums).⁶
- On 30 January 2014, Mr Gilmartin left The Danse Society. He then formed a band called “Heaven is Waiting” whose line-up included Mr Wheeler. “Heaven is Waiting” is the title of an album released by The Danse Society in 1983. In June 2014, Mr Gilmartin changed the name of this band to “Danse Society Reincarnated”.
- On 20 August 2014, Mr Gilmartin applied to register as a trade mark a logo comprising the words “The Danse Society”, with the letter “O” being a stylised crown of thorns device. The mark was registered on 21 November 2014. Mr Paul Nash and Ms Maethelyiah L Pile (as she then was) applied to invalidate Mr Gilmartin’s trade mark on 16 December 2014. They also applied to register the same logo and the words **The Danse Society** as trade marks. Mr Gilmartin’s trade mark was invalidated and Mr Nash and Ms Pile’s applications refused in a decision dated 17 February 2016.⁷ Mr Nash and Ms Pile appealed the latter point. Following the decision of the Appointed Person, issued on 16 November 2016, to which I have already referred.⁸ Mr Nash and Ms Pile’s applications proceeded to registration, which took place on 2 December 2016.

⁶ This is the same line-up that is depicted on the cover of the 1986 single “Hold On (To What You’ve Got)” shown in Exhibit 8 of the applicant’s evidence, page 30.

⁷ BL O-086-16.

⁸ BL O-537-16.

- Meanwhile, the company “The Danse Society Limited” had been incorporated on 5 December 2014. The directors and shareholders were Mr Gilmartin (52%) and a Mr John Dalby (48%).
- On 1 December 2016, Mr Wheeler filed a trade mark application for **Danse Society Limited**. Mr Wheeler was a member of Mr Gilmartin’s band.
- Mr Armstrong, the uncle and godfather of Mr Wheeler, was appointed as a director of The Danse Society Limited on 3 January 2017. Mr Gilmartin resigned his directorship on 17 January 2017 and his shareholding was transferred shortly afterwards to Mr Armstrong. Mr Dalby’s directorship was terminated on 18 December 2018. Mr Armstrong states that the reason for this is that Mr Dalby had expressed the desire to resign and then did not respond to requests to put this in writing. He was removed at an Extraordinary General Meeting.
- Mr Wheeler’s trade mark application was assigned to The Danse Society Limited on 13 June 2018.
- The current line-up of the band “The Danse Society” is Paul Nash (guitars), Maethelyiah L Nash (vocals, from January 2011), Jack Cooper (bass, from March 2014), Sam Bollands (keyboards, from October 2014), Tom Davenport (drums) (from January 2018).
- Mr Gilmartin’s band now performs as “The Society”.

20. I end my summary of the evidence here for the present, but will refer to it in more detail where appropriate in my decision.

DECISION

Section 5(2)(b) ground

21. Section 5(2)(b) of the Act states that:

“A trade mark shall not be registered if because –

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

22. An “earlier trade mark” is defined in section 6(1) of the Act:

“In this Act an ‘earlier trade mark’ means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

23. The registration upon which the opponents rely qualifies as an earlier trade mark under the above provision. In this opposition, the opponents are relying upon all the goods and services for which this earlier mark is registered. As the mark was registered within the five years before the date on which the applicant’s mark was published, it is not subject to proof of use and the opponents are therefore entitled to rely on all the goods and services for which the mark stands registered.

24. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the courts of the European Union in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for*

Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (Case C-3/03), Medion AG v Thomson Multimedia Sales Germany & Austria GmbH (Case C-120/04), Shaker di L. Laudato & C. Sas v OHIM (Case C-334/05 P) and Bimbo SA v OHIM (Case C-519/12 P):

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

25. The goods and services to be compared are shown in the table below:

Opponent's goods and services	Applicant's goods and services
<p><u>Class 9</u> <i>Photographic, cinematographic, apparatus for recording, transmission or reproduction of sound or images; recording discs; compact discs, DVDs and other digital recording media; data processing equipment, computers; computer software.</i></p> <p><u>Class 25</u> <i>Clothing, footwear, headgear.</i></p>	<p><u>Class 9</u> <i>Discs (Compact -) [audio-video]; Audio compact discs; Digital music downloadable provided from MP3 internet web sites; Digital music downloadable provided from MP3 internet websites; Digital music [downloadable] provided from mp3 web sites on the internet; Audio digital discs.</i></p>

Opponent's goods and services	Applicant's goods and services
<p><u>Class 41</u></p> <p><i>Live performances by a musical band, Musical concert services, Music composition for film radio documentary and television use, Music concerts, Music performances, Music production, Music publishing, Music publishing and music recording services, Performance of music and singing, Performing of music and singing, Production of sound and music recordings, Providing digital music [not downloadable] for the internet, Providing digital music [not downloadable] from MP3 internet web sites, Providing digital music [not downloadable] from MP3 internet websites; Providing digital music [not downloadable] from the internet, Music entertainment services, Arranging of music shows, Digital music [not downloadable] provided from mp3 web sites on the internet.</i></p>	<p><u>Class 41</u></p> <p><i>Live performances by a musical band; Entertainment in the nature of live performances by musical bands; Presentation of live performances by musical bands; Band performances (Live -); Digital music [not downloadable] provided from mp3 websites on the internet; Digital music [not downloadable] provided from the internet; Digital video, audio and multimedia entertainment publishing services; DVD and CD-ROM film production; Information services relating to entertainment; Live music concerts; Live music performances; Live music services; Live music shows; Live musical concerts; Live musical performances; Live performances by a musical band; Live stage shows; Music concerts; Music performances; Music production; Music publishing; Performance of music; Performance of music and singing; Music production; Music publishing; Performance of music; Performing of music and singing; Production of audio/visual presentations; Production of audio-visual recordings; Entertainment services for sharing audio and video recordings; Production of audio master</i></p>

Opponent's goods and services	Applicant's goods and services
	<i>recordings; Providing digital music [not downloadable] from MP3 internet web sites; Providing digital music [not downloadable] from MP3 internet websites; Providing digital music [not downloadable] for mp3 internet web sites; Providing digital music [not downloadable] for the internet; Providing digital music from mp3 internet web sites.</i>

26. The Court of Justice of the European Union (CJEU) held in *Canon Kabushiki Kaisha* that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary.”⁹

27. In *Kurt Hesse v OHIM*, C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The General Court clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, T-325/06:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”¹⁰

⁹ Paragraph 23
¹⁰ Paragraph 82.

28. Guidance was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

29. In construing the terms used in the specifications, I keep in mind the comments of Floyd J (as he then was) in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch):

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved

a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”¹¹

Identical Goods and Services

30. The following applied-for goods and services are self-evidently identical to goods and services in the opponent’s specification: *Discs (compact -) [audio-video]; audio compact discs; audio digital discs; Live performances by a musical band; Entertainment in the nature of live performances by musical bands; Presentation of live performances by musical bands; Band performances (Live -); Digital music [not downloadable] provided from mp3 websites on the internet; Digital music [not downloadable] provided from the internet; Live music concerts; Live performances by a musical band; Music concerts; Music performances; Music production; Music publishing; Performance of music; Performance of music and singing; Providing digital music [not downloadable] from mp3 internet websites; Providing digital music [not downloadable] for mp3 internet websites; Providing digital music [not downloadable] for the internet; Providing digital music from mp3 internet websites.*

31. In addition to these, there are other services that may be considered to be identical. In *Gérard Meric v OHIM*, Case T-133/05, the General Court stated that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”¹²

¹¹ Paragraph 12.

¹² Paragraph 29.

32. The opponents' services include *Music entertainment services*. In the light of *Meric*, I find that the applicant's *Live music performances*, *Live music services*, *Live music shows* and *Live musical performances* are identical to the opponent's services, as they are included in the more general category.
33. I also find that the applicant's *Production of audio master recordings* is identical to the opponents' *Music production* on the same principles. The average consumer would understand *Music production* to refer to the process of recording music and adding effects, altering the balance, or making any other changes required to result in the version that the listener hears when they play a track. The product of this process is the master recording from which copies are then made. The applicant's term is broader, as it includes recordings of speech as well as music.

Class 9

34. The applicant's remaining goods are *Digital music downloadable provided from mp3 internet websites*, *Digital music downloadable provided from mp3 internet web sites* and *Digital music downloadable provided from mp3 web sites on the internet*. Since the terms are simply three ways of describing the same goods, I shall deal with them collectively. The users of these goods are the same as those of the opponents' service of *Providing digital music [not downloadable] from mp3 internet websites*, as is the purpose and the method of delivery to the consumer. The goods and services are in competition, and the choice the consumer makes will be guided by a number of factors, including cost. For some, it will be more convenient and cheaper to subscribe to a non-downloadable, streaming service than purchase individual tracks. Consequently, I find these goods and services to be highly similar.

Class 41

35. The applied-for term *Digital, video, audio and multimedia entertainment publishing services* encompasses the publication of a wide range of entertainment products featuring sound (both music and speech), moving and static images, and text. The opponents' *Music publishing*, on the other hand, could include both the publication

of both music recordings and printed sheet music. While the services are not identical on the *Meric* principle, there is some overlap in terms of users, uses, physical nature and trade channels. I find that the services are similar to at least a medium degree.

36. The applicant's *DVD and CD-ROM film production, Production of audio-visual presentations* and *Production of audio-visual recordings* are all services involving the creation of sequences of sounds and images. Where goods and services are "sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons", they may be considered collectively: see *SEPARODE Trade Mark*, BL O-399-10. Of the opponents' goods and services, *Music production* is, to my mind, the most similar. The nature of the service is similar and there will be some overlap in the users, as many musicians will want to appear in videos, as well as sound recordings. In my view, the average consumer would expect the suppliers of these services to be either specialists or businesses providing a one-stop shop for audio and visual production. I find that the services are similar to a medium degree.
37. *Information services relating to entertainment* could be provided online, in print or be broadcast, and could be supplied by the undertaking responsible for providing the entertainment or by an unrelated third party. In the case of the former, the service provided is likely to be promotion of the entertainment services offered by that undertaking, rather than trading in information about entertainment. It is not obvious to me that a consumer would assume that there is a trade connection between these services and the opponents' *Music entertainment services*, which I consider to be the closest comparison. The services are different in nature and intended purpose. Furthermore, the opponent's services are restricted to music, rather than the broad category of entertainment. Any complementarity will, therefore, be fairly low: music entertainment services are important or even indispensable to the provision of information relating to entertainment of a musical kind. I find that, based on their complementarity, there is a degree of similarity between the services, but it is at a very low level.

38. I move on to consider the applicant's *Live stage shows*. There is some overlap with the opponent's *Music performances*, as concerts may involve an element of spectacle which, in my view, is at the core of the natural meaning of "show", but the applicant's term encompasses shows with no musical aspect at all. Neither can all music performances be fairly described as "shows". The users are the same, as is the intended purpose of entertainment. The nature of the service is the same: the consumer goes to a venue to watch and listen to the show or performance. The services are in competition with each other for an audience, but are not complementary. I find that these services are similar to a medium degree.
39. The average consumer would understand the applicant's term *Entertainment services for sharing audio and video recordings* to refer to services that enable users to upload recordings they have made, for example to a website, and to watch or listen to recordings made by others. There is a clear overlap with the opponents' *Music entertainment services*, but this is not total, as some of the recordings may not contain any music. The users of the opponents' services are the audience for the music, while those of the applicant's services create content as well as consume it. It will be seen that the intended purpose is different. The opponents' services will take a greater variety of forms than the applicant's, including live performances as well as recordings. As with the provision of information services, a service for sharing recordings that is supplied by a music entertainment provider is likely to be promoting that provider's own music. I find that there is similarity between these services to no more than a medium degree.

Average consumer and the purchasing act

40. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, I must bear in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: see *Lloyd Schuhfabrik Meyer*.

41. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading Limited), U Wear Limited, J Fox Limited* [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”¹³

42. In relation to the goods and services at issue, there are two types of average consumer. The first is a member of the general public, who purchases tickets to take watch live performances or who watches or listens to recordings. They will make the selection using primarily visual means, seeing adverts or other promotional material in the press or in public places, or using websites. I must also take account of the aural element, as word-of-mouth recommendations and hearing future events discussed, for example, on the radio will play a part. The cost of the live performances will vary greatly, depending on the reputation of the performers or the lavishness of the spectacle. In relative terms, the recordings will be relatively inexpensive and are likely to be regular purchases. Particularly in the case of non-downloadable digital content providers, the average consumer is likely to pay a monthly subscription for access, or use “free” services that are in fact funded by advertising. In my view, the average consumer will pay an average level of attention when making their decision.
43. The second type of average consumer is a creative professional who wants to use production or publishing services. Word-of-mouth recommendations are likely to play a bigger role here, although the visual element will still, in my view, be more important. The average consumer will browse the internet and see adverts. The

¹³ Paragraph 60.

services will be relatively expensive and make a significant impact on the way that an artist is presented to its current and potential public. With this in mind, I consider that this type of average consumer will be paying a higher than average level of attention when making their decision.

Comparison of marks

44. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”¹⁴

45. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

46. The respective marks are shown below:

Earlier mark	Applied-for mark
The Danse Society	Danse Society Limited

¹⁴ Paragraph 34.

47. The opponents' mark consists of three words, the first of which is the definite article. The opponents submit that the distinctive element of the mark is "Danse Society". I agree. These two words hang together as a unit, which has the same meaning, whether or not the definite article is present. The overall impression of the mark lies in those two words.
48. The same words begin the applied-for mark and are followed by the word "Limited". I find this last word to be non-distinctive, as it simply describes the corporate structure of the applicant. The overall impression of the mark lies in the words "Danse Society", which hang together as a unit.

Visual comparison

49. Both marks consist of the same number of words and their distinctive elements are identical, although those elements are in different positions in the mark. Each mark is presented in a normal font and in upper and lower case. I find there to be a very high level of visual similarity between them.

Aural comparison

50. The opponents' mark has six syllables, while the applicant's mark has eight. Given the non-distinctiveness of the words "THE" and "LIMITED", it is likely that some consumers would just articulate the phrase "DANSE SOCIETY". For these consumers, the marks are aurally identical. Even when all the words are spoken, the marks are aurally highly similar.

Conceptual comparison

51. The conceptual meaning of both marks is carried by the distinctive element: "DANSE SOCIETY". Consequently, I find them to be conceptually identical.

Distinctiveness of the earlier mark

52. There is, as has already been noted, a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark's distinctive character in *Lloyd Schuhfabrik Meyer*:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

53. The opponents have not claimed that the distinctiveness of its earlier mark has been enhanced through use, neither have they provided enough evidence of the kind described by the CJEU. Mrs Nash refers to the playing of a track by The Danse Society on national radio (BBC 6 Music), but this in itself does not demonstrate that the mark is known to the relevant public. No financial information or numbers of tickets sold have been supplied. Therefore, I can only consider the mark's inherent distinctiveness. While “SOCIETY” is a commonly used English

word, “DANSE” will be seen as a mis-spelling of “DANCE”, another dictionary word. Dance tends to be performed to the accompaniment of music, and live performances by a band may include dance elements. I find there to be a degree of allusiveness to this mark. This would give the mark a relatively low level of inherent distinctiveness, but the alternative spelling of “DANCE” raises it slightly, although to a no-more-than-medium level.

Conclusions on likelihood of confusion

54. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph [24]. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa.¹⁵ The distinctiveness of the earlier mark must also be taken into account.
55. Such a global assessment does not imply an arithmetical exercise, where the factors are given a score and the result of a calculation reveals whether or not there is a likelihood of confusion. I must keep in mind the average consumer of the goods and services and the nature of the purchasing process. I note that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture he has kept in his mind.¹⁶
56. The degree of similarity between the marks is so high that it seems to me that, where the goods and services are identical or similar to at least a medium degree, it is likely that the average consumer would be confused. Even where there is a low degree of similarity (*Information services relating to entertainment*), in my view the average consumer would confuse the marks. The elements that are additional to “DANSE SOCIETY” in both marks are non-distinctive and will easily be misremembered, if they are recalled at all. If the average consumer were to encounter those information services under the applied-for mark, I consider that they would believe it to be the same mark as that of the opponents.

¹⁵ *Canon Kabushiki Kaisa*, paragraph 17.

¹⁶ *Lloyd Schuhfabrik Meyer*, paragraph 27.

Outcome of Section 5(2)(b) ground

57. The opposition succeeds fully under section 5(2)(b) of the Act.

Section 5(3) ground

58. Even though the opposition has succeeded under section 5(2)(b) of the Act, I shall briefly consider the remaining grounds.

59. Section 5(3) of the Act states that a trade mark which is identical with or similar to an earlier trade mark

“shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community/European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

60. The conditions of section 5(3) are cumulative:

- 1) The opponent must show that the earlier mark has a reputation.
- 2) The level of reputation and the similarities between the marks must be such as to cause the public to make a link between the marks.
- 3) One or more of three types of damage (unfair advantage, detriment to distinctive character or repute) will occur.

It is not necessary for the goods to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

61. In *General Motors Corporation v Yplon SA*, Case C-375/97, the CJEU gave the following guidance on assessing whether the earlier mark has a reputation:

“In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”¹⁷

62. As I have already noted when discussing the distinctiveness of the opponents’ mark under section 5(2)(b), the evidence submitted with a view to adducing such facts is extremely patchy. Consequently, I am unable to find that the opponent’s mark has a reputation and the section 5(3) ground fails.

Section 5(4)(a) ground

63. Section 5(4)(a) of the Act states that:

“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 or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(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’.

64. It is settled law that for a successful finding of passing off, three factors must be present: goodwill, misrepresentation and damage, the so-called “classical trinity” of that tort: see *Reckitt & Colman Products v Borden (“Jif Lemon”)* [1990] 1 WLR 491 HL, [1990] RPC 341, HL.

¹⁷ Paragraph 27.

65. 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 advantages 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

66. As with the section 5(3) ground, I find that the evidence submitted does not support a claim that the opponents have goodwill associated with the sign **THE DANSE SOCIETY**. While references are made to concerts and recordings, and Mrs Nash states that the band has “a strong following in relation to [the alternative] genre of music”, I am unable to assess whether these actually reflect goodwill.¹⁸ In particular, I cannot make such an inference from the fact that a band has played at festivals, which typically have a large number of performers, not all of which would draw a reasonably sized audience. Furthermore, no evidence of UK sales figures has been provided. The section 5(4)(a) ground must also fail.

Section 3(6)

67. Section 3(6) of the Act states:

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

¹⁸ First witness statement of Mrs Nash, paragraph 2.

68. The law in relation to section 3(6) of the Act was summarised by Arnold J in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), as follows:

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C-529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but 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’: see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at [379] and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly’s Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant’s conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant’s own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant’s intention. As the CJEU stated in *Lindt v Hauswirth*:

‘41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, *inter alia*, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48).”

69. In deciding the section 3(6) ground, I must determine whether the opponents have proved on the balance of probabilities that, in applying for the mark, the conduct of the applicant, judged by the ordinary standards of honest people, was somehow dishonest or otherwise fell short of the standards of acceptable commercial behaviour.

70. The opponents claim that filing the application was an attempt to “circumvent the clear intention of the Appointed Person to vest exclusive rights in the name of our band” to them.¹⁹ Mr Armstrong, however, states that:

“as far as I know [the application] was not made in bad faith or in an attempt of abuse of process as it was an attempt to protect the earlier rights (sometimes called prior rights) of the Band then known as Danse Society Reincarnated as well as the rights of Paul Gilmartin to speak and write about his history in the original Danse Society since the 1980s.”²⁰

71. Mr Armstrong also makes this point in his witness statement. He continues:

“Despite the animosity and acrimony between members of the two Bands (Danse Society Official and Danse Society Reincarnated) Elliot Wheeler had expressed to myself that ‘Paul and Maeth Nash are welcome to the name Danse Society, just as long as Paul Gilmartin can have his history.’”²¹

Mr Armstrong does not record when Mr Wheeler said this.

72. Taking what Mr Armstrong says at face value, it seems curious that it was Mr Wheeler who made the application rather than Mr Gilmartin or the company of which he was a director and which is now the applicant. Mr Wheeler himself has provided no witness statement, although it should not have been difficult for Mr Armstrong, given his close family connections, to obtain one. From the evidence I have before me, it seems to me probable that Mr Wheeler made the application on behalf of either Mr Gilmartin or his company. There is nothing to suggest that he was intending to use it himself. What little evidence there is indicates that he and Mr Armstrong were acting in the interests of Mr Gilmartin. I recall the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *John Williams and Barbara Williams v Canaries Seaschool SLU*, BL O-074-10:

¹⁹ First witness statement of Mrs Nash, paragraph 9.

²⁰ Page 2 of the statement of 2 December 2018, submitted by Mr Armstrong.

²¹ Paragraph 21.

“It seems to have been a matter of administrative convenience that the opposed application for registration was filed in the name of Andrew Williams’ partner, Janet Willis, before being assigned to the Applicant. No argument to the contrary has been raised on its behalf. On the basis of the evidence on file, the knowledge, intentions and motives of Andrew Williams can properly be attributed to the Applicant...”²²

73. In the counterstatement itself, the applicant states that:

“We want to continue the application for our Trade Mark mainly to protect the prior rights as specified in the above mentioned statement [rights arising from the activities of the 1980s band and of Mr Gilmartin’s band]. There has been repeated ‘over-use’ (in our opinion) by the opponents to remove performances and statements on the likes of Facebook and YouTube relating to matters prior to 2017 as infringing their Trade Mark even when they have been informed that their Trade Mark is effective only from January 2017.”²³

74. This is of course evidence from a date after the date of application for the trade mark, but, as Arnold J noted, such evidence may shed light on the position at the date of application. The contested mark was applied for after the publication of the Appointed Person’s decision and the day before its registration. At the time, Mr Armstrong appears to have been offering informal advice (he attended the hearing before the Appointed Person), and made the suggestion to get professional legal advice. He states that he believed (erroneously) that there were grounds for appealing this decision, although he also says that he never felt the decision was incorrect.²⁴

75. Mr Armstrong therefore presents the application of the trade mark as a defensive measure to protect prior rights. In her first witness statement, Mrs Nash seems to

²² Paragraph 51.

²³ According to section 40(3) of the Act, the date of filing of the application for registration is deemed for the purposes of the Act to be the date of registration, i.e. 26 November 2014.

²⁴ See paragraphs 12-16 of Mr Armstrong’s witness statement.

interpret this statement as a lack of acceptance of the Appointed Person's decision. Mr Armstrong, in response, states:

"The Decision of the Appointed Person was found in favour of Paul and Maethelyiah Nash and their continuity of the Band after the split in January 2014. The decision centred on the continuity of that Band. There was no mention in the Decision of the Appointed Person to backdate that award to the year 1980."²⁵

76. It is not implausible that Mr Gilmartin or his associates believed he possessed rights in relation to the activities of the 1980s band. The existence of such rights did not come up in the appeal to the Appointed Person, although the opponents claimed, at least at the time of filing the notice of opposition, that **DANSE SOCIETY** had been the property of Mr Nash since 1980. The existence of such rights is beyond the scope of these proceedings, but the facts are consistent with such a belief. I note that the applicant put the opponents to proof of Mr Nash's claim to ownership from 1980. No proof was provided.

77. In *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others* [2009] RPC 9, Arnold J stated that:

"In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark."²⁶

78. An allegation of bad faith is a serious one and must be distinctly proved. On the balance of probabilities, it is my view that the claim has not been made out, and

²⁵ Witness statement of William Armstrong, paragraph 19.

²⁶ Paragraph 189.

that the opposition fails under section 3(6). This does not, however, affect the overall outcome of these proceedings, which succeed under section 5(2)(b).

Conclusion

79. The opposition has been successful under section 5(2)(b). The application by The Danse Society Limited will be refused.

Costs

80. The opponents have been successful. In line with Tribunal Practice Notice 2/2016, they would ordinarily be entitled to a contribution towards their costs. However, their representative has been acting on a pro bono basis. In the circumstances, I make no award of costs, apart from the reimbursement of the official fee of £200.

81. I therefore order Danse Society Limited to pay Mr Paul Nash and Mrs Maethelyiah L. Nash jointly the sum of £200. The above sum should 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 10th day of October 2019

Clare Boucher

**For the Registrar,
Comptroller-General**