

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 96672

IN THE NAMES OF ANNETTE CAMPBELL AND BENTE ZABER

TO TRADE MARK APPLICATION No. 2463230

IN THE NAME OF CATHERINE HUGHES

DECISION

1. On 4 August 2007 Catherine Hughes (*‘the Applicant’*) applied under number 2463230 to register the name **IAN ADAM** as a trade mark for use in relation to the following services in Class 41:

Education; providing of training, voice training, voice coaching; voice lessons; entertainment; sporting and cultural activities.

The Applicant thereby sought to acquire the right to control commercial exploitation of the name of her friend and professional associate Ian Adam.

2. Ian Adam was a renowned voice training teacher. He was born in Scotland on 12 March 1943. He died at the Royal Brompton Hospital in London on 10 May 2007. His obituary published in The Times newspaper on 22 May 2007 under the heading *‘Ian*

Adam. Dedicated vocal coach whose inspirational teaching helped a generation of theatrical stars’ profiled his life and work in the following terms:

The intensely musical and inspirational teaching of the voice coach Ian Adam had a profound influence on the singing styles of many leading musical performers in British theatre during the past three decades. He had a genius for bringing out the potential in any voice. [...]

Adam’s beginnings were steeped in music. Born in Fortrose on the Black Isle in Scotland in 1943, he worked as a boy with Benjamin Britten in musical summer schools and had a deep love of opera. He was an accomplished singer and joined Scottish Opera, playing leading and character roles before deciding to become a voice teacher.

Renowned for his low-key professionalism coupled with a dry, and often unrepeatable, sense of humour, the soft-spoken Scot began to make a name for himself among West End theatre managements and performers. [...]

As Adam’s fame grew, stars from both sides of the Atlantic queued up for his tuition. While he charged top rates for those sent direct from Hollywood studios, he would often waive his fee for exceptional or impoverished students.

In 1989 he had his own BBC television show *‘I’d Like To Teach The World To Sing*, a series of masterclasses in which he expounded the idea that ‘everyone can sing’.

3. His obituaries in The Times, The Guardian, The Independent and The Stage newspapers indicate that his voice training skills were highly valued not only in the world of media and entertainment but also among people from other walks of life. A concert with a *‘star-studded cast to pay tribute to world-leading vocal coach, Ian Adam’* took place at Her Majesty’s Theatre, Haymarket in London on 24 February 2008 to raise money for the Ian Adam Memorial Fund in aid of respiratory treatment programmes at

the Royal Brompton Hospital. This received wide coverage in printed and online media. There are also many enduring references to Ian Adam's work in biographical materials published by and about those who benefitted from his teaching.

4. For more than 35 years down to the date of his death in 2007, Ian Adam lived at 15 Ovington Street, London SW3 in a house with a studio which he used for teaching purposes. He was assisted from time to time by the Applicant. She provided voice training services to clients at the studio, usually or perhaps invariably as a stand-in for him when he was working abroad. Unfortunately, the evidence on file in the present proceedings is contradictory with regard to the nature and extent of their collaboration in that connection.

5. The present application for registration was opposed by Annette Campbell and Bente Zaber (*'the Opponents'*). In their Notice and Grounds of Opposition filed under number 96672 on 20 March 2008, the Opponents objected to the application on absolute grounds under Sections 3(3)(b) and 3(6) of the Trade Marks Act 1994 and on relative grounds under Section 5(4)(a).

6. The objection under Section 5(4)(a) was removed from the pleadings in November 2008. The objection under Section 3(3)(b) was pursued unsuccessfully at first instance. It was raised on appeal, but ultimately not proceeded with. The objection under Section 3(6) was pursued unsuccessfully at first instance. It was raised on appeal and is now the only basis on which it is contended that registration should be refused.

7. Section 3(6) implements the optional ground of objection to registration contained in Article 3(2)(d) of the Trade Marks Directive (Directive 2008/95/EC of 22 October 2008). It does so by providing that:

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

The corresponding provisions of the Community Trade Mark Regulation (Regulation 207/2009/EC of 26 February 2009) are Articles 52(1)(b) and 52(3).

8. In their Statement of Grounds the Opponents contended as follows:

- 1) Ian Adam was a world-renowned vocal coach who died in May 2007. Throughout a long and illustrious career Ian Adam developed a substantial reputation in the musical world both for his voice coaching, and for the techniques that he developed.
- 2) The Opponents are Annette Campbell (Ian Adam's next-of-kin) and Bente Zaber (one of Ian Adam's closest business partners, who was trained by Ian Adam in his techniques and teaching).

...

- 4) The Opponents claim that the application is filed in bad faith, and therefore registration of the application would be contrary to Section 3(6). The Opponents claim that the Applicant has no rightful proprietorial claim to the trade mark. The Applicant has been invited a number of times to explain the nature of her claim to own the trade mark but she has always declined to do so.

In the circumstances the Opponents believe that the application has been filed in an attempt to take advantage of the reputation of Ian Adam, and to

disrupt the ongoing business of others who use the voice coaching techniques of Ian Adam.

The Applicant joined issue with the Opponents on these contentions in a Counterstatement filed on 27 June 2008. She did so without pleading any positive basis for claiming an independent or derivative right to register the trade mark **IAN ADAM** in her own name. The Counterstatement was deficient for failing to foreshadow the case on entitlement she subsequently put forward in her witness statement of 19 March 2009 (see paragraph 10 below). In effect, the Opponents were left to deal with the substance of her case in their evidence in reply.

9. The Opponents' evidence in support of the opposition broadly substantiated the averments made in paragraph 1 of their Statement of Grounds. It established that Bente Zaber had worked quite closely and quite frequently with Ian Adam, primarily for the purpose of enabling people to benefit from his voice training skills and techniques in Denmark and elsewhere in Scandinavia. No evidence was at that stage adduced in support of the averment that Annette Campbell was *'Ian Adam's next-of-kin'* as pleaded in paragraph 2 of the Statement of Grounds. The central contention that *'the Applicant has no rightful proprietorial claim to the trade mark'* (see paragraph 4 of the Statement of Grounds) was pursued on the basis of evidence intended to show that although the Applicant had provided voice training services to clients of the late Ian Adam during his lifetime, she had only done so for short periods at irregular intervals on a locum basis.

10. The Applicant defended her application for registration in a six-paragraph witness statement of 19 March 2009 in which she stated as follows:

1. I am a trained classical singer and singing teacher/voice coach. Attached marked Exhibit 1 are copies of newspaper clippings and advertisements detailing some of the work which I have undertaken to date.
2. I was a friend of Ian Adam for almost 40 years. I have worked with Ian Adam since as early as 1970 at 15 Ovington Street, London. I have provided singing lessons and voice coaching to a wide range of clients alongside Ian Adam since the 1990's. Ian Adam and I both operated the Ian Adam Song Studio, each providing singing lessons and voice coaching to clients. Since Ian Adam's death in 2007, I have continued to operate the Ian Adam Song Studio from the original address at 15 Ovington Street which is also my resident address. In addition to assisting Ian Adam I have since the early 1990's been responsible for the sole operation of the Ian Adam Song Studio for periods of several months each year while Ian Adam was out of the country teaching or on business. I have also been left in sole charge of the singing practice for regular periods while Ian Adam was in hospital obtaining treatment for his illness. Attached marked Exhibit 2 is a written statement by Mr. Rob Nash confirming details in this regard.
3. Attached marked Exhibit 3 are copies of two letters confirming my status as a singing teacher at the Ian Adam Song Studio.
4. Attached marked Exhibit 4 is a copy of a stamp which is applied to all receipts when invoicing clients of the Ian Adam Song Studio. The clients whom worked with both Ian Adam and I have confirmed my status as a singing teacher at the Ian Adam Song Studio. Please see the evidence submitted by the Opponents which confirms this. In particular, I refer to Exhibit EC2 of the Witness Statement of Edward Carstairs in the Opponent's evidence attached again hereto as Exhibit 5. This is an article by Clive James printed in the Guardian on 4 June 2007 and which, as you will see, confirms my role as *'Ian's devoted assistant, Kate Hughes, who filled in for him when he was away, imposed the same regime of disciplinary*

warm up, so we all got to reproduce the strange sets of sounds week by week, forever’.

5. Also exhibited hereto as Exhibit 5 is a copy of the article by Michael Coveney printed in the Guardian and referred to in the Opponent’s evidence as Exhibit EC1 in the Witness Statement of Edward Carstairs. This again contains a statement confirming my status in the Ian Adam Song Studio, namely, ‘, *and Scottish Opera in Glasgow where he met his lifelong assistant, Kate Hughes, and started to develop his singing practice in London’.*
6. During his time at the Royal Brompton Hospital and in the final stage of his illness, Ian Adam appointed me as his next of kin. Attached hereto marked Exhibit 6 is a copy of this letter and a copy from the hospital records confirming my appointment as next of kin.

11. There were three main components to the case presented in her witness statement: (1) that singing lessons and voice coaching services had been provided to clients of the **IAN ADAM SONG STUDIO** at 15 Ovington Street continuously since at least the early 1990’s; (2) that Ian Adam and the Applicant ‘*both operated*’ the **IAN ADAM SONG STUDIO** by providing singing lessons and voice coaching services to clients from the early 1990’s down to the date of his death in 2007; and (3) that in the final stages of his illness Ian Adam had appointed the Applicant by letter to be ‘*his next-of-kin*’ and she had ‘*since Ian Adam’s death in 2007*’ continued to operate the **IAN ADAM SONG STUDIO** at 15 Ovington Street ‘*which is also my resident address*’.

12. Exhibit 6 to the Applicant’s witness statement consisted of a hospital record printed on 11 May 2007. Under the heading Registration - Next Of Kin Details she was named as a ‘*Friend*’ with an address in ‘*Aberdeen, Scotland*’. Contrary to what was said

in paragraph 6 of her witness statement, the Exhibit did not contain a copy of any letter from Ian Adam appointing the Applicant as his next-of-kin. The Exhibit simply showed that she had been named as a 'friend' who could be contacted by the hospital if the need should arise.

13. The Applicant's account of events was challenged by the Opponents in their evidence in reply. In addition to re-asserting that the Applicant had only provided voice training services to clients occasionally and as a stand-in for the late Ian Adam, the Opponents adduced evidence in reply to the following effect:

- (1) that his business ledgers and financial affairs had for many years been looked after by a secretarial assistant on whom he relied totally for help with VAT and with collation of the information required for his annual tax returns;
- (2) that the accountant who dealt with his tax affairs for more than 15 years prior to his death in 2007: (a) was not aware of any partnership arrangement with the Applicant; (b) had not been contacted by her as would have occurred if a partnership arrangement had existed; (c) had no recollection of hearing her name mentioned or of meeting her on any of his visits to 15 Ovington Street; and (d) had never heard of the expression **IAN ADAM SONG STUDIO** being used in relation to any business at that address;
- (3) that Ian Adam had been ill and taken into hospital on several occasions prior to 2007 and it was always his habit to name the person he was with as 'next-of-kin' for hospital contact.

14. Annette Campbell provided a witness statement with regard to kinship and the administration of Ian Adam's estate. This was her first and only witness statement in the proceedings. She stated as follows:

- 1) I am the only niece of the late Ian Adam.
- 2) When I was told of his death, I was also told by Catherine Hughes that he had not left a will and that he was in serious debt. She also told me, repeatedly, that possessions would have to be sold to accumulate monies for outstanding bills, especially a tax bill. She said she would keep me updated on this.
- 3) In June 2007, I was informed by Catherine Hughes I would have to come to London to meet with a solicitor because, as next of kin, my presence was required.
- 4) We met the solicitor at a place called Liphook. In all there were 7 of us there, including my husband and I and Catherine Hughes. At all times Catherine Hughes referred to me as the sole next of kin. I instructed the solicitor that it would be acceptable for Catherine Hughes and Andrew McRobb to settle my uncle's affairs, as long as I was kept informed of any decisions that were made.
- 5) At one stage Catherine Hughes told me that my uncle had no business. However, she now runs what she states to be my uncle's business and she refers to "the Ian Adam Song Studio" in the letterhead of any correspondence she sends. However, my uncle did not run a business called "Ian Adam Song Studio" and he did not use the term "Ian Adam Song Studio".
- 6) Attached at exhibit AC1 is a copy of a letter from the solicitor [...] who we met in Liphook. This letter shows that my uncle was a statutory tenant at 15 Ovington Street, and could not have passed on any right to live or work there to Catherine Hughes or any other person.

- 7) When my uncle was away, Catherine Hughes stayed at his home and carried out her own practice but she taught in a very different way to my uncle. Only Bente Zaber in Denmark knew of, and followed, his technique.
- 8) Since my uncle's death, I believe that Catherine Hughes has been running her own business from two different addresses; one in London and one in Aberdeen, and has attempted to make it more successful by using my uncle's name.
- 9) At exhibit 2 of her witness statement, Catherine Hughes includes a letter from Mr. Rob Nash. Mr. Nash claims that he was employed by my uncle and that "from 1991 to 2007 Kate Hughes was regularly invited by Mr. Adam to teach at his studio in Chelsea, London while Ian was away working on location with clients or giving master classes abroad". From 2001 Mr. Nash was not employed by my uncle and had no contact with him from that date. Therefore it is unlikely Mr. Nash had knowledge of any arrangements my uncle made with Catherine Hughes.
- 10) Catherine Hughes also claims in her witness statement that she was appointed next of kin to Ian Adam. I do not see how this can be as I am Ian Adam's next of kin. The letter from the solicitor, at exhibit AC1, indicates that only under my authority, was Catherine Hughes allowed to deal with my uncle's chattels so that the balance of the funeral account and mourning expenses could be paid.

15. The letter at Exhibit AC1 was dated 27 July 2007. It stated as follows:

Re: Ian Adam deceased: 15 Ovington Street

I thought you would just like to know that we sought a barrister's advice on Mr. Adam's tenancy of 15 Ovington Street although the research which I undertook seemed to indicate that there was a statutory tenancy of the property.

The barrister has confirmed that Mr. Adam was a statutory tenant and because a statutory tenancy is a personal right belonging to an individual to remain in a property there is nothing which can be transmitted to or passed onto Mr. Adam's beneficiaries.

I understand that under your authority Mrs. Hughes has either already or is in the course of dealing with Mr. Adam's chattels so that the business of the funeral account and the mourning expenses can be paid.

Eight days after the date of that letter, on 4 August 2007, the Applicant's trade mark attorneys filed the opposed application for registration in her name giving her address as 15 Ovington Street, London SW3.

16. The powers available to the Registrar under Rules 62 and 65 of the Trade Marks Rules 2008 include the power to require the attendance of witnesses for cross-examination on their witness statements and the power to require disclosure of relevant documents. However, neither side applied for the reliability of the other side's evidence to be tested in that way. That resulted in the contested allegation of bad faith being pursued without recourse to the most effective procedures available for its determination.

17. The hearing of the opposition took place on 29 October 2009 before Mr. George Salthouse acting on behalf of the Registrar of Trade Marks. The Opponents maintained their objection to registration under Section 3(6) on the basis put forward in their Statement of Grounds. In that connection they specifically contended that the Applicant's claim to be Ian Adam's next-of-kin and any claim she might thereby make to have inherited any of his business assets was false. This together with the Applicant's evidence in defence of her application to register the trade mark **IAN ADAM** raised the question

whether there was a business asset in the form of a surviving goodwill and reputation attaching to the name **IAN ADAM** which the Applicant was seeking to exclude from his estate for her own benefit.

18. That question was not examined in any real depth before the Hearing Officer. The argument before him centred on the applicability or otherwise of the following guidance in the Work Manual published by the Trade Marks Registry:

Section 3(6) - Bad Faith

Where third parties apply to register the name of a famous individual or a recently deceased famous individual an objection under section 3(6) of the Act may be appropriate. However, this will depend upon whether the application covers goods and/or services with which the famous individual is associated. For example, an application to register the name of a famous fashion model for “clothing” or “cosmetics” would be liable to an objection because it is an obvious attempt to take unfair advantage of the person’s reputation.

The opposed application to register the name **IAN ADAM** was alleged to have been part of an obvious attempt to take unfair advantage of the fame and reputation of a recently deceased person.

19. The opposition was rejected for the reasons given by the Hearing Officer in a written decision issued under reference BL O-006-10 on 14 January 2010. He ordered the Opponents to pay £3,600 to the Applicant as a contribution to her costs of the registry proceedings.

20. He refused to accept that there was anything inappropriate in the Applicant's conduct with regard to Ian Adam's estate:

43) I do not understand the accusations that the applicant has falsely claimed to have been next of kin, inherited business assets and by living at the property previously occupied by Mr. Adam was trying to obtain a connection with Mr. Adam. Firstly, in her statement the applicant merely stated that she was named as Mr. Adam's next of kin when he went into hospital and this was backed up by documentation. This, in my opinion, was put forward to make the case that she was a close confidant of Mr. Adam, as one does not choose a mere acquaintance as your nominated next of kin when going into hospital. As to the issue of inhering business assets and living at the address once occupied by Mr. Adam, this has to be viewed in context. By the opponents own evidence, Ms. Hughes was asked to sort out the affairs of Mr. Adam, despite the fact that he lived in London and she lived in Scotland. Inevitably, the premises which Mr. Adam occupied at the time of his death contained numerous possessions although the property was in fact rented. Ms. Hughes would have required somewhere to live in London whilst sorting the affairs of Mr. Adam. In renting the same premises it solved the issue of storage of goods whilst they were disposed of, and allowed her to continue to earn her living as a voice coach as the premises had a studio which she had worked in for decades, and which was familiar to the clients who would have previously been used to her teaching during the occasions when she had covered for Mr. Adam. In passing I note that the opponents do not dispute that Ms. Hughes also contributed to the funeral expenses as well as assisting in its planning.

21. He dismissed the argument that the Applicant was attempting to take unfair advantage of Ian Adam's fame and reputation on the following basis:

45) It was contended that Mr. Adam was "famous" and so his name should be protected as set out in paragraphs 39 and 40 above. Whilst I accept that Mr. Adam had a reputation as

a voice coach, I would hesitate to state that he would be regarded as being famous. However, even if I am incorrect in this the instant case does not infringe the principles set out in those paragraphs. This is not an instance of someone unknown to the person who has just died seeking to cash in on their name, such as was seen when Princess Diana, Elvis Presley or Michael Jackson died. In the instant case the application was filed by a person who had frequently stood in for Mr. Adam, teaching his pupils on his behalf and indeed recruiting new pupils who were then passed over to Mr. Adam on his return. This business relationship lasted for over thirty years. This is not an instance of an opportunist seeking to cash in on the demise of someone they did not know or had never even met, this was someone who was regarded by the consumers as being a business partner, albeit not in the strict legal sense, and close confidant of Mr. Adam.

22. Annette Campbell did not appeal. Bente Zaber appealed to an Appointed Person under Section 76 of the Trade Marks Act 1994 contending in substance: (1) that the Hearing Officer had not adequately grappled with the issues relating to entitlement and succession raised by the Applicant's witness statement and the Opponent's evidence in reply; and (2) that the Hearing Officer ought to have determined on the evidence before him that the opposed application for registration plainly involved an attempt to take unfair advantage of the late Ian Adam's fame and reputation contrary to Section 3(6) of the Act.

23. The parties' loose use of the expression 'next-of-kin' prompted me to seek clarification under Rules 62(1)(a) and 73(4) of the 2008 Rules as to the actual position with regard to kinship and succession. I understand that Ian Adam's parents predeceased him, that he never married and that he had no children of his own. His only sibling was a brother who predeceased him. His deceased brother had five children, all of whom were living at the date of Ian Adam's death. They were Annette Campbell and her four

brothers. I was told that Annette Campbell had not been in contact with any of her brothers for some time. *'She does not know where they currently are. She says that Ian Adam also was not in contact with any of her brothers'*.

24. I was informed that no will has been found and that the parties were proceeding upon the basis that Ian Adam died intestate. I was told that *'Letters of administration were not taken out because it was agreed that there was nothing to administer i.e. no assets, money or anything else of any value and the estate of Ian Adam was in fact in debt with monies owing to the Inland Revenue and accountants'*.

25. The evidence on file indicates that Ian Adam was not only resident but also domiciled in England and Wales at the date of his death. According to Section 9 of the Administration of Estates Act 1925 (as amended) his real and personal estate in England and Wales will have vested in the Public Trustee until the grant of administration, though not so as to confer upon the Public Trustee any beneficial interest in, or impose on him any duty, obligation or liability in respect of the property. It seems that his residuary estate (if any) will have belonged to the Crown as bona vacantia in accordance with the default provisions of Section 46(1)(vi) for lack of anyone with a better entitlement under the antecedent provisions of Section 46. Section 46(1)(vi) expressly empowers the Crown in such situations to *'provide, in accordance with the existing practice, for dependents, whether kindred or not, of the intestate, and other persons for whom the intestate might reasonably have been expected to make provision'*. There has, so far as I am aware, been no attempt by any of the parties to the present proceedings to seek benefit from the Crown in the exercise of that power.

26. In the circumstances I think it must be concluded, for the purposes of the present proceedings, that nobody on either side of the case has ever been entitled to any legal or beneficial interest in any assets of Ian Adam's estate under the 1925 Act. I can see no basis on which the Applicant might validly have obtained authorisation from Annette Campbell to administer the estate. In addition I must make it clear that I regard the Applicant's claim to have been appointed by Ian Adam as his 'next-of-kin' as contrived for the purpose of providing her with an excuse for acting as she did in relation to his assets after he had died. The net effect of the evidence is that the Applicant exercised rights of disposition and control over assets comprised in the estate in the course of acting as administrator without valid authorisation.

27. Her actions in that regard brought her within the scope of the principle stated in Williams, Mortimer and Sunnucks on Executors, Administrators and Probate (2008) at paragraphs 8-19 (with footnotes omitted):

Executor *de son tort* - intermeddling

A person not lawfully appointed executor or administrator and without title to a grant may by reason of his own intrusion upon the affairs of the deceased be treated for some purposes as having assumed the executorship. Such an intermeddler is called a tort executor or an executor *de son tort* (i.e. of his own wrong). The concept is derived from the principle that a person who has assumed authority where he has none is accountable as if he had that authority.

The same term is used whether the deceased died testate or intestate, for the law knows no such appellation as "administrator *de son tort*". Depending upon the circumstances, such a person may also become a constructive trustee for those entitled to the assets and may also be liable to criminal sanctions. [...]

Although there is no duty on a person to take out a grant and become a personal representative, the fact that a person fails to take out a grant and instead intermeddles without a grant *may* be a reason why such person is not merely an executor *de son tort* but is also a constructive trustee.

28. The solicitors' letter of 27 July 2007 at Exhibit AC1 (see paragraph 15 above) identified Ian Adam's right to occupy 15 Ovington Street as a statutory right incapable of forming part of his estate. Nothing in the evidence on file contradicts that assessment. Moreover, there is no evidence that the Applicant acquired the right to occupy 15 Ovington Street by virtue of any dealing or transaction after the date of Ian Adam's death for which she could be made liable to account as executor *de son tort* cf. paragraph 49-07 of Williams, Mortimer and Sunnucks (above). The taking of advice from a barrister (as noted in the letter of 27 July 2007) suggests to my mind that the Applicant wished to ensure that she acted correctly in that regard. In the circumstances I think it must be concluded, for the purposes of the present proceedings, that the Applicant did not acquire the right to occupy 15 Ovington Street as executor *de son tort* in the administration of Ian Adam's estate.

29. I consider that the position is different in relation to the goodwill of the business she refers to as the **IAN ADAM SONG STUDIO**. That, in accordance with her evidence, was a business with a goodwill built up and acquired since at least the early 1990's which survived so as to be capable of ongoing commercial exploitation after Ian Adam's death on 10 May 2007. By carrying on that business she acted as executor *de son tort* in relation to so much of the goodwill and assets of it as formed part of his estate: Hooper v.

Summersett (1810) Wight. 16; Williams, Mortimer and Sunnucks (above) at paragraph 8-20. I state the proposition in that way because the Applicant seems to suggest in her evidence that the business might not have been 100% owned by Ian Adam at the date of his death. However, I can see no proper basis in the evidence for a finding to the effect that Ian Adam was entitled only to a proportionate part of the business in question. And even if that was the case, the Applicant would still be answerable for her dealings as executor de son tort in relation to the proportionate part of the business comprised in his estate: Williams, Mortimer and Sunnucks (above) at paragraph 49-05.

30. When the opposed application for registration is considered in the context of the facts and matters I have referred to above, it clearly appears to have been filed by the Applicant as a way of securing the goodwill of what she refers to as the **IAN ADAM SONG STUDIO** for herself as sole successor in business. The selling power of Ian Adam's name was a key component of the goodwill of that business. I am prepared to accept that the present application for registration of his name as a trade mark in Class 41 was an item of property for which the Applicant could have been required to account in properly constituted proceedings for the administration of his estate. That would have been upon the basis that she had acted without full regard for the due administration of the estate she was purporting to administer. It nonetheless remains to be determined whether her conduct in that connection, in particular with regard to the filing of the trade mark application, was affected by bad faith so as to be objectionable under the trade marks legislation. There is, in my view, no wooden rule to the effect that any application to register the name of a deceased celebrity must always or necessarily be objectionable

on the ground of bad faith. The issues raised by that objection are fact sensitive and case specific.

31. The basic proposition is that the right to apply for registration of a trade mark cannot validly be exercised in bad faith. The invalidity of the application is not conditional upon the trade mark itself being either registrable or unregistrable in relation to any goods or services of the kind specified. The objection is absolute in the sense that it is intended to prevent abusive use of the system for acquiring title to a trade mark by registration. Any natural or legal person with the capacity to sue and be sued may pursue an objection on this ground: see the Judgment of the Court of Justice in Case C-408/08P Lancôme parfums et beauté & Cie SNC v. OHIM [2010] ECR I-00000 at paragraph [39] and the Opinion of Advocate General Ruiz-Jarabo Colomer at paragraphs [63] and [64]. Since there is no requirement for the objector to be personally aggrieved by the filing of the application in question, it is possible for an objection to be upheld upon the basis of improper behaviour by the applicant towards persons who are not parties to the proceedings provided that their position is established with enough clarity to show that the objection is well-founded.

32. Any attempt to establish bad faith must allow for the fact that there is nothing intrinsically wrong in a person exercising *'the right to apply the rules of substantive and procedural law in the way that is most to his advantage without laying himself open to an accusation of abuse of rights'* as noted in paragraph [121] of the Opinion delivered by Advocate General Trstenjak in Case C-482/09 Budejovicky Budvar NP v. Anheuser-Busch Inc on 3 February 2011. In paragraph [189] of his judgment at first instance in

Hotel Cipriani SRL v. Cipriani (Grosvenor Street) Ltd [2009] EWHC 3032 (Ch); [2009]

RPC 9 Arnold J. likewise emphasised:

... 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. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Art. 107 can hardly be said to be abusing the Community trade mark system.

These observations were not called into question in the judgment of the Court of Appeal in that case: [2010] EWCA Civ 110; [2010] RPC 16. They were re-affirmed by Arnold J. in Och-Ziff Management Europe Ltd v. Och Capital LLP [2011] ETMR 1 at paragraph [37].

33. The line which separates legitimate self-interest from bad faith can only be crossed if the applicant has sought to acquire rights of control over the use of the sign graphically represented in his application for registration in an improper manner or for an improper purpose. The appropriate remedy will in that case be rejection of the offending

application for registration to the extent necessary to render it ineffective for the purpose which made it objectionable in the first place.

34. In a case where the relevant application fulfils the requirements for obtaining a filing date, the key questions are: (1) what, in concrete terms, is the objective that the applicant has been accused of pursuing? (2) is that an objective for the purposes of which the application could not properly be filed? (3) is it established that the application was filed in pursuit of that objective? The first question serves to ensure procedural fairness and clarity of analysis. The second question requires the decision taker to apply a moral standard which, in the absence of any direct ruling on the point from the Court of Justice, is taken to condemn 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'*: Gromax Plasticulture Ltd v. Don & Low Nonwovens Ltd [1999] RPC 367 at 379 (Lindsay J). The third question requires the decision taker to give effect to the principle that innocence must be presumed in the absence of evidence sufficient to show that the applicant has acted improperly as alleged.

35. In assessing the evidence, the decision taker is entitled to draw inferences from proven facts provided that he or she does so rationally and without allowing the assessment to degenerate into an exercise in speculation. The Court of Justice has confirmed that there must be an overall assessment which takes into account all factors relevant to the particular case: Case C-529/07 Chocoladefabriken Lindt & Sprüngli AG v. Franz Hauswirth GmbH [2009] ECR I-4893 at paragraph [37]; Case C-569/08 Internetportal und Marketing GmbH v. Richard Schlicht [2010] ECR I-00000 at

paragraph [42]. As part of that assessment it is necessary as part of that approach to consider the intention of the applicant at the time when the application was filed, with intention being regarded as a subjective factor to be determined by reference to the objective circumstances of the particular case: Chocoladefabriken Lindt & Sprüngli GmbH (above) at paragraphs [41], [42]; Internetportal and Marketing GmbH (above) at paragraph [45]. This accords with the well-established principle that ‘national courts may, case by case, take account - on the basis of objective evidence - of abuse or fraudulent conduct on the part of the persons concerned in order, where appropriate, to deny them the benefit of the provisions of Community law on which they seek to rely’: Case C-16/05 The Queen (on the applications of Veli Tum and Mehmet Dari) v. Secretary of State for the Home Department [2007] ECR I-7415 at paragraph [64].

36. The concept of assessing subjective intention objectively has recently been examined by the Court of Appeal in the context of civil proceedings where the defendant was alleged to have acted dishonestly: Starglade Properties Ltd v. Roland Nash [2010] EWCA Civ 1314 (19 November 2010). The Court considered the law as stated in Royal Brunei Airlines v. Tan [1995] 2 AC 378 (PC), Twinsectra Ltd v Yardley [2002] 2 AC 164 (HL), Barlow Clowes International Ltd v. Eurotrust International Ltd [2006] 1 WLR 1476 (PC) and Abu Rahman v. Abacha [2007] 1 LL Rep 115 (CA). These cases were taken to have decided that there is a single standard of honesty, objectively determined by the court and applied to the specific conduct of a specific individual possessing the knowledge and qualities that he or she actually possessed: see paragraphs [25], [28], [29] and [32]. This appears to me to accord with treating intention as a subjective factor to be

determined by reference to the objective circumstances of the particular case, as envisaged by the judgments of the Court of Justice relating to the assessment of objections to registration on the ground of bad faith.

37. In so far as the opposition in the present case was based upon the allegation that there was a business asset in the form of a surviving goodwill and reputation attaching to the name **IAN ADAM** which the Applicant was seeking to exclude from his estate for her own benefit, it accused the Applicant of pursuing an objective for the purposes of which, in my view, the application could not properly be filed. The accusation was imprecisely expressed in the Grounds of Opposition. I am nonetheless satisfied on reading the Applicant's witness statement of 19 March 2009 that she fully understood that she was being accused of having '*no rightful proprietorial claim ... to take advantage of the reputation of Ian Adam*' by registering his name as her trade mark following his death in May 2007. That led her to raise the case on entitlement she put forward in her witness statement, including the claim (which I have dismissed as contrived) to have been appointed by Ian Adam as his 'next-of-kin'.

38. The Applicant's witness statement is completely silent with regard to her involvement in the administration of Ian Adam's estate. Her stance appears to have been that her involvement in the administration of the estate was a matter of no consequence in relation to the filing of the opposed application for registration. She did not claim to have been acting with the authorisation or consent of anyone having any right, title or interest with respect to the administration of the estate either when she took control of the business she referred to as the **IAN ADAM SONG STUDIO** or when she applied to

register **IAN ADAM** as her trade mark for related services in Class 41. Her case was that she had a legitimate interest in doing what she did for her own benefit and on her own account.

39. My reasons for rejecting her case on entitlement are given in paragraphs 23 to 29 above. That brings me to the question of intention, which I must consider in accordance with the case law noted above. When the Applicant filed the application for registration, was she seeking for her own benefit to exclude the surviving goodwill and reputation attaching to the name **IAN ADAM** from the estate she was purporting to administer? It is unsatisfactory, to say the least of it, that this issue was fought to a conclusion without disclosure of relevant documents or cross-examination. However, that did not relieve the Hearing Officer (and does not relieve me) of the need to address it within the constraints imposed by the parties' decision to proceed on the basis of written evidence alone: see CLUB SAIL Trade Marks [2010] RPC 32 at paras. [33] to [41].

40. On the evidence as it stands, I have decided that Ian Adam's right to occupy the house at 15 Ovington Street should be regarded as a statutory right incapable of forming part of his estate and that the Applicant should not be taken to have acquired the right to occupy the house as executor de son tort. I also infer that the Applicant took legal advice with a view to ensuring that she acted correctly in that regard. Did she believe, with or without the benefit of advice, that the goodwill of the business she refers to as the **IAN ADAM SONG STUDIO** came with the premises so as to be available for exploitation by her as an adjunct to her right of occupation? She does not say so. And it is not permissible for me to guess what her position might or might not have been in that connection. I

therefore do not propose to consider whether the existence of such a belief (albeit mistaken) on the part of the Applicant might have precluded a finding of bad faith.

41. It was rightly accepted at the hearing before me that the Applicant would have had no answer to objections under Section 3(6) of the Act (on the basis of bad faith) and Section 5(4)(a) of the Act (on the basis of anticipated passing off) if her application to register the trade mark **IAN ADAM** had been filed during Ian Adam's lifetime without his consent. I was offered no clear explanation or analysis as to how or why it was nevertheless said to be acceptable for the application to be filed by the Applicant acting unilaterally and for her own benefit less than three months after the date of his death. I understand the supposition to be that the Applicant needed no consent, because there was no surviving goodwill and reputation attaching to the name **IAN ADAM** belonging to anyone other than herself. However, her witness statement does not say that her decision to file the opposed application for registration was made upon that supposition. In other words, the supposition upon which she appears to rely is not shown to have been a supposition upon which she actually relied.

42. The Applicant was undoubtedly aware of the way in which the business she refers to as the **IAN ADAM SONG STUDIO** had been carried on by Ian Adam during his lifetime. Her involvement in the administration of his estate could only have added to her understanding of the commercial viability of the business he left behind. He was the founder of that business. She clearly decided to step into his shoes so far as she could by continuing to operate the business at the address in Ovington Street where it had previously been carried on. Equally clearly she decided to register **IAN ADAM** as her

trade mark in Class 41 for the purpose of preventing others from exploiting the goodwill and reputation attaching to his name in relation to services of the kind specified in the opposed application for registration. She had knowledge of the facts and matters which made it necessary for the business and the associated goodwill and reputation attaching to his name in relation to such services to be treated as assets of the estate. There is no evidence testifying to any inability or failure on her part to understand the existence and effect of that necessity. On the evidence as it stands, I think it is more probable than not that she realised the business and associated goodwill and reputation were assets of his estate. Hence the absence of any express averments to the contrary in her witness statement.

43. On treating her intention as a subjective factor to be determined by reference to the objective circumstances of the present case, I consider that the Applicant was for her own benefit seeking to exclude the surviving goodwill and reputation attaching to the name **IAN ADAM** from the estate she was purporting to administer when she filed the opposed application for registration. I therefore consider that the application for registration was made for an improper purpose which rendered it objectionable on the ground of bad faith under Section 3(6) of the 1994 Act. In order to render the application ineffective for the purpose which made it objectionable in the first place, it should in my view be rejected for all of the services specified other than sporting activities. I have no reason to believe that use of the trade mark **IAN ADAM** in relation to sporting activities would capitalise on the goodwill and reputation belonging to the estate.

44. For the reasons given above, the appeal under Section 3(6) is for the most part allowed and the Hearing Officer's decision under that section is set aside in relation to all of the services specified in the opposed application for registration other than sporting activities. The Hearing Officer's decision under Section 3(3)(b) remains undisturbed. However, his order for costs will be set aside so that the parties may have an opportunity to make representations in relation to the question of how and by whom the costs of the proceedings at first instance and on appeal are to be borne and paid in the light of my decision in relation to the objection under Section 3(6). The following directions are given with a view to the determination of that question:

- (1) the Opponents are directed to send me written representations in support of any claim for costs in respect of the proceedings in the Registry and on appeal, this to be done by 6.00pm on 21 March 2011;
- (2) the Applicant is directed to send me any written representations she wishes to make in response to those of the Opponents under paragraph (1) above, this to be done by 6.00pm on 1 April 2011;
- (3) the Opponents are directed to send me any written representations they wish to make in reply to those of the Applicant under paragraph (2) above, this to be done by 6.00pm on 8 April 2011.
- (4) any written representations sent to me under paragraphs (1) to (3) above must at the same time be copied to the opposite party and to the Treasury Solicitor's Department (Reference R 100629A/SOT/4E).

If neither side informs me in writing by 6.00pm on 15 April 2011 that they wish to be heard in relation to the claim for costs that remains to be determined I shall proceed to issue a supplementary decision dealing with that claim, taking account of the written representations I have received.

Geoffrey Hobbs Q.C.

7 March 2011

Andrew Marsden of Saunders & Dolleymore LLP appeared on behalf of the Applicant.

Kate Széll of Venner Shipley LLP appeared on behalf of the named Opponent.

The Registrar was not represented.