

O/412/21

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003333426

IN THE NAME OF WAYNE BARRETT-MCGRATH

FOR THE FOLLOWING TRADE MARK:

Slaughter and the Dogs

IN CLASS 9

AND IN THE MATTER OF AN APPLICATION FOR A DECLARATION OF
INVALIDITY THERETO UNDER NO. 503042

BY MICK ROSSI

BACKGROUND AND PLEADINGS

1. Wayne Barrett-McGrath (“the proprietor”) is the registered proprietor of UK trade mark no. 3333426 for the mark **Slaughter and the Dogs** (“the Contested Mark”). The Contested Mark was filed on 22 August 2018 and registered on 16 November 2018. It stands registered for the following goods:

Class 9 Musical cassettes; Musical recordings; Musical recordings in the form of discs; Musical sound recordings; Musical video recordings.

2. On 28 February 2020, Mick Rossi (“the applicant”) applied to invalidate the Contested Mark under section 47 of the Trade Marks Act 1994 (“the Act”). The applicant relies upon section 3(6) of the Act. The applicant claims:

- a) The proprietor and the applicant were both members of a band called Slaughter and the Dogs;
- b) In June 2019, the proprietor publicly fired the other members of the band;
- c) The proprietor “made a willfully false statement to the Commissioner for Trademarks, that is, Barret McGrath falsely stated that he was the “Owner” of the Mark. This statement was willfully false because Barrett McGrath identified himself as the Sole Owner of the Mark, which was not true or correct; He was not the exclusive owner of the Mark. At most, and at the time of application, he was co-owner of the Mark.”
- d) The proprietor had no right to register the Mark as sole owner, as he had not used it since June 2019 in connection with live performances, whereas the applicant had continued to use the mark;
- e) The proprietor has used his registration of the Contested Mark to prevent the applicant from trading under it.

3. The proprietor filed a counterstatement denying the claims made and asserting a) that he is the creator and owner of the Contested Mark, b) that the applicant impliedly or expressly consented to the registration prior to the filing date in order to handle a dispute with third parties and c) that the public associate the trade mark with the proprietor and not the applicant.

4. Both parties filed evidence in chief. The applicant filed evidence in reply. A hearing took place before me on 6 May 2021, by video conference. The proprietor represented himself throughout these proceedings and was represented by his wife, Erin Custer-McGrath, at the hearing; the applicant has been represented throughout these proceedings by the band manager, Maurice Murray, but elected not to attend the hearing. The applicant did, however, file written submissions in lieu of attendance.

EVIDENCE AND SUBMISSIONS

5. The applicant filed four witness statements as evidence in chief dated 5 October 2020, accompanied by 35 exhibits in total.

6. The proprietor filed a witness statement as evidence in chief dated 5 January 2021, accompanied by 11 exhibits. The proprietor's evidence in chief also consists of the witness statements of John Pierre Thollet and Erin Custer-McGrath dated 24 November 2020 and 22 November 2020 respectively.

7. The applicant filed a fifth witness statement as evidence in reply dated 24 February 2021, accompanied by 13 exhibits. The applicant's evidence in reply also consists of the witness statements of:

- a) Mark Reback dated 20 January 2021. Mr Reback was the drummer in the band between 2015 and 2019.
- b) Dan Graziano dated 20 January 2021. Mr Graziano was the bassist in the band between 2015 and 2019.

- c) Ray Rossi dated 19 February 2021. Mr Rossi was the manager of the band between 1976 and 1980 and is the older brother of the applicant.
- d) Howard Bates dated 28 January 2021. Mr Bates was the original bass player for the band from late 1975 to 1980.
- e) Philip Rowland dated 21 January 2021. Mr Rowland was the drummer for the band between 1979 and 1980.
- f) Phil Smith dated 25 January 2021. Mr Smith is a Theatre Director/General Manager based in the North East of England.
- g) Anthony James Davidson dated 19 February 2021. Mr Davidson founded TJM Records, an independent record label located in Manchester and the band used his recording studios.
- h) Bryan Swirsky dated 22 February 2021. Mr Swirsky has been a booking agent for over 30 years.
- i) Maurice Murray dated 29 January 2021. Mr Murray worked with the band between 2001 and 2015, but had been known the band since 1976.
- j) Jennie Russell-Smith dated 25 January 2021. Ms Russell-Smith operated a festival in the UK in 1996.

8. I note that the applicant also filed written submissions in lieu of attendance. However, large parts of this document appear to be further evidence (or, rather, a repeat of the evidence already given by the applicant). For the avoidance of doubt, I have not taken any new evidence contained within that document into account in reaching my decision.

9. Whilst I do not propose to summarise the evidence here, I have taken it into consideration and will refer to it below to the extent that I consider necessary.

PRELIMINARY ISSUES

The proprietor's representation

10. Throughout these proceedings, Ms Custer-McGrath (the proprietor's wife) has engaged in correspondence with this Tribunal. She also attended the hearing on his behalf. However, prior to the hearing no TM33 has been filed to record Ms Custer-McGrath as the proprietor's representative.

11. At the hearing, I asked the proprietor to confirm that he was content for Ms Custer-McGrath to speak on his behalf. He confirmed that he was. I also invited Ms Custer-McGrath to file a TM33 after the hearing. She duly did so. Consequently, I will proceed on the basis that the submissions made by Ms Custer-McGrath represent the proprietor's position.

Application to file further evidence

12. Prior to the hearing, the proprietor sought to file further evidence, specifically, a DVD, a 'declaration' from Rexford Brabson and a witness statement of Florian Schueck. The DVD was another version of the recording filed as WMB3; the proprietor sought to file this to counter claims that the original exhibit had been tampered with. However, as the purpose of the original exhibit was aimed at identifying who came up with the band name (and for the reasons set out below I do not consider that to be relevant) the Tribunal's preliminary view was that this request to file further evidence should be refused. Consequently, the Tribunal wrote to the parties as follows by email on 28 April 2020:

"With regard to the DVD, it is the Hearing Officer's understanding that this relates to the question of who created the name of the band. The question of who came up with the name is not relevant to the bad faith pleading and, consequently, we do not consider the additional evidence to be necessary. This is a preliminary view. All preliminary views given by the Tribunal can be challenged. This means that if you disagree with the preliminary view given, you have the right to be heard on the matter. Consequently, if you disagree with

the preliminary view given, please inform us within the next 7 days i.e. on or before 5 May 2021, and it will be dealt with as a preliminary point at the hearing. [...]"

13. By email on the same date, the proprietor accepted the preliminary view.

14. With regard to the 'declaration' and witness statement, the Tribunal wrote to the parties as follows on 4 May 2021:

"It is the Registry's preliminary view that the application to file additional evidence (statement of Florian Schueck and declaration of Rexford Brabson) be refused. The reason for this is that 1) the statement of Mr Schueck appears to relate entirely to events that took place after the relevant date and does not appear to cast light back upon the position at that time and 2) the declaration of Mr Brabson appears to refer entirely to a dispute between the parties in another jurisdiction which appears to have no bearing on the matters before this Tribunal.

If either party disagrees with the preliminary view, they should inform the Tribunal in writing in advance of the hearing. If a challenge to the preliminary view is received, it will be dealt with as a preliminary point at the hearing."

15. On the same date, the proprietor disputed the preliminary view and, consequently, it was dealt with as a preliminary point at the hearing.

16. At the hearing, Ms Custer-McGrath explained that the proprietor wanted to rely upon the statement of Mr Brabson as it related to the state of the dispute between the parties in the US. Ms Custer-McGrath wanted to dispute the allegation, made by Mr Rossi, that the bad faith claim had been successful in the US. Mr Brabson is an Attorney in the US who is acting for the proprietor in those proceedings. His declaration explains what has happened in the dispute in that jurisdiction since he was instructed (in April 2020). With regard to the statement of Mr Schueck, Ms Custer-McGrath explained that the statement was filed to dispute the claim that the proprietor had not used its mark. Mr Schueck is the Director of a record company who has been working

with the proprietor. He states that he was involved in releasing a vinyl record for the band in summer 2019 and explains the activities that he has been involved in with the proprietor since then. I declined to admit the further evidence and gave brief reasons at the hearing. I set out my full reasons below:

- a) Mr Brabson's evidence is given in the incorrect format. It is neither a witness statement, affidavit or statutory declaration (or any other form allowed by the Civil Procedure Rules).
- b) The explanation as to why both of these documents were not filed during the evidence rounds is, largely, due to the impacts of the individuals having suffered from Covid-19 meaning they were unable, at the time, to provide the evidence. However, whilst that might explain some delay, it does not explain why it was only in the week before the hearing that these documents were filed.
- c) Crucially, I do not consider either document to be relevant to the issues in this case. Mr Brabson's statement relates entirely to the dispute between the parties in the United States. That is a separate jurisdiction and any decision made in that dispute will not be binding upon this Tribunal. Consequently, I do not consider that information regarding that dispute assists either party. Mr Schueck's evidence relates entirely to the activities of the proprietor from summer 2019 onwards. Given the relevant date in this case, and the fact that there is nothing to suggest that those activities cast light backwards upon the position at the relevant date, I do not consider that evidence assists the proprietor.

17. I note that following the hearing, Ms Custer-McGrath filed a further request to file additional evidence. She stated:

“[The proprietor] has discovered after much research an email from Mr Rossi sent from [the applicant's wife's] email account, stating that Mr Barrett-McGrath is the founder of the band and he filed the trademark in 1976 and this email is from 2012. I would like this placed on record.”

18. Accompanying Ms Custer-McGrath's email was a forwarded email from an individual who the proprietor states is the applicant's wife. The email states: "clarify that YOU legally own the name of SATD and have done since 1976 when you legally registered it". The email is signed off by someone called "Mick" and Ms Custer McGrath states that it was sent by the applicant. This further evidence was not provided in the appropriate format (it was not exhibited to a witness statement, statutory declaration or affidavit or accompanied by a statement of truth). Further, even if it was sent by the applicant, no context has been provided as to what the circumstances of this email being sent were and what registration it refers to (or what jurisdiction). Ms Custer-McGrath states that this was not provided sooner because the computer upon which it was stored crashed and had to be repaired and it took time for the proprietor to search his hard drives to locate it. No information is provided as to when this computer was damaged or, indeed, when it was repaired. Parties to proceedings are responsible for ensuring that all evidence they wish to rely upon is located and filed at the appropriate time. It is not acceptable for parties to wait until after the hearing to file evidence, nor to approach the filing of evidence in a piecemeal fashion. It would be unfair to the applicant to allow evidence to be admitted at this late stage. For these reasons, I declined to admit the evidence.

Allegations

19. Various emails have been exchanged between the parties both before and after the hearing regarding allegations of defamatory comments and/or threats made between the parties or their witnesses. These are not matters upon which I intend to comment and they will not factor into my decision.

Without prejudice information

20. Various comments have been made by both parties about attempts to settle this dispute or related disputes in other jurisdictions. For the avoidance of doubt, I have disregarded these comments and have not taken them into consideration in reaching my decision.

DECISION

21. 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.”

22. Section 3(6) has application in invalidation proceedings by virtue of section 47 of the Act, which states:

“47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

23. The relevant case-law covering trade mark applications made in bad faith can be found in the following cases: *Chocoladefabriken Lindt & Sprüngli*, CJEU, Case C-529/07, *Malaysia Dairy Industries*, CJEU, Case C-320/12, *Koton*, CJEU, Case C-104/18P, *Sky v Skykick*, CJEU, Case C-371/18, *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16), *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch), *Copernicus-Trademarks v EUIPO*, General Court of the EU, Case T-82/14, *Daawat Trade Mark, The Appointed Person*, [2003] RPC 11, *Saxon Trade Mark*, [2003] EWHC 295 (Ch), *Mouldpro ApS v EUIPO*, General Court of the EU, Case T-796/17, *Alexander Trade Mark, The Appointed Person*, BL O/036/18, *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) and *Sky v Skykick* [2020] EWHC, 990 (Ch).

24. The law appears to be as follows:

- (a) While in everyday language the concept of ‘bad faith’ involves a dishonest state of mind or intention, the concept of bad faith in trade mark law must be understood in the context of trade: *Sky* CJEU.

- (b) Applying to register a trade mark without an intention to use it is not bad faith *per se*. Therefore, it is not necessary for the trade mark applicant to be using, or have plans to use, the mark in relation to all the goods/services covered by the specification: *Sky CJEU*.
- (c) The bad faith of the trade mark applicant cannot, therefore, be presumed on the basis of the mere finding that, at the time of filing his or her application, that applicant had no economic activity corresponding to the goods and services referred to in that application: *Sky CJEU*.
- (d) However, where the trade mark application is filed without an intention to use it in relation to the specified goods and services, and there is no rationale for the application under trade mark law, it may constitute bad faith. Such bad faith may be established where there are objective, relevant and consistent indications showing that the applicant had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark: *Sky CJEU*.
- (e) This may be the case where the exclusive right was sought as part of a strategy of using widely cast trade mark registrations as legal weapons for use against others in opposition proceedings and/or for the purposes of blocking applications by third parties: *Sky EWHC* and *Copernicus-Trademarks v EUIPO*.
- (f) A trade mark may be applied for in good faith in relation to some of the goods/services covered by the application, and in bad faith as regards others: *Sky CJEU*.
- (g) This may be the case where the trade mark applicant has included a specific term in the specification, such as 'computer games', with no intention of using the mark in relation to any such goods, simply to obstruct third parties from using or registering the same mark, or similar marks. It may also be the case where the applicant has included a broad term, such as 'computer software',

with the intention of using the mark in relation to a particular sub-category of such goods/services, but no intention of using the mark in relation to all the other (sometimes very different) sub-categories of goods/services covered by the broad term, with the objective of obstructing third parties from using or registering the mark in relation to such goods/services: *Sky EWHC*.

- (h) In deciding whether there was a rationale for registering the trade mark in relation to any particular term, it is necessary to bear in mind that trade mark proprietors have a legitimate interest in seeking protection in respect of goods or services in relation to which they may wish to use the trade mark in future (even if were no plans to use the mark in relation to the goods/services at issue at the time of filing the application): *Sky EWHC*. It is therefore relevant to consider whether the goods/services in the contested application are related to those for which the mark has been used, or for which the applicant had plans to use the mark.

25. The following points are apparent from the pre-*Sky* case-law about registering trade marks in bad faith:

- (a) Although it may be a relevant factor, the mere fact that the trade mark applicant knew that another party was using the trade mark in another territory does not establish bad faith: *Malaysia Dairy Industries*.
- (b) Similarly, the mere fact that the trade mark applicant knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton* (paragraph 55). The trade mark applicant may have reasonably believed that it was entitled to apply to register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani*.
- (c) However, an application to register a mark is likely to have been filed in bad faith where the trade mark applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat*, or to

gain an unfair advantage by exploiting the reputation of a well-known name:
Trump International Limited.

- (d) An application may also have been filed in bad faith where the trade mark applicant acted in breach of a general duty of trust as regards the interests of another party, including his or her own (ex) company or (ex) partners, or a party with whom there is, or had recently been, a contractual or pre-contractual relationship, such as a licensor, prospective licensor or overseas principal: *Saxon, Mouldpro*; or where a legal agreement prohibits such a filing.

26. The correct approach to the assessment of bad faith claims is as follows. According to *Alexander Trade Mark*, the key questions for determination in such a case are:

- (a) What, in concrete terms, was the objective that the trade mark applicant has been accused of pursuing?
- (b) Was that an objective for the purposes of which the contested application could not be properly filed? and
- (c) Was it established that the contested application was filed in pursuit of that objective?

27. The trade mark applicant's intention (i.e. objective) is a subjective factor which must be determined objectively by the competent authority. An overall assessment is required, which must take account of all the factual circumstances relevant to the particular case: *Lindt*.

28. The matter must be judged at the relevant date, which is the date of the application for registration: *Lindt*. In this case, the relevant date is 22 August 2018.

29. It is necessary to ascertain what the trade mark applicant knew at the relevant date: *Red Bull*. Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani*.

30. A statement on the application form that the mark is in use, or there is a *bona fide* intention to use it may, if untrue, provide evidence supporting a bad faith case, but is not sufficient by itself to justify the refusal or cancellation of the registration: *Sky CJEU*.

31. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull*.

Findings of Fact

32. I will begin by making findings of fact regarding the chronology of the band. I find that the chronology of the band is as follows:

1975 – the band was formed. Both parties agree that the band Slaughter and the Dogs was first started in 1975 and that they were both members. Mr Bates gives evidence that he was also a member of the band at this time.

1979 – the proprietor left the band. Both parties agree that the proprietor ceased to be involved in the band from this date onwards, although the proprietor claims that, at this point, he had ‘disbanded’ the band.

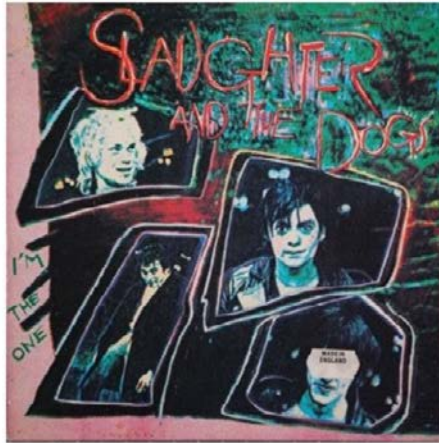
1979-1980 – I find that the band continued to perform after the proprietor’s departure until some time in 1980. At this time, the band consisted of the applicant, Eddie Garrity, Howard Bates and Phil Rowland. I note that there is some dispute about whether the album entitled ‘Slaughter’ was released under the Contested Mark.¹ However, I do not consider that anything turns on this point. This is because there is other evidence which proves continued use of the Contested Mark by the band after the proprietor’s departure, specifically:

a. Evidence of another single having been released in 1980.²

¹ Exhibits WMB4, WMB5, MR9 and MR10

² Exhibits MR11 and MR13

Slaughter & The Dogs - I'm The One



Original Release Date

1980

Release Information

UK 7" 1980 (DJM - DJS 10945)

- 1 I'm The One 2:35
- 2 What's Wrong Boy (Live) 2:34
- 3 Hell In New York 3:38

Chart Placings

None

Credits

Engineered by John Cooper

- b. Publicity shots that the applicant states show the new band formation which he states were taken in 1980:³



SLAUGHTER & THE DOGS



³ Exhibits MR14 and MR15



- c. Posters publicising live events which the applicant states took place on 10 and 17 May 1980: ⁴



- d. Mr Bates and Mr Rowland both give evidence that they continued to perform in the band until 1980 (after the proprietor had departed).

⁴ Exhibit MR18

- e. Mr Davidson gives evidence that, in May 1980, he promoted a gig for the band in Manchester under the Contested Mark; he states that this was after the proprietor had left the band and a new singer had joined.

1990/1993 – the band got back together. The parties disagree on whether this was 1990 or 1993, but nothing turns on the exact date. This band formation included both the proprietor and the applicant. At this time, the parties were joined by two new band members (Noel Kay and Nigel Mead) and, together, they recorded a new album – “Shocking” – after being approached by a British record label.

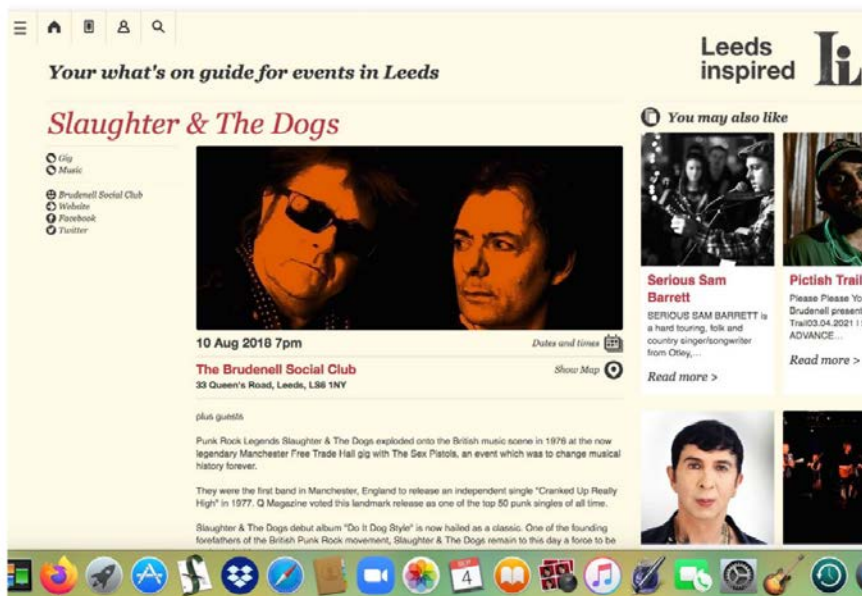
1996 onwards – It is not clear whether the parties continued to perform until 1996 continuously or whether there was a hiatus. However, what is clear, is that they performed at a music festival in the UK in 1996 (this is also confirmed by Mrs Russell-Smith’s evidence). It is not clear who the band members were at this time. The applicant states that, from this time onwards, he continued to perform in the band. On balance, this is supported by the evidence. Specifically:

- a. Mr Swirsky gives evidence that he was involved with the band (which, at that time, included both the applicant and the proprietor) in 2001 when he booked their first ever American tour. He states that the tour took place in 2002 and his work continued with the band until 2004.
- b. The applicant has provided an example of promotional material dated 10 October 2017 for an event that the parties attended together under the Contested Mark:⁵

⁵ Exhibit MR21



c. Publicity materials dated 10 August 2018 showing both parties have been provided:⁶



⁶ Exhibit MR23

d. Mr Reback and Mr Graziano give evidence that they were band members from 2015 to 2019.

June 2019 – the proprietor left the band again. The proprietor states that he “fired” the other band members.

Who owned the name?

33. Cases of this kind are very often brought under section 5(4)(a) of the Act. That is not the case here. However, the question of who owns the goodwill (and, consequently, the name) is still a relevant consideration. I will, therefore, now consider the question of ownership.

34. The proprietor believes that he owns the band name, because he claims to have come up with the idea. This is disputed by the applicant. However, I do not consider this point to be relevant for the purposes of the present proceedings as creation of a name *per se* provides no legal right to use it or to exclude others from using it.⁷

35. The proprietor claims to have “hired” the applicant as a rhythm guitarist when the band was formed. As Ms Custer-McGrath stated at the hearing, the proprietor claims that the applicant “was a contracted musician who ended up lasting 40 years in the band”. The applicant disputes this and claims that he was a co-founder.

36. In this regard, the proprietor has filed a document which he describes as the document signed by the applicant at the time he initially joined the band, although the document itself is undated.⁸ The document states:

“This is to the person who is joining WAYNE AND THE MIME TROUPE who is MICHAEL ROSSI playing rhythm guitar [illegible] is five year contract and the person who signs this is bound to the groupe [sic]

⁷ *Harrods Limited v Harrodian School Limited* [1996] RPC 697

⁸ Exhibit WMB2

By Wayne Barrett”

37. What appears to be the applicant’s signature appears beneath. The proprietor explains that WAYNE AND THE MIME TROUPE was “the first incarnation of Slaughter and the Dogs”. After this time, the name of the band was changed. The applicant denies signing this document, or that it is his signature that appears on it.

38. Whether or not this document was actually signed by the applicant, I do not consider it to be relevant. That is because, even if a contract did exist between the parties in relation to another band - “Wayne Barrett and the Mime Troupe” – that does not prove what the arrangement was in relation to Slaughter and the Dogs. There is no evidence before me at all as to what the arrangement was when the new band – Slaughter and the Dogs – was created.

39. In my view, the applicant’s claim that he was a co-founder of the band, rather than a hired musician, is supported by the following:

- a. A Facebook post filed by the applicant dated 2 June 2016. The post is one that has been published by the proprietor himself, and describes both parties as “official members & creators of Slaughter and The Dogs”.⁹ I note, in this regard, that the proprietor claims that he was “being playful” when making this post and that he “obviously used incorrect language”. However, if the applicant was only a hired musician, I see no reason why the proprietor would have referred to him as one of the “creators”.
- b. Letters filed by the proprietor himself which were sent by Ms Custer-McGrath on behalf of the band in 2017 refer to “Wayne Barrett and Mick Rossi, Slaughter and the Dogs” and confirms that they are the “copyrighted owners” of posters used by the band.¹⁰ Again, if the applicant was a hired musician, I see no reason for Ms Custer-McGrath to have referred to him in this way.

⁹ Exhibit MR1

¹⁰ Exhibit WMB11

- c. An email from the proprietor to the band management email address dated 25 August 2014 which contains a draft announcement relating to the retirement of one of the band members, stating:

“Wayne went on to say (When something ends, something always begins. Life is too short, Mick & Myself are committed as founders of the band we have fond memories with Noel & JP but the band goes on [...])”¹¹

Again, if the applicant was a hired musician, I see no reason for the proprietor to describe him as one of the “founders”.

- d. The proprietor gives narrative evidence that, when he fell out with other band members/band management, he demanded payment for his earned finances through the band. This suggests to me that this was not a set up by which the proprietor had hired other musicians (such as the applicant and other subsequent band members), accumulated finances through the band and paid them a set fee; rather this set up suggests that each band member was paid a royalty.

40. Although some of this evidence is dated more recently, it suggests to me that both parties viewed themselves as founding members of the band until this dispute arose. In the absence of any evidence to show that the band members were contracted by the proprietor (other than the evidence relating to a different band which I have dismissed for the reasons set out above), I consider that the band was a partnership at will. The effect of this is that the goodwill and the name were partnership assets.

41. As noted above, the members of the band have changed over time on at least five occasions (first, when the band was joined by Mr Rowland in 1979, second when the proprietor sought to disband the group by leaving in 1979, third when the band completely disbanded in or around 1980, fourth when they reformed in 1990/1993 and fifth when they were joined by Mr Reback and Mr Graziano in 2015). In *Saxon Trade*

¹¹ Exhibit MR42

Mark, Laddie J considered the ownership of goodwill (and, consequently, the name) generated by bands with changing membership.¹² He stated:

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

26 The position is no different if two bands contain common members. If, as here, they are partnerships at will which are dissolved when one or more partners leave, they are two separate legal entities. This is not affected by the fact that some, even a majority, of the partners in the first band become members of the second. A properly advised band could avoid the problem that this might cause by entering into a partnership agreement which expressly

¹² [2003] FSR 39

provides for the partnership to continue on the departure of one or more members and which expressly confirms the rights of the continuing and expressly limits the rights of departing partners to make use of the partnership name and goodwill. This is now commonplace in the partnership deed for solicitors' practices."

42. Consequently, each formation of the band under the Contested Mark would have acquired its own goodwill and each band member would have been entitled to an undivided share in that goodwill. At the relevant date, both parties were active members of the band, as were Mr Graziano and Mr Reback. I have very little information as to the circumstances of Mr Graziano and Mr Reback joining the band (i.e. were they paid a set fee for each performance? Were they paid royalties? Did they enter into formal contracts?). As this is not a passing off case, it is not necessary for me to make a finding in this regard. However, in the absence of any agreement to the contrary, it seems likely to me that each of those individuals would have been entitled to an undivided share in the goodwill and, as a result, the name. Certainly, in respect of the applicant, that appears to have been the case here.

Assessment

What, in concrete terms, was the objective that the trade mark applicant has been accused of pursuing?

43. The thrust of the applicant's bad faith claim is a) that the proprietor made a false statement when filing his trade mark that he was the sole owner, b) that he had no right to register the mark, as he stopped using it in June 2019, whereas the applicant continued using it and c) that he has since used the registration to prevent the applicant from using the Contested Mark.

Was that an objective for the purposes of which the contested application could not be properly filed?

44. I accept, in principle, that the filing of a trade mark to prevent the other band members from using the Contested Mark when they were legitimately entitled to do so

or with no intention to use the mark himself could be objectives for the purposes of which the Contested Mark could not properly be filed. Similarly, I accept in principle that the filing of a trade mark in a sole name (as opposed to joint names), could also amount to bad faith.

Was it established that the contested application was filed in pursuit of that objective?

45. Point b) in paragraph 43 can be dealt with relatively swiftly. The assessment I must undertake is based upon the position at the relevant date i.e. 22 August 2018. At that time, as set out above, the proprietor was performing in the band under the Contested Mark. Clearly, therefore, it cannot be said that he had no intention to use the mark as he was, in fact, using it at the time (albeit as part of the band). There does not appear to be any suggestion (and, in any event, there is no evidence) that the proprietor was, at 22 August 2018, already contemplating leaving the band. Consequently, his subsequent departure as outlined in point b) cannot be relevant to his intentions or objectives at the relevant date. This cannot, therefore, be grounds for a finding of bad faith.

46. That leaves points a) and c). In my view, the fact that the application was made in the proprietor's sole name, combined with my findings above that he was not the sole owner of the name is sufficient to give rise to a prime facie case of bad faith. On the face of things, the proprietor should have known that the name was not his alone and that registration of the trade mark would give him exclusive rights to the name, to which he was not, on the face of things, entitled.

47. In his counterstatement, the proprietor sets out three main reasons for his denial of the bad faith claim, as set out in paragraph 3 above. I must, therefore, consider whether the explanation given by the proprietor rebuts the prima facie case of bad faith.

48. Two of the points raised by the proprietor are that: 1) he was the creator and owner of the name and 2) that the public associate him with the band rather than the applicant. I have already explained that creating the name does not prove ownership

and that, for the reasons set out above, the proprietor did not own the name himself; rather, it was a partnership asset. I have no doubt that the public would associate the proprietor with the band. However, I see no reason to conclude that they would not also associate the applicant with the band.

49. The final point raised by the proprietor in his counterstatement is that the applicant consented to the registration, in order for the proprietor to be able to deal with third parties with which the band were having difficulties. I note that the proprietor gives evidence regarding issues that the band was having with third party infringement prior to the time of filing. In his evidence in chief, the proprietor states that the band had experienced a number of problems with illegal merchandise. The proprietor has filed two letters to third parties which he states were sent in 2017 (although the letters themselves are undated).¹³ These were sent by the proprietor's wife, on behalf of the parties (and the band) and state:

- a. "Wayne Barrett and Mick Rossi, Slaughter and the Dogs are the copyrighted owners of "Lesser Free Trade Hall Slaughter and the Dogs and the Sex Pistols" poster that you are reproducing as a t-shirt and selling on the internet. Exhibit 2 illustrates your infringing use of Wayne Barrett and Mick Rossi, Slaughter and the Dogs, work through screenshots taken from the following [...] we are prepared to take the necessary steps to protect their interest and seek appropriate damages. Pursuant to Wayne Barrett and Mick Rossi, Slaughter and the Dogs, exclusive rights as the copyright owners of the work, we demand that you immediately remove from the internet and destroy all copies of the work in your possession [...];"
- b. "Wayne Barrett and Mick Rossi, Slaughter and the Dogs are the copyrighted owners of the following that you are reproducing as badges and selling on the internet; Slaughter and the Dogs "Dog Head Official Band Logo", Slaughter and the Dogs "Do It Dog Style" artwork, Slaughter and the Dogs "Beware of..." artwork, Slaughter and the Dogs "Rabid Dog", Slaughter and the Dogs "Logo with Blood", Slaughter and the Dogs "Cranked Up Really High" [...] artwork,

¹³ Exhibit WMB11

Slaughter and the Dogs “Logo UK Union Jack”, flyers reproduced in your scrapbook. [...] we demand that you immediately remove from the internet and destroy all copies of their works in your possession [...].”

50. The same exhibit also includes an email chain between Ms Custer-McGrath and a third party, which is dated June 2017. The first email from Ms Custer-McGrath states: “My fiancé is the singer and leader of Slaughter and the Dogs [...]. The below picture is a counterfeit t-shirt you are promoting [...]. [...] take the post down within the next 24 hours”. The third party responds stating: “this will be removed within 12 hours”. The proprietor’s wife responds: “Thank you for your cooperation. And quit making counterfeit merchandise!”. A similar thread of conversation took place in November 2017 in relation to what appears to be another listing. The third party confirmed “this has been removed”, to which Ms Custer Mc-Grath responded: “where is the remaining stock and how are you disposing of it? How much have you sold?”.

51. The proprietor states that he had brought up applying for a trade mark on a number of occasions from 2014 onwards, but was always told by the applicant that “he did not want to pay the fees, and it is your band anyway, but it’s a good idea”. This is supported by evidence from Ms Custer-McGrath who says that she was involved in a conversation with both parties in March 2017 (prior to her marriage to the proprietor) in which the issue of illegal merchandising was raised and the applicant said that he did not want to pay any fees or be involved in applying for a trade mark for the band name, although he did think it was a good idea. Mr John Pierre Thollet, a bass player who performed with the band until 2014, confirms that he overheard a similar discussion in August 2014, in which the proprietor raised the question of applying for a trade mark and the applicant stated that he did not want to help finance any trade marks as he did not think it concerned him (as the proprietor had come up with the name).

52. In this regard, the applicant states:

“[...] [The proprietor] claims to have brought up the idea of trademarking our bands name in a conversation with me in 2014 in a hotel lobby and introduced a witness statement from J.P. Thollet, a French musician, who lives in Lyon,

France and played Bass with [Slaughter and the Dogs] for several years and who claims to have been there for this alleged conversation. I never had any conversation of this nature with Barrett & J.P. Thollet and I would certainly never say trade marking our bands name did not concern me! This is an absurd assertion! Please note that I have known J.P. Thollet for many, many years and his comprehension of English is very limited. Some 3 years later, [the proprietor] claims a second similar conversation occurred, this time, in a van, involving his then girl-friend, Erin Custer, who was helping sell Merch on the road while we were touring. Barrett McGrath offers a witness statement from his (now) wife & manager Erin Custer McGrath, who is actually named in these proceedings as defaming the Mark and interfering & intermeddling with my ability to make a living as a musician, while acting as Barrett McGrath's representative. This alleged conversation also never happened. Paragraph 5 of Erin Custer McGrath's witness statement is a complete fabrication on her part. I have never had any conversation of this nature with [the proprietor] in front of his wife or anyone, be they band members or not. Please see witness statements from Mark Reback (SATD Drummer) & Dan Graziano (SATD Bass Player) who were playing on this tour with the Mark. I strongly refute these baseless claims."

53. Mr Reback's evidence in this regard is as follows:

"I never heard Erin Custer-McGrath say anything about securing a Trade Mark for the band name Slaughter & The Dogs, and I never heard Mick Rossi state what she said in her Witness Statement. Mick Rossi would never say what she said he did, because Mr Rossi is a founding member of Slaughter & The Dogs and would not knowingly give away his right to use the band name, which he co-founded."

54. Mr Graziano's evidence in this regard is as follows:

"I read Erin Custer McGrath's Witness Statement and I was on that 2017 European tour as the band's bassist and I never heard any conversations about securing a Trade mark for the band and I certainly never heard Mick Rossi say any of the things she is now claiming."

55. I accept Mr Graziano's and Mr Reback's evidence that they did not overhear the conversations referred to by the proprietor, Ms Custer-McGrath and Mr Thollet. However, that does not mean that the conversations did not occur; only that those individuals did not overhear them. I note the applicant's denial that this conversation took place. However, no request for cross-examination has been made to enable me to assess the reliability of the evidence given by the proprietor, Ms Custer-McGrath and Mr Thollet. I see no reason to doubt Ms Custer-McGrath's evidence, although I accept that it should be treated with the necessary caution, given her relationship with the proprietor. However, Mr Thollet does not appear to have a relationship with the proprietor over and above having been involved in the band previously. His evidence is, to my mind, particularly important. On balance, I find that the question of registering a trade mark was raised in discussions between the parties and that the applicant made comments to the effect that he was not interested in registering (or, at least, financing) a trade mark.

56. I note that the conversation referred to by Mr Thollet took place around 4 years prior to the relevant date; the conversation referred to by Ms Custer-McGrath took place around a year prior to the relevant date. However, there is nothing in the evidence to suggest that the proprietor should have known that the applicant's view on this had changed in the interim period. In light of the evidence regarding unauthorised merchandising and the conversations with the applicant (the only remaining 'original' band member) to the effect that he was not interested in funding a trade mark registration, it does not seem unreasonable to me that the proprietor decided to proceed with this proposed action alone. As set out in the case law above, it is not sufficient to establish facts which could also be consistent with good faith. Consequently, I am not satisfied that the actions of the proprietor in registering the Contested Mark amounted to bad faith.

57. In reaching this conclusion, I have considered whether the proprietor should have known that other band members (such as Mr Reback and Mr Graziano) had an interest in the name. I have found above that they most likely did have an interest, albeit there is very little information available to me as to the nature of their involvement in the band. However, the ownership of goodwill (and, consequently, the band name) where

there are multiple changing formations over a long period of time is a complex area of law and not one that the proprietor can be expected to have known or understood. Whilst I consider that he knew (or should have known) that the applicant had an interest in the name (by virtue of his long-standing and founding role in the band), I see no reason to conclude the same with regard to the other, newer band members.

58. The application for invalidation based upon section 3(6) is dismissed.

CONCLUSION

59. The application for invalidation is unsuccessful.

COSTS

60. The proprietor has been successful and is entitled to a contribution towards his costs. As the proprietor is unrepresented, the following letter was sent on 22 March 2021:

“If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. [...]

If there is to be a “decision from the papers” this should be provided by 19 April 2021. If a hearing is taking place you will be advised of the deadline to do so when the Hearing is appointed.”

61. However, no date was subsequently set for the proprietor to file a proforma.

62. Consequently, **I direct that the proprietor file a costs proforma within 14 days of the date of this decision**, if he wishes to claim costs. This should include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. I will then assess the costs I consider to be reasonable and issue a supplementary costs decision. For the avoidance of doubt, if the proforma is not completed and returned, costs, other than

official fees arising from the action (excluding extensions of time), may not be awarded.”

APPEAL PERIOD

63. The appeal period will be set from the date of the supplementary costs decision.

Dated this 2nd day of June 2021

S WILSON

For the Registrar