

O-296-11

TRADE MARKS ACT 1994

APPLICATION No. 2535492 BY THE ORIGINAL BUCKS FIZZ

TO REGISTER THE TRADE MARK

'THE ORIGINAL BUCKS FIZZ' IN CLASS 41

AND

OPPOSITION No. 100772 BY HEIDI MANTON

AND

APPLICATION No. 83877 BY THE ORIGINAL BUCKS FIZZ

TO REVOKE THE TRADE MARK 'BUCKS FIZZ'

REGISTERED UNDER No. 2137010

Background

1. BUCKS FIZZ was registered as a trade mark on 27 April 2001 in the name of Heidi Manton. The application for registration had been made nearly four years earlier on 25 June 1997, but the application was initially opposed by Mike Nolan and Rita Stroud (stage name, Cheryl Baker). The opposition was withdrawn in 2001. The mark was then registered under No. 2137010 for:

Class 09:

Sound and/or video recordings; gramophone records; audio cassettes; compact discs; video tapes and cassettes; CD-ROMS; computer software.

Class 41:

Live entertainment; theatrical, stage and musical entertainment and production thereof; shows; television broadcasts, video and audio broadcasts and recordings; entertainment services rendered by a vocal and instrumental group.

2. On 7 January 2010, The Original Bucks Fizz, a partnership consisting of Mike Nolan, Rita Stroud and Jay Aston (hereafter “the partnership”) applied to register THE ORIGINAL BUCKS FIZZ as a trade mark for entertainment services.

3. That application (No. 2535492) is opposed by Heidi Manton on two grounds. Firstly, that the trade mark is for identical services to those covered by earlier trade mark No.2137010 and the marks are so similar that there is a likelihood of confusion on the part of the public. Secondly, that the application was made in bad faith. This is because it was contrary to an agreement reached in March 2001 between the owner of the earlier Bucks Fizz trade mark and Mike Nolan which led to the withdrawal of the opposition to the registration of the earlier mark.

4. The partnership filed a defence which states that:

- i) The trade mark proprietor and Mr Bobby Gee (real name and hereafter ‘Robert Gubby’) pressurised Mr Nolan into withdrawing the opposition to the registration of the earlier Bucks Fizz trade mark.
- ii) Rita Stroud did not agree to withdraw her opposition to the registration of the earlier mark, despite the letter received by the Registry from solicitors purporting to have received instructions to that effect.
- iii) Since 2004, Rita Stroud and Mike Nolan have performed as a group known as ‘The Original Bucks Fizz’. The Original Buck’s Fizz toured the country and released singles under that name. In 2009, Jay Aston joined the group (see 5(i) below).
- iv) There was a verbal agreement between the trade mark proprietor and the partnership that Bucks Fizz and The Original

Bucks Fizz could co-exist. Accordingly, the proprietor is estopped from bringing this opposition.

5. The earlier Bucks Fizz trade mark is the subject of an application for revocation made by the partnership on 5 October 2010. The grounds for revocation are that:

- i) Bucks Fizz was a band manufactured to take part in the Eurovision Song Contest of 1981. The band consisted of Mike Nolan, Rita Stroud, Jay Aston and Robert Gubby.
- ii) This band won the contest and then toured for 3 years and had considerable success, including 20 top 'hits'.
- iii) The group now known as Bucks Fizz has only one original group member – Robert Gubby.
- iv) The use of Bucks Fizz by this group has led the public to believe that it is the same band described in points i) - ii) above, and consequently the use of the mark by the proprietor, or with her consent, is liable to mislead the public.

6. Heidi Manton filed a defence the relevant points of which are as follows:

- i) The members of the partnership and Robert Gubby (i.e. the original members of Bucks Fizz) were contracted to Big Note Music Limited. This contract started in 1981 when the band was formed and lasted for a minimum of 5 years. During this time the trade mark Bucks Fizz was registered to Big Note Music Ltd, which also owned the goodwill. Consequently, when Jay Aston left the band in 1985, Big Note Music Ltd organised a public competition to replace her and subsequently contracted the winner of it - Shelley Preston.
- ii) The membership of the group has since changed on numerous occasions: there have been 15 members at different times.
- iii) The group continues to perform over 100 live shows per year.
- iv) Changes to the group line up are advertised through the use of publicity photographs, biographies and press releases.
- v) It is denied that the use of Bucks Fizz is misleading the public
- vi) The registration of Bucks Fizz under No. 1162030 in the name of Big Note Music Ltd was allowed to lapse.
- vii) In April 1997, Nicola Martin on behalf of Big Note Music Ltd consented to the mark being registered in Heidi Manton's name.

- viii) Ms Manton denies that she or Robert Gubby pressurised Mike Nolan into reaching the 2001 agreement which led to the withdrawal of the opposition to the registration of the Bucks Fizz trade mark in her name.
- ix) There is no agreement for the partnership, or any of them, to use the mark Bucks Fizz, but the use of the name in a description of their former membership of the group is not disputed.

7. The invalidation and opposition proceeding are consolidated.

The Evidence

8. Heidi Manton's evidence takes the form of two witness statements from herself, one from Robert Gubby and one each from Derek Royal and Dean Spain. Mr Royal is a theatrical agent who has acted for Bucks Fizz in its various forms since 1990. Mr Spain is an entertainment booker who has secured the group's services at various times over the last 10 years.

9. The partnership's evidence takes the form of witness statements from themselves (two from Rita Stroud), and witness statements from Dr Clive Marchant, Barry McKay, Kevin Newell, David Hahn, Ian Stocker and Lisa Denning. Dr Marchant is a friend of Mike Nolan. Mr Newell has been a fan of Bucks Fizz since 1981. Mr McKay promoted pop concerts in the UK between 1971 and 1989. David Hahn is a celebrity agent who acts for Rita Stroud. Ian Stocker is the creator and administrator of the longest existing Bucks Fizz website called 'bucksfizzearlyyears.co.uk'. Lisa Denning is a celebrity booker who organised an interview in 2010 about the Eurovision Song Contest with who she understood to be Bucks Fizz.

10. It is convenient to summarise the evidence by relevant subject matter rather than by witness. I have, however, taken all the evidence into account.

Chronology of events

11. It will assist if I start with a chronology of events.

1981-84. The group Bucks Fizz is formed by Nicola Martin and Andy Hill of Big Note Music Limited. The trade mark Bucks Fizz is registered in the name of the company. Following the group's success in the Eurovision Song Contest, they go on to have a successful series of hits and tours.

1984. The group's coach is involved in a serious road traffic accident. Mike Nolan is worst injured, suffering serious head injuries. This interrupted the group's performances until 1985.

1985. Jay Aston left the group. Following a well publicised competition, she was replaced with Shelley Preston.

1989/1990. Shelley Preston left the group at the end of 1989.

1990-1993. Bucks Fizz performed as a trio consisting of Mike Nolan, Rita Stroud and Robert Gubby.

1993-1996. Rita Stroud left the group at the end of 1993 and Heidi Manton and Amanda Swarcz joined Mike Nolan and Robert Gubby.

1996-1997. Mike Nolan and Amanda Swarcz left the group in 1996. Mike Nolan was replaced with David Van Day. David Van Day subsequently left in 1997

1997- ? Mike Nolan and David Van Day performed as 'Bucks Fizz starring Mike Nolan and co-starring David Van Day'. It is not entirely clear how long this lasted, but Mike Nolan left that group in 2001.

1997-2001. Heidi Manton applied to register the Buck's Fizz trade mark in 1997. Following the withdrawal of an opposition filed by Rita Stroud and Mike Nolan, the mark was registered in her name in 2001. During this period Bucks Fizz continued to perform under this name as a foursome, with Robert Gubby as the only original member.

2001 to date. Bucks Fizz continues to perform as a foursome with Robert Gubby as the only original member. There were further changes to the line-up, but Robert Gubby and Heidi Manton were constants.

2004. A firm called Tony Denton Promotions organised a 7 date tour in December 2004 under the title "Here and Now Tour 2004" which featured artistes from the 80s era. Robert Gubby was contracted to appear on this tour performing with Mike Nolan, Rita Stroud and Shelley Preston as 'The Original Buck's Fizz'.

2004+ After this tour was completed Robert Gubby continued to perform with Bucks Fizz, but Mike Nolan, and Rita Stroud also continued to provide entertainment services, sometimes as The Original Bucks Fizz. The extent to which they did so, and whether they consistently performed under that name is disputed. However, there is no dispute that after Jay Aston joined them in 2009 the partnership performed under that name.

Registration No. 2137010 and the 2001 Agreement

12. According to Heidi Manton and Robert Gubby's evidence, at a meeting in April 1997 between the two of them and Nichola Martin (a Director of Big Note) it was agreed that Big Note Music Limited would assign the Bucks Fizz trade mark to Heidi Manton. However, it was then discovered that the trade mark had been allowed to lapse and Nichola Martin agreed instead to consent to the re-registration of the mark. There is no challenge to this evidence. The application was opposed by Rita Stroud and Mike Nolan. According to Ms

Manton, the terms of the verbal agreement made with Mike Nolan to settle the opposition proceedings are set out in a letter dated 28 June 2001 from Mike Nolan to Robert Gubby and herself¹. The letter is addressed to "Dear Bobby and Heidi". The terms of the letter are re-produced below.

"I write to you regarding our verbal discussion and agreement made in March 2001 concerning my withdrawal of my opposition to your trademark application dated 2nd April 2001.

I put it to you in writing and confirm that I have withdrawn my opposition to the trademark and will cease trading as Bucks Fizz that took immediate effect dated 17th March 2001. I have also withdrawn my website also confirming that I no longer wish to trade under the name Bucks Fizz.

I also confirm to you that it was agreed that both parties would be responsible for our own costs that have occurred without prejudice.

Due to my withdrawal of the trademark, I also confirm that I have no objections to you having the sole rights to the name Bucks Fizz being the last of the original line up which was formed in 1981."

13. Mr Gubby gives evidence that this letter confirms a verbal agreement reached with Mike Nolan after a hearing was appointed on 27 April 2001 to determine the opposition to the registration of Bucks Fizz in Heidi Manton's name. According to Mr Gubby, Mr Nolan initiated the settlement to those proceedings by calling Heidi Manton in March 2001 and offering to withdraw the opposition and cease trading as Bucks Fizz in return for each side bearing its own costs.

14. Mr Nolan's evidence is broadly consistent with this. He says that he left the pop group he was in with David Van Day in March 2001 in acrimonious circumstances, and that in the same month he:

"... called Bobby G to try and arrange a settlement before Court. Heidi Manton answered the phone, and I asked to speak to Bobby G. These were the only words I spoke to Heidi. I then told Bobby G that I did not wish to go to Court and that I did not want to pursue with my opposition to their trademark application. I was tired of this dispute and was physically exhausted from all the arguing and losing a considerable amount of money to David Van Day."

15. Mr Nolan goes on to state that:

"After verbally agreeing with Bobby G that I no longer wanted to have anything to do with the trademark dispute, he asked me to sign a written agreement of the same. Dr Clive Marchant agreed to type letters for me, which was dictated by Bobby G. I then signed them and they were used to inform Sarah Leno, the Trademark Registry and Bobby G.
At this time I was suffering from depression. I was very fragile and still suffered from short term memory loss. I had got to a point where I was fed up with all of the disputes in relation to Bucks Fizz and just wanted it all to end."

¹ See exhibit HM7 to Heidi Manton's statement of 1/2/11.

16. Mr Nolan adds that:

“On 28th June 2001, Bobby G requested that I write a further letter confirming that I was no longer opposing the trademark Bucks Fizz. This was again dictated by Bobby G and typed by Dr Clive Marchant, before being signed by me..... Again Cheryl was never asked to write and sign such a document. Within the letter it states that I confirm "I no longer wish to trade under the name Bucks Fizz", however I never had traded under the name Bucks Fizz. When working with David Van Day, we had been known as 'Bucks Fizz starring Mike Nolan and co-starring David Van Day'. In the final paragraph of this letter, it states 'I have no objections to you having the sole rights to the name Bucks Fizz, where the letter is addressed to both Bobby and Heidi, not Heidi solely. At the time I believed I was allowing Bobby G to have the trademark, not his wife, who was not an original member. The letter then goes on to say 'being the last of the original line up which was formed in 1981, which further let me to believe I was allowing Bobby G to have the trademark, not Heidi Manton.”

17. The last sentence of this statement is difficult to understand because paragraphs 18 and 30 of the same statement indicate that Mr Nolan understood that the trade mark application had been made (and later registered) in Heidi Manton's name alone.

18. As I noted earlier, Dr Marchant is a friend of Mr Nolan. He works as an Offender Manager/Practitioner for the Ministry of Justice. Dr Marchant does not say that he is a medical doctor, still less that he is qualified to provide an expert opinion on Mr Nolan's mental state in March 2001. Although it appears that the conversation in March 2001 between Mr Nolan and Mr Gubby took place on the telephone, Dr Marchant says that he was present. I take this to mean that he was with Mr Nolan when the conversation occurred and listened to his end of the conversation. On the basis of this, Dr Marchant gives the following evidence:

“Mr Nolan was not in a fit state to continue the battle over the trade name Bucks Fizz at this time.

Mr Gubby proposed to Mr Nolan that the only way this could be resolved was for Mr Nolan to withdraw his opposition to the trade name. This would, in practice, allow one of the original members to keep the trade name rather than allow Mr Van Day to take it from them. Mr Gubby did not, at any stage, mention that he would have objection about Mr Nolan nor any other original member of the group working under the name Bucks Fizz in the future. The main objective of this conversation was to stop Mr Van Day taking the name away from the original group or the original line up.”

19. There is no explanation as to how Dr Marchant can give first hand evidence of Mr Gubby's end of the conversation, but it is possible that he overheard it. Dr Marchant also gives evidence that:

“On 28th June 2001, Mr Gubby telephoned me requesting written confirmation about our previous conversation which took place in March 2001 (as above). I can confirm that Mr Gubby insisted that the contents of this letter be dictated by him... dated 28th June 2001 which was typed by me and

signed by Mr Nolan. We were both advised that this was to legitimize any comeback from Mr David Van Day regarding the misuse of the trade name Bucks Fizz.”

20. Despite the evidence that Mr Nolan was in a “fragile” mental state in March 2001, there is no medical evidence that he was incapable of making rational decisions at the time, or unable to understand the documents he was signing. Mr Nolan plainly found it too much to cope with the dispute over the Bucks Fizz name and another dispute with Mr Van Day over their income from their collaboration as ‘Bucks Fizz, starring Mike Nolan and co-starring David Van Day’. He seems to have decided to abandon the dispute over the name and continue with his claim against Mr Van Day. There was nothing irrational about that choice. Further, there is absolutely no evidence of any duress. I do not therefore accept that Mr Nolan’s letter of 28 June 2001 to Mr Gubby and Ms Manton should be given no legal significance or weight. As it was signed by Mr Nolan of his own freewill and represented his intentions at the time, it makes no difference whether the letter was drafted by him or by someone else.

21. Similarly, it makes no difference whether Mr Nolan thought that he was conceding the Bucks Fizz mark to Heidi Manton and Robert Gubby jointly, or to Heidi Manton alone. Given that he knew that the trade mark registration was in Heidi Manton’s name alone, and that he addressed his letter to both of them, it is not credible that he thought he was conceding the mark to Mr Gubby alone. The essential point is that he gave an unconditional undertaking to the legal owner of the trade mark - Ms Manton - to a) cease trading as Bucks Fizz, and b) concede sole rights to the name Bucks Fizz to Heidi Manton and Robert Gubby. It is difficult to square Dr Marchant’s evidence, that the letter was intended to confirm the earlier agreement of March 2001, with his evidence that Mr Gubby at no point indicated that he objected to Mr Nolan continuing to trade as Bucks Fizz. What else can “*you having the sole rights*” and “*[I] will cease trading as Bucks Fizz*” mean? Mr Nolan takes the point that he had not been trading as Bucks Fizz anyway, but as ‘Bucks Fizz starring Mike Nolan and co-starring David Van Day’. This is disingenuous. If he did not think he had been trading as Bucks Fizz, why did he agree to “*..cease trading as Bucks Fizz*”? (emphasis added)

The 2004 Tour

22. Ms Manton and Mr Gubby’s evidence is that Ms Manton licensed the use of the Bucks Fizz trade mark for the ‘Here and Now Tour 2004’. Mr Gubby’s evidence includes a copy of his contract² with the tour operator, Tony Denton Promotions (“TDP”). It appears from this that:

- i) Mr Gubby was contracted by TDP to appear on the tour;
- ii) It was agreed that he would appear with Rita Stroud, Mike Nolan and Shelley Preston as ‘The Original Bucks Fizz’;

² See exhibit RG8 to Mr Gubby’s statement.

- iii) The tour consisted of 7 dates in December 2004 and Mr Gubby was committed to appear on at least 4 of them (it seems that he made 5);
- iv) TDP was to pay the other artistes directly.

23. According to Ms Stroud's evidence, she initiated the getting back together of some of the original members of Bucks Fizz after speaking to Jay Aston in early 2003 and finding out that there was a big demand for this because of the 80s comeback which was taking place at the time. Ms Stroud says that she contacted Tony Denton and this led to the later offer to perform under the name 'The Original Bucks Fizz'. According to Ms Stroud, it was Robert Gubby who wanted the group to perform on the tour under this name.

24. I consider that Ms Manton's evidence of having 'licensed' the use of the mark in 2004 rather overstates the true position. There was no written licence as such. And a licence is not effective unless it is signed on behalf of the licensor³. Nevertheless, I think it is clear that:

- i) The use of the mark Bucks Fizz as part of The Original Bucks Fizz was made with the tacit consent of the trade mark proprietor;
- ii) This consent related to the 2004 tour in which Robert Gubby was a participant.

25. Ms Stroud gives evidence⁴ that:

"Liz Hobbs (agent) represented OBF [Original Bucks Fizz] early 2005 went up to see her in Newark. She had big plans for OBF. She asked Bobby [Robert Gubby] to get involved but he said no. Bobby knew that we was using the name Original Bucks Fizz and had no problem with this".

26. However, Mr Gubby and Ms Manton give evidence that they did have a problem with such use and tried to resolve the matter amicably with Ms Stroud, but that she would not discuss it. Further, Mr Nolan's evidence is that Robert Gubby and Heidi Manton have regularly contacted promoters and complained about the use of The Original Bucks Fizz.

27. There are no details of Ms Stroud's claim that "Bobby.... had no problem with [the use of Original Bucks Fizz]". It is a bare assertion. Further, the trade mark proprietor is Heidi Manton, not Robert (Bobby) Gubby. In my view, the claim of consent by, or on behalf of, the trade mark proprietor to post 2004 use of The Original Bucks Fizz is not substantiated by the evidence.

The use of The Original Bucks Fizz and Bucks Fizz since 2004

28. There is, in any event, disagreement as to the extent of the use of the mark The Original Bucks Fizz after 2004. Ms Manton points out that a range of names have been used by the partnership since 2005, including X-Bucks

³ Section 28(2) of the Trade Marks Act 1994.

⁴ See paragraph 20 of her first witness statement.

Fizz and sometimes just Bucks Fizz⁵. The exhibits to Ms Manton's statement show that around 2007, the name X-Bucks Fizz was in use⁶. Indeed there is scant documentary evidence of the partnership or its predecessor (with Shelley Preston instead of Jay Aston) performing as The Original Bucks Fizz before 2009. However, it appears that at least some performances under that name occurred. For example, a copy of an e-mail from 'stephen@digitalghostproductions.com'⁷ describes having gone to see Bucks Fizz and The Original Buck's Fizz in August and September of 2007. There is more evidence of use of The Original Bucks Fizz after 2009, but that is not in dispute.

29. The partnership claim that the proprietor's use has changed to Bobby G's Bucks Fizz in recent years. However, Ms Stroud gives evidence⁸ that the proprietor uses both Bucks Fizz and Bobby G's Bucks Fizz (which, she complains, adds to the public confusion). So it is not factually correct to say that the proprietor no longer uses the mark as registered.

Evidence that the public are mislead/confused

30. It seems to be common ground that the public are confused by the parties' use of Bucks Fizz. The issue between the parties is the cause of this misleading/confusion. The partnership relies on evidence which they say shows that:

- i) The majority of the on-line media think of Bucks Fizz as including Cheryl Baker, Mike Nolan and Jay Aston;
- ii) The proprietor of trade mark No. 2137010 (Bucks Fizz) has provided services which utilise images or sound from the original Bucks Fizz line up;
- iii) The proprietor has promoted the group which provides entertainment services under the Bucks Fizz mark as "winners from 1981" (of the Eurovision Song Contest), contrary to the facts;
- iv) A picture of the original line-up of the group has been used to promote the services currently provided under the Bucks Fizz mark;
- v) The group which provides services under the mark has been promoted as one of a number of "massive acts from the 1980s" thereby misleading the public to expect the original group line-up;
- vi) Customers have complained of being mislead by the use of the Bucks Fizz mark to designate services other than those associated with the group's original line-up.

31. In support of point i) above, Rita Stroud gives evidence that the first page of hits in a recent Google search against 'Bucks Fizz' produced six images of

⁵ The partnership say that this is use by promoters without their consent.

⁶ See exhibit HM8 to Ms Manton's first statement.

⁷ See exhibit CB3 to Ms Stroud's first statement.

⁸ See paragraph 26 of her second witness statement.

Bucks Fizz, five of which include herself and Mike Nolan, an entry in Wikipedia, which also mentions herself, Mike Nolan and Jay Aston, and links to three YouTube videos showing performances from the 1980s by the original line-up of the group.

32. In support of point ii), Rita Stroud gives evidence that material available on YouTube shows entertainment services being provided under the mark that feature Robert Gubby and others miming to the song 'Making your mind up' as actually performed by the original line-up, and the group appearing on a Spanish TV show with footage of the original line-up of the group in the background.

33. In support of point iii), Rita Stroud provides evidence⁹ of a poster advertisement for entertainment services provided in Portsmouth in 2009 featuring several acts including Bucks Fizz. The claim "winners from 1981" appears next to a picture of a group featuring just one of the original line-up of Bucks Fizz.

34. In support of point iv), Rita Stroud provides evidence¹⁰ of a "Best of British Variety Tour 2009", which included services provided under the mark Bucks Fizz, and which featured a picture of the original line-up of the group.

35. In support of point v) above, Rita Stroud provides evidence¹¹ of an advertisement on a website for 'shortbreakoffers' at Butlins Adult 80s weekends and Short Breaks, which promotes "massive acts from the 1980s such as..... Bucks Fizz".

36. It is convenient at this point to assess points i) -v) before moving on to point vi). The Google search shows only that the Bucks Fizz group from the 1980s is more prominently referenced on the internet than any other group that has performed under that name in recent years. This is hardly surprising given that the groups that performed under the mark in the 1980s were much more successful than those performing under the name in recent times. The YouTube clips show the Bucks Fizz group as constituted at the time of the recordings. Miming is not evidence of impersonation or misleading the public as to the makeup of the current group. The appearance of a recently constituted Bucks Fizz group on a Spanish TV show is, a) outside the jurisdiction, and b) makes no more than a nostalgic link to the original group. This is plainly not evidence of an attempt to impersonate the original group or mislead the public.

37. The advertising poster for a recently constituted Bucks Fizz group with the claim "winners from 1981" is misleading because the trade mark owner cannot claim the credit for the success of earlier groups performing under the Bucks Fizz name. Similarly, the use of a picture of the original line-up of the group in connection with the "Best of British Variety Tour 2009" is also misleading. However, there is no evidence that the trade mark owner was responsible for

⁹ See CB2 to Ms Stroud's first statement.

¹⁰ See CB4 to Ms Stroud's first statement.

¹¹ See CB6 to Ms Stroud's first statement.

this advertisement. The same can be said about the reference in a promotion for a Butlin's 1980s weekend to the current group as being one of the "massive acts from the 1980s". Merely providing services under the mark at nostalgic events looking back at the 1980s is plainly not misleading *per se*.

38. Turning then to the issue vi), public complaints, Ms Stroud and Mr Nolan give evidence¹² of e-mails and posts from fans claiming to have been and, in some cases, witnessed other fans who had been, disappointed to find that services were provided under the Bucks Fizz mark by a group with only one original group member and/or by the quality of the group's performances. It is clear from the way the material is addressed and dated (nearly all January/early February 2011) that these mails and posts were acquired during the course of these proceedings for the purposes of supporting the partnership against the trade mark proprietor. Nearly all contrast the services provided by the trade mark owner with, as they see it, the more worthy, legitimate and/or higher quality services provided by the partnership under the name 'The Original Bucks Fizz'. That is not to say that the views expressed are irrelevant, but these are not spontaneous complaints about services provided on behalf of the owner of the Bucks Fizz mark. Rather they are from fans opining as to which of the two groups trading as Bucks Fizz/Original Bucks Fizz has the better claim to the Bucks Fizz name. Importantly, this means that it cannot be assumed that these mails and posts would have existed if there had not been two groups claiming to be Bucks Fizz.

39. Mr Hahn's evidence is that he has acted as Celebrity Agent for Rita Stroud for 5 years. His statement is undated, but was filed earlier this year. So I take this to mean that he has acted for her since 2006. Mr Hahn says that over this period he has received "a great deal of emails and phone calls from unhappy fans who have purchased tickets to see 'Bucks Fizz' not knowing that the original band member is [Robert Gubby]" and that he has received enquiries "asking if [Rita Stroud] is part of the Bucks Fizz advertised by [Robert Gubby]".

40. Ian Stocker runs a Bucks Fizz website [bucksfizzearlyyears.co.uk] and, as the name suggests, is a longstanding fan of Bucks Fizz. As a result he often discusses the group with family and friends. He says that:

"I am a long standing fan of Bucks Fizz, which is widely known in my circle of friends and family. As a result, the subject of Bucks Fizz is often raised and discussed with me at social gatherings etc. The most commonly asked question is in connection with what the band is currently doing and who is currently in the band. There has been much confusion over the years following newspaper reports, particularly around David Van Day and the group line up. This generally leads on to discussing who they remember as being in the Original Bucks Fizz. The two names which are always mentioned to me in connection with the group are either Cheryl Baker or Mike Nolan. It is fair to say that people would generally expect to see either of these two group members in the line up.

On a number of occasions, I have been told of stories when people have visited Butlins on 80's weekends, which advertise Bucks Fizz as one of the

¹² See CB3 to Ms Stroud's first statement and MN6 to Mr Nolan's statement.

participating acts. They have expected to see what they perceive as the original members of Bucks Fizz, and have been disappointed when Bobby G and three relatively unknown individuals then perform on stage. In my role as creator and administrator of the longest running Bucks Fizz website on the internet, I often receive emails from the general public asking for clarification on who would be performing at certain venues.”

41. I note that Mr Stocker’s most common personal experience is of people asking him what the band is currently doing and who is in it. This suggests that Mr Stocker’s circle of friends and family are well aware that the current line-up of Bucks Fizz is not the original one. Of course, given his own exceptional interest in the group, the level of knowledge of his friends may not be typical of the public at large. Mr Stocker also says that he has been “told of stories” of the public at Butlins’ 80s weekends expecting to see the original members of the group when services have been promoted under the name Bucks Fizz. This is obviously hearsay. He does not even say who told him these “stories” or how that person, or those persons, came by the knowledge. This is simply gossip. I attach no weight to it.

42. Mr Newell is also a longstanding fan of the group. His evidence is encapsulated in paragraph 6 of his statement as follows:

“To any reasonable person, the current line up consisting of Bobby Gubby, Heidi Manton, Tammy Choat and Paul Fordham could not be described as Bucks Fizz, and they represent a poor facsimile or spurious copy of the original group, and I have witnessed this reaction to them myself on several occasions. The group with these members can only be described as counterfeit and any reasonable person would expect Bucks Fizz to contain the original members who participated in the aforementioned events and whose vocal talents took them to the top of the charts through the 1980s. People would expect to see Bucks Fizz as Cheryl Baker, Mike Nolan, Jay Aston and Bobby Gubby.”

43. Mr McKay was a promoter of concerts between 1971-1989. He appears to be put forward as an expert who knows who the public would expect to be in a group called ‘Bucks Fizz’. However, there is nothing in his evidence which indicates that he has any direct experience of the matter from having spoken to any members of the relevant public. As such I find his evidence inappropriate and irrelevant. Further, he makes a personal attack on Mr Gubby calling him “*a most obnoxious person*”. Accordingly, even if there was a role for independent ‘expert’ evidence as to what the public thinks (which there is not), Mr McKay would not be qualified to give it.

44. Similarly, I find Ms Denning’s evidence irrelevant. All she says is that she wanted to interview the Eurovision Song Contest winning group. So her interest was historical. She went to the partnership because they comprised three of the original members. She did not know of the other group providing services under the Bucks Fizz trade mark.

45. In my judgment, the above evidence establishes no more than that:

- i) The public remember who was in the original group called Bucks Fizz;
- ii) There are more members of the original band in the partnership than there are in the group that currently provide services under the mark Bucks Fizz;
- iii) Since the services provided by the trade mark owner have had to compete with services provided by partnership under the name 'The Original Bucks Fizz', there has been some confusion as to the source of the services provided under the mark Bucks Fizz.

46. It is more difficult to assess the level of confusion prior to the partnership providing entertainment services under the name The Original Bucks Fizz. Mr Gubby gives evidence¹³ that Rita Stroud's exit in 1993 from the group then performing as Bucks Fizz was the subject of a statement sent to all the groups' fans at the time. The statement indicated that Ms Stroud was leaving to concentrate on solo work and that the group would continue as a foursome without her. Indeed, it records that she wished them well. Ms Stroud accepts the accuracy of this statement, but points out that the group then performing as Bucks Fizz had only around 100 fans. Therefore most of the fans of the original group would not have seen it.

47. Mr Spain has booked services under the trade mark Bucks Fizz for 10 years at places such as Pontins, Butlins, Park Resorts and Parkdean Holidays and Haven. He says that the group was requested back and that any changes in the line-up were always communicated to him by Heidi Manton, along with supporting biographies, photographs and advertising material.

48. Mr Royall is a theatrical agent who represents the group providing services under the mark Bucks Fizz. He has also represented Rita Stroud since she left the group and secured her engagements under the name Cheryl Baker. His evidence is that whenever there have been changes to the personnel within Bucks Fizz, Heidi Manton has provided him with photographs and an amended biography to publicise the change.

49. I conclude that:

- i) The trade mark owner has taken steps to inform the public about changes in the line-up of the group performing under the name Bucks Fizz;
- ii) There is no credible evidence of the Bucks Fizz mark misleading or confusing the public prior to the partnership or its predecessor starting to perform as The Original Bucks Fizz.

¹³ See RG6 to Mr Gubby's statement.

The Hearing

50. The matter came to be heard on 15 July 2011 when the partnership were represented by Mr Dean Durham of Debello Law and Heidi Manton was represented by Mr Robert Gubby.

51. It emerged at the start of the hearing that Mr Dunham had made a request on 23 May 2011 to cross examine Heidi Manton and Robert Gubby. However, this request had not been copied to the people concerned (unlike other communications from Mr Dunham's firm), and the request did not appear to have been received by the Registrar. Consequently, no response was made to it. Mr Dunham asked for an immediate adjournment, which I refused. I did, however, agree to consider resuming the hearing at a later date so that cross examination could take place, subject to directions on the issues to be covered and costs. In the event, Mr Dunham later withdrew the request.

The Partnerships' Application to Revoke the Bucks Fizz Trade Mark

52. Section 46(1) of the Act (insofar as it is material) is as follows:

46. - (1) The registration of a trade mark may be revoked on any of the following grounds-
- (a) -
 - (b) -
 - (c) -
 - (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

53. Although there is no claim that the partnership has an earlier right to the mark Bucks Fizz, their case is that the use of that mark by its proprietor is liable to mislead the public into believing that the entertainment services provided under the mark are those of the original group that performed under the name Buck Fizz. I therefore find it convenient to start by examining the ownership of the mark prior to it being registered by Heidi Manton.

54. It is common ground that Bucks Fizz was first registered by Big Note Music Limited ("Big Note") in or around 1981. This is the business that 'manufactured' the original group. Mr Gubby's evidence is that each of the original four members were contracted to provide their services to Big Note and that all were aware that Big Note owned the trade mark rights. Although the other original members quibble with the description 'employees' there is no real dispute that Big Note owned the trade mark rights, and I think it is to be inferred that all had accepted that the goodwill in the business conducted under the name Bucks Fizz accrued to Big Note. This assessment of the relationship between the original group members and Big Note is consistent with Big Note (not the other members) organising the replacement of Jay Aston when she left the group in 1985.

55. It appears that the Bucks Fizz trade mark was allowed to lapse and was no longer registered when Heidi Manton sought to acquire ownership of it from Big Note in 1997. Prior to 1994, trade marks were initially registered for a period of seven years and could be renewed for further periods of fourteen years. Consequently, it seems that the original trade mark would have lapsed around 1988 (otherwise it would have been renewed until 2002). Further, as the success of the second group to perform as Bucks Fizz ebbed towards the end of the 1980s it appears that the relationship with Big Note came to an end. Consequently, by the time Jay Aston's replacement, Shelly Preston, left the group to pursue a solo career at the end of 1989, the other three members were free to decide to continue as a trio. At least from this point onwards (and probably from some point earlier), the group were probably operating as a partnership at will.

56. The relevant law was considered by Laddie J. in connection with the registration of a trade mark consisting of the name a heavy metal band called Saxon¹⁴. The application for registration of Saxon was made by two members of the original group, Messrs Oliver and Dawson. Both had left the group by the time they made their application for registration: Mr Dawson twelve years before, Mr Oliver two years before. Both had been replaced and gone on to work as musicians in other bands. An application was made by another band member, Mr Byford, to invalidate the trade mark. Mr Byford had continued to be a member of various manifestations of the band since the 1970s. The invalidation application was initially rejected by the Registrar on the grounds that each of the band members held a share in the goodwill of the band, which they were entitled to exploit. Consequently, Mr Byford's claim was no greater than that of Mr Oliver or Mr Dawson. On appeal Laddie J. assessed the situation differently. He said that:

"19. In my view, Mr Foley's views as to ownership of the name SAXON and the goodwill associated with it are not correct. There is no dispute that the group was a partnership at will in the 1980s. The name and goodwill were assets of the partnership. All the partners have or had an interest in those and all other assets of the partnership, but that does not mean that they owned the assets themselves. Absent a special provision in the partnership agreement, the partners had an interest in the realised value of the partnership assets. On dissolution of the original partnership, which is what happened when Mr Dawson departed in 1985, he and all the other partners were entitled to ask for the partnership assets to be realised and divided between them in accordance with their respective partnership shares. But none of them "owned" the partnership assets. In particular, none of them owned the name SAXON or the goodwill built up under it."

"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, entirely 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,

¹⁴ See *Byford v Oliver* [2003] Fleet Street Reports, 39.

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 the 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 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.”

57. On the facts of the *Saxon* case, the judge decided that Mr Dawson had abandoned his share in the goodwill in the partnership by the time that the application for registration was made, and that Mr Oliver was in much the same position. Consequently, neither was entitled to apply for registration in the face of the goodwill generated by the more recently constituted partnership performing as *Saxon*. Further, the judge was of the view that if Mr Dawson and Mr Oliver started to perform again as *Saxon*, Mr Byford's group would have been entitled to sue them for passing off on the basis of their more recent use of the name and the goodwill associated with it, and that Mr Dawson and Mr Oliver's historical connection to the name would have provided no defence¹⁵.

58. In the light of the law expressed in *Saxon* it seems likely on the facts of this case that a new partnership was formed when Shelley Preston left the group in 1989, that another partnership again was formed when Rita Stroud left in 1993 and was replaced by Heidi Manton and Amanda Swarcz, and further partnerships were formed when Mike Nolan left in 1996 and was replaced by David Van Day, and when David Van Day subsequently left in 1997.

¹⁵ See paragraphs 33 and 34 of the judgment.

59. Heidi Manton's application to register the trade mark in 1997 with the consent of the only other continuing group member, Robert Gubby, probably changed the position after that, but that does not matter for present purposes.

60. In my judgment, Rita Stroud abandoned her share in the goodwill when she left the partnership in 1993 to pursue a solo career without making a claim for a share of the partnership assets. It seems that her subsequent role in opposing Heidi Manton's application for registration was limited to supporting Mike Nolan. Accordingly, when he withdrew the opposition, her opposition also fell away. The position of Mike Nolan is less clear, but there is a strong likelihood that his letter of 28 June 2001 amounted to an abandonment of his share in the goodwill in the partnerships he was a member of up until 1996. Jay Aston left the group whilst the mark was being used only with the consent of Big Note. Consequently, it is unlikely that she ever owned a share of any goodwill associated with the name Bucks Fizz.

61. Turning to events after 2004, when Mike Nolan, Rita Stroud and Shelley Preston re-formed as The Original Bucks Fizz then, absent a partnership agreement, they probably formed a new partnership at will, which was dissolved when Shelley Preston left in 2009 and the partnership in these proceedings was formed.

62. The net result of these observations is that:

- i) The individual members of the current partnership can make no claim to be the owners of the goodwill in Bucks Fizz, and
- ii) The current partnership cannot claim the benefit of any goodwill generated by previous partnerships, i.e. before 2009.

63. Further, as I noted earlier, there is unchallenged evidence that the owner of the trade mark at the time of the original line-up of the group (Big Note) has consented to the registration of the trade mark in the name of Heidi Manton. That makes it unlikely that anyone else has a better legal claim to the mark. On the face of it, it is difficult to see why the use of the trade mark by its lawful owner can be said to mislead the public, essentially because of the residual goodwill from the performances and recordings of the original group.

64. However, Mr Dunham submitted that his case could succeed even if the trade mark owner was the lawful owner of the mark. His argument was essentially twofold. Firstly, that provided the public is misled by the use of the mark *per se*, it is not decisive that the proprietor is the lawful owner of the mark. This seems to me to be saying that the residual goodwill associated with the original group is so strong that the trade mark owner's later use of the mark to designate a different group was bound to mislead from the outset in 1997. Mr Dunham's second line of argument is that specific uses made of the mark in association with misleading material are such as to make the mark misleading. However, he stopped short of accusing the owner of deliberately deceiving the public.

65. Mr Dunham correctly identified that the judgment of the European Court of Justice (“ECJ”) in Case C-259/04, *Elizabeth Emanuel v Continental Shelf 128 Ltd* presented his first line of argument with some difficulty, and that it was necessary for him to distinguish that case from this one. In *Emanuel* the ECJ was asked whether the use of a trade mark corresponding to the name of a well known clothing designer could be regarded as deceptive or misleading where:

- i) The mark had been assigned for consideration to another party and was being used by that party, and
- ii) The public might still believe that the clothing marketed by the new owner is connected with the designer.

66. The court answered that:

“A trade mark corresponding to the name of the designer and first manufacturer of the goods bearing that mark is not, by reason of that particular feature alone, liable to revocation on the ground that that mark would mislead the public, within the meaning of Article 12(2)(b) of Directive 89/104, in particular where the goodwill associated with that mark has been assigned together with the business making the goods to which the mark relates.”

67. This is highly relevant to the application before me because section 46(1)(d) of the Act implemented Article 12(2)(d) of the Trade Marks Directive and must be applied consistently with the Directive. Consequently, the decision of the ECJ is binding on me insofar as the scope of s.46(1) is concerned, and Mr Dunham’s first argument appears to raise a similar legal point to the one that the ECJ considered in *Emanuel*.

68. In order to understand the ECJ’s answer it is necessary to examine the court’s reasoning. The relevant section is as follows:

“44. As the Commission pointed out, for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish and maintain, it must offer a guarantee that all the goods or services bearing it have been manufactured or supplied under the control of a single undertaking which is responsible for their quality (see, in particular, *Arsenal Football Club*, paragraph 48).

45. A trade mark such as ‘ELIZABETH EMANUEL’ may have that function of distinguishing the goods manufactured by an undertaking, particularly where that trade mark has been assigned to that undertaking and the undertaking manufactures the same type of goods as those which initially bore the trade mark in question.

46. However, in the case of a trade mark corresponding to the name of a person, the public interest ground which justifies the prohibition laid down by Article 3(1)(g) of Directive 89/104 to register a trade mark which is liable to deceive the public, namely consumer protection, must raise the question of the risk of confusion which such a trade mark may engender in the mind of

the average consumer, especially where the person to whose name the mark corresponds originally personified the goods bearing that mark.

47. Nevertheless, the circumstances for refusing registration referred to in Article 3(1)(g) of Directive 89/104 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (Case C-87/97 *Conorzio per la tutela del formaggio Gorgonzola* [1999] ECR I-1301, paragraph 41).

48. In the present case, even if the average consumer might be influenced in his act of purchasing a garment bearing the trade mark 'ELIZABETH EMANUEL' by imagining that the appellant in the main proceedings was involved in the design of that garment, the characteristics and the qualities of that garment remain guaranteed by the undertaking which owns the trade mark.

49. Consequently, the name Elizabeth Emanuel cannot be regarded in itself as being of such a nature as to deceive the public as to the nature, quality or geographical origin of the product it designates.

50. On the other hand, it would be for the national court to determine whether or not, in the presentation of the trade mark 'ELIZABETH EMANUEL' there is an intention on the part of the undertaking which lodged the application to register that mark to make the consumer believe that Ms Emanuel is still the designer of the goods bearing the mark or that she is involved in their design. In that case there would be conduct which might be held to be fraudulent but which could not be analysed as deception for the purposes of Article 3 of Directive 89/104 and which, for that reason, would not affect the trade mark itself and, consequently, its prospects of being registered.

51.-

52.-

53. Since the conditions for revocation laid down by Article 12(2)(b) of Directive 89/104 are the same as those for the refusal of registration under Article 3(1)(g) of that directive.....a trade mark corresponding to the name of the designer and first manufacturer of the goods bearing that mark is not, by reason of that particular feature alone, liable to revocation on the ground that that mark would mislead the public, within the meaning of Article 12(2)(b) of Directive 89/104, in particular where the goodwill associated with that mark has been assigned together with the business making the goods to which the mark relates."

69. The key to the court's reasoning is in paragraph 44 of the judgment above. The essential function of a trade mark is to guarantee that all the goods or services sold under the mark are provided under the control of a single undertaking, which is responsible for their quality. It is not a guarantee of quality *per se*. Accordingly, if the trade mark owner decides to provide services or a higher, lower or just different quality, than he has him or herself provided in the past, that is not to be taken as misleading the public. The position can be no different where the services provided in the past were provided by someone else. And even where the trade mark is the

personification of an individual, as in the *Emanuel* case, the lawful use of the mark by a later owner cannot, of itself, be classed as misleading.

70. There is no reason to think that the position is any different where the mark does not personify an individual, but is said to personify a group of individuals. Further, the name of a pop group is not as closely linked to particular individuals as a personal name, such as Elizabeth Emanuel, is to a particular person. There are many examples of well known groups, such as the Sugababes, where the line-up of the group has changed considerably over time.

71. Mr Dunham sought to distinguish his clients' case from *Emanuel* by pointing out that the question in that case turned on the assignment of the mark, whereas in this case the question arises in the context of a subsequent registration of the same mark by a different party. However, in my judgment, that distinction does not assist his case. Indeed, the court's qualified that its answer applied:

“.....in particular where the goodwill associated with that mark has been assigned...”.(emphasis added)

72. The use of the words, “in particular” indicate that the answer was not limited to the situation where the trade mark had been assigned. Mr Dunham also sought to distinguish *Emanuel* on the facts. He submitted that the consistent quality of the goods was a factor in *Emanuel*, but was absent here. However, as a preliminary reference to the ECJ is concerned only with points of law, the particular facts of the *Emanuel* case could not have determined the court's answer to the question of law referred to it by the national tribunal.

73. I therefore reject Mr Dunham's first argument that the public association between the name Bucks Fizz and the members of the original line-up of that group is so strong that the trade mark owner's use of the mark to designate a different group is inherently misleading.

74. If the argument was a good one then the partnership's own use of Bucks Fizz would also be misleading because Mr Gubby, who was also an original member of Bucks Fizz, is not a member of the partnership. Mr Dunham sought to meet this point by suggesting that the use of Bucks Fizz by a majority of the original members, or by a majority of the partnership, would not be misleading, whereas the use of the mark by a group with only one original member is misleading. The suggestion that a majority of the original members is enough to avoid misleading the public is a development of the pleadings, which claim that use of the mark other than by the original four members of the group would be misleading. The further development that a majority of the partnership would also be free from objection is no doubt because for a period of time The Original Bucks Fizz contained only two of the original four members, Ms Stroud and Mr Nolan. There is a further argument that these two members are somehow more significant than the other members because they are better known. I can see no legal basis for any of these distinctions. The outcome of the submission - that two original members are enough to

avoid misleading the public (possibly provided that these are Rita Stroud and Mike Nolan), but that one original member is not enough, appears to me to be an arbitrary distinction, which merely serves to confirm that the first argument is not well founded.

75. I confess that in the light of the ECJ's judgment in *Emanuel*, I have not found it easy to assess whether there is a legal basis for Mr Dunham's second argument – that certain uses of the Bucks Fizz mark have made it misleading. This is because the court clearly indicated that deception under article 3(1)(g) of the Directive (corresponding to section 3(3)(b) of the Act) depended on the nature of the mark alone (when compared to the goods and services for which it was to be registered) and paragraph 53 of the judgment states that:

“...the conditions for revocation laid down by Article 12(2)(b) of Directive 89/104 are the same as those for the refusal of registration under Article 3(1)(g)..”

76. If this means that s.46(1)(d) has the same scope as s.3(3)(b) then the second argument is no better than the first because the mark is not deceptive by nature. Mr Dunham's argument depends not on the nature of the mark itself¹⁶, but on who is using it. However, this limited view of the scope of s.46(1)(d) does not sit easily with the wording of the provision itself, which plainly contemplates the result of the use of the mark, or with paragraph 50 of the ECJ's judgment, which points out that it is for the national court to assess whether the use made of the mark is fraudulent. There would be little point in looking at this if the judgment means that even fraudulent use does not fall within s.46(1)(d). I therefore consider that the ECJ's judgment cannot mean that the scope of s.46(1)(d) is no different to that of s.3(3)(b). Rather the judgment means that the conditions for refusal and revocation are the same where these relate to whether a mark corresponding to a well known personal name can be regarded as being inherently deceptive when used by someone else.

77. Have the specific uses made of the mark by, or with the consent of, the owner made the mark misleading? I am prepared to accept that the use of a mark in conjunction with misleading claims or statements may, over time, make the mark itself misleading. And I have accepted that a few misleading statements have been made. However, there is little evidence that these statements were made by, or with the consent of, the trade mark owner. Further, the frequency and scale of any misleading claims is not so great as to result in the continued use of the mark being liable to mislead the public as to the source or nature of the services provided under it.

78. In reality the confusion as to whether Bucks Fizz designates the original line-up of the group has only really become a live issue since The Original Bucks Fizz started to compete with the trade mark owner. Prior to 2009, the public would have had no reason to expect the group performing as Bucks Fizz to consist of the original line-up. That line-up had not performed together

¹⁶ Unlike the *Orlwoola* case [1909] 26 RPC, to which Mr Dunham drew my attention.

for 24 years, since 1985. And for substantially all of this period, Bucks Fizz continued to perform with varying line-ups and apparently without complaint. Even if one considers what the position was prior to 2004 (when The Original Bucks Fizz first came into existence), Rita Stroud had not at that point performed as a member of Bucks Fizz for over 11 years, having left the group in 1993, and Mike Nolan had not performed as Bucks Fizz for 8 years, since 1996 (or for at least for 3 years if one includes his performances in a rival Bucks Fizz group with David Van Day). Plainly, once the public became aware that most or all the original members of the group were once again performing under the name Bucks Fizz, the public's expectations as to the line-up of any particular group appearing under that name was liable to change. But the recent confusion is not the result of the use made of the mark by its owner. Rather it is primarily the result of the use made of the name Bucks Fizz by the partnership and its immediate predecessor. The trade mark owner cannot be held responsible for that because, other than for the one-off tour in 2004, such use was not with the consent of the trade mark owner.

79. I therefore reject the ground for revocation under s.46(1)(d) of the Act.

Heidi Manton's Opposition to the Partnerships' Application No. 2535492

80. Section 5(2)(b) states that:

- (2) A trade mark shall not be registered if because -
 - (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
 - (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

81. Trade mark 2137010 is plainly an earlier trade mark compared to application 2535492. Further, there is no dispute that the earlier mark covers the same services specified in the later trade mark application. Consequently, the only question under this heading is whether the marks are similar enough for there to exist a likelihood of confusion. According to the relevant case law¹⁷, a likelihood of confusion exists where the marks are directly mistaken one for the other, or the later mark is liable to be misremembered as the earlier mark, or the resemblance between the marks is sufficient to cause the relevant public to expect that the later mark is used by the owner of the earlier mark, or by a person with an economic connection to the owner, such as a licensee. In each case the matter is to be assessed through the eyes and ears of a reasonably attentive average consumer of the services in question.

¹⁷ Sabel BV v Puma AG [1998] RPC 199, Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117, Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77, Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723, and Shaker di L. Laudato & C. Sas v OHIM C-334/05 P

82. On the face of it, the resemblance between the marks Bucks Fizz and The Original Bucks Fizz is so great that, at least when used in respect of the same services, there is no doubt that there exists a likelihood of confusion. The only difference, the addition of “The Original..” is not a distinctive difference. These words are really used as much to lay claim to the goodwill of the original group as they are to distinguish the partnership’s use from that of the trade mark owner.

83. Mr Dunham submitted that if I was against him on the partnership’s application for revocation, then as a matter of logic I must find that there is no likelihood of confusion. However, although I agree that there is a likelihood of confusion (in fact actual confusion), I consider that to be the result of the more recent use of the partnership’s mark, rather than as a result of the use made of the earlier mark. I see no illogicality in this conclusion.

84. Mr Dunham also asked me to take account of the fact that the mark applied for is used as a logo. However, this is irrelevant because the mark applied for is not the logo version of the mark, but the words alone. In any event, the words Bucks Fizz are even more visually prominent in the logo version I have seen than they are in the word only version.

85. Finally, Mr Dunham asked me to take account of the fact that the trade mark owner has taken to adapting her mark to “Bobby Gee’s Bucks Fizz”. Indeed, although he did not maintain the request, Mr Dunham at one point invited me to revoke the earlier mark for non-use. These are bad points. Firstly, no application has been made to revoke the earlier mark for non-use. Secondly, the partnership had a specific opportunity when filing their counterstatement in the opposition to request the owner of the earlier mark to show that it satisfied the use requirements at the date of the publication of the later mark. This opportunity stems from section 6A of the Act which (so far as it is relevant) is as follows:

“(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
(3) The use conditions are met if -
(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.”

86. The part of the Form of Counterstatement designed for requests for proof of use was left empty. It was too late to make such a request at the hearing and after the evidence had been filed. In any event, it is clear on both parties’ evidence that the owner of the earlier mark did make use of Bucks Fizz alone in the five year period ending on the date of publication of the opposed mark. The owner of the earlier mark is therefore entitled to rely on the mark as registered for the purposes of this opposition. Indeed, if I am right so far, the recent adaption of the registered mark is likely to have been an attempt by its owner to reduce the level of public confusion caused by its continued

infringement by the partnership. That is a very unattractive reason to refuse to protect the mark as registered.

87. I find that there is a likelihood of confusion with the earlier mark and the opposition under s.5(2)(b) therefore succeeds.

88. In the circumstances, there is no need to consider the further ground of opposition that the partnership's application was made in bad faith.

Costs

89. The opposition having succeeded and the application for revocation having failed, Heidi Manton is entitled to a contribution towards her costs. This will include the cost of any official fees paid for the opposition and a contribution towards the reasonable cost of the time spent on these proceedings, including travel costs. The Registrar usually operates on a published scale of costs. However, given that Heidi Manton is not professionally represented, that might produce a larger award than the amount actually expended. Consequently, I invite Heidi Manton to produce an estimate of her actual costs, including the number of hours that she and Mr Gubby spent on these proceedings broken down by category of activity, eg preparing evidence.

90. This should be filed within 21 days of the date of this decision and should be copied to the partnership's legal representative. I will allow 10 days from the date of receipt of that estimate for the partnership to provide written submissions. I will then issue a supplementary decision covering the costs of these proceedings.

Dated this 18 day of August 2011

**Allan James
For the Registrar**