

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2017743
BY MARY WILSON ENTERPRISES INC TO REGISTER THE MARK
THE SUPREMES IN CLASSES 9, 16, 25 AND 41**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 46997
BY LYNDLA LAURENCE AND SCHERRIE PAYNE**

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**IN THE MATTER of Opposition thereto under No 46997
by Lynda Laurence and Scherrie Payne**

DECISION

1. On 12 April 1995 Mary Wilson Enterprises, Inc. applied to register the mark THE SUPREMES for the following goods and services:

"Class 09:

Sound recordings in the form of phonograph records, discs and tapes; video recordings in the form of discs and tapes; discs and tapes, all for recording sound and/or vision; cassettes and cartridges all for use with or containing video and sound recordings; cinematographic films; television films and programmes; sound and/or visual reproducing, amplifying, recording and transmitting apparatus and instruments.

Class 16:

Printed matter; printed publications; books, magazines and periodical publications; photographs; posters, stationery; album covers; decalcomanias; stickers; sheet music; display cards, printed advertising material; playing cards.

Class 25;

Articles of clothing; headgear.

Class 41:

Musical entertainment services; concert performances; music publishing; production of records, sound recordings and videos; rental of cine-films; discotheque services; presentation of live performances; production of radio and television programmes and of shows; radio and television entertainment; audio and video recording studio services; rental of sound recordings and of stadium facilities; information and advisory services relating thereto."

2. The application is numbered 2017743.

3. On 11 June 1997 Lynda Laurence and Scherrie Payne (jointly) filed notice of opposition to this application. They say that they have been performing as The Supremes since the group was reformed in 1986. On the other hand it is said that Mary Wilson, whose company has applied for the mark, was a member of the original line up of The Supremes but left to pursue a solo career in 1977. The opponents say they have toured extensively throughout the UK as The Supremes and released seven albums under that name. As a result of all this they say that objection arises:

- (i) under Section 5(4)(a). Somewhat confusingly the objection is framed in terms which appear to reflect the wording of Section 11 of the preceding law. However I take it the intention is to say that the mark should not be registered because its use would be liable to be prevented by the law of passing off.
- (ii) under Section 3(6) in that it is said Mary Wilson chose to leave The Supremes in 1977 and stated publicly that the group would continue without her. It is claimed that she has not used the name herself and has no intention of doing so. The name does not, therefore, belong to her and has been applied for in bad faith.

There is also a request that I should exercise the Registrar's discretion in the opponent's favour. There is no such general discretion available to me under the current law. The point was in any case not pursued at the hearing.

- 4. The applicant filed a counterstatement. She says that she is an original founding member of The Supremes and denies the opponents claims (I will treat the applicant as being Mary Wilson though strictly it is her company.) It is said that the applicant has made extensive use of the trade mark THE SUPREMES in the UK.
- 5. Both sides ask for an award of costs in their favour.
- 6. Both sides filed evidence. The matter came to be heard on 5 March 2001 when the applicant was represented by Mr R Miller of Her Majesty's Counsel instructed by Castles and the opponents by Mr D Turner of Beresford & Co.
- 7. A not inconsiderable amount of evidence has been filed by each side. In the opponents' case there are two statutory declarations by Steven Weaver, their UK record producer. He also describes himself as an ardent collector of musical productions under the name 'The Supremes' and set up their UK fan club. There is also a statutory declaration from Lynda Lawrence, one of the joint opponents.
- 8. The applicant is a US corporation owned by Mary Wilson. Mary Wilson herself has filed two declarations.
- 9. Both sides have set out the history of The Supremes in some detail. There is a large measure of common ground as one might expect but some disagreement over detail and motives for particular actions. It will suffice initially to set out the background in general and, I hope, largely uncontroversial terms.

10. In fact the group which was to become known as The Supremes did not start life with that name. A group called The Primettes was formed in 1959 including Diana Ross, Mary Wilson, Florence Ballard and Betty McClung (or McGlown). In discussions with Motown in 1960 it became clear that the record company did not like that name and instead The Supremes was chosen. Mary Wilson herself attributes the choice of name to Florence Ballard. A recording contract with Motown was eventually signed in 1961 by the above members (minus it seems Betty McClung). Many of the songs for which the original group was probably best known date from the period 1964 to 1967.
11. As is often the case with popular music groups the line-up is rarely static over any length of time and so it was with The Supremes. The first change took place in 1967 when Florence Ballard left the group due to ill health and was replaced by Cindy Birdsong. The other significant change which occurred at this time was the renaming of the group as Diana Ross and The Supremes.
12. Up until this time neither of the opponents was involved in the group. Lynda Lawrence was the first to join. The precise date is variously said to be 1971 (Exhibit SW/1 to Mr Weaver's declaration) and 1972 (paragraph 14 of Mary Wilson's declaration). Nothing in my view turns on the apparent discrepancy. Her initial stay appears to have been a relatively brief one and she left sometime in 1973. Scherrie Payne, the other opponent, joined in 1974. A number of other changes of personnel took place between 1973 and 1977 with Cindy Birdsong rejoining the group after a short absence and Susaye Green becoming another new member. Mary Wilson remained throughout this initial period (that is 1961 to 1977).
13. The year 1977 marked a turning point. The group was disbanded at that point. There is a reference in Mary Wilson's evidence to a Motown reunion anniversary performance in 1983 which was a revival of the 1967-70 line-up but effectively The Supremes ceased to exist as an active group during the period 1977 to 1985.
14. In 1985 Scherrie Payne was approached by a new record company (Superstar International) to reform The Supremes. She in turn is said to have contacted Lynda Lawrence and Jean Terrell. Collectively they started to record and perform together as former ladies of The Supremes though it seems that the 'former ladies of' was soon either dropped or given considerably less prominence. Mary Wilson appeared with the opponents at an event in 1987 though each side puts its own spin on the circumstances and motives.
15. Scherrie Payne and Lynda Lawrence have continued to perform as The Supremes from 1985 to at least the material date in these proceedings (12 April 1995) and beyond. The third member of the group has changed during that period. It is said that there have been some 10 albums released in the period from 1986 (Exhibit SW10) and an active programme of tours, television appearances etc. (Exhibit SW5).
16. At this point I should turn to Mary Wilson's activities. It will be remembered that she was a founding member of the group and the only person who was with the group throughout the period 1960 to its disbandment in 1977.

17. Mr Weaver, for the opponents, suggests by reference particularly to comments made on a soundtrack cassette (SW/3) of Mary Wilson's final show that she acknowledged that the other members of the group at that time (Scherrie Payne and Susaye Green) would be continuing as The Supremes. Much later in an interview published in a music magazine Mr Weaver notes that Ms Wilson says "I myself have no intention to form any groups of Supremes". That quotation is a selective one so I should also record the next sentences "I am still the only member who has any rights to use the name. So if they [later members of the group] continue to do those kind of things [use the Supremes name] they will be sued." Those quotations are said to come from a 1996 magazine so it will be apparent that this is a long standing dispute.
18. Mary Wilson gives evidence about her own role and activities in the period since the disbandment of the original group in 1977. The following claims are made in her evidence:
- her final contract with Motown was in April 1974. After that the record company is said to have lost interest in promoting the group and Mary Wilson herself 'took over and managed and controlled performance of The Supremes'. She says she managed the group (para 12 of her first declaration)
 - from 1974 to 1997 she has performed approximately 6000 times as The Supremes including tours in England (paragraph 17). These tours were independent of Motown.
 - the opponents were employees of her corporation (paragraph 14). A copy of an employment contract between The Supremes Incorporated and Scherrie Payne is exhibited (MW10)
 - it is conceded that she made a brief decision not to continue as the Supremes after the break up but later did reuse the name (paragraph 28)
 - she has continued to tour the UK with multi-date tours in 1981, 1982, 1983, 1985 and 1987-1998 (paragraph 32 and Exhibit MW14)
 - she signed a contract with Motown Record Corporation granting her 50% of Motown's right and interest in the name The Supremes (paragraph 36 and Exhibit MW16)
19. The above is not intended to be a full summary of the evidence but is sufficient to explain the history of The Supremes and the positions adopted by the parties and the claims made. Unsurprisingly certain claims are disputed and different interpretations placed on events. Some of these, such as whether particular members of the group had lead singer status, do not seem to me to be material to the opposition. Other areas of disagreement bear more directly on these proceedings and will be dealt with as necessary during the course of my decision. Briefly the opponents claim that Mary Wilson's activities in the UK since 1977 have been under her own name and not that of The Supremes; that she assigned her entire interest and goodwill in the name The Supremes to Motown in 1974; that (in or about 1977) Motown Record Corporation obtained an injunction against her prohibiting her from using the name The Supremes; that contrary to her claim Ms Wilson did not take over management of the

group; that the opponents were at one time under contract to Motown Records but not Mary Wilson's corporation; and that the exhibited (MW10) employment contract between Supremes Incorporated and Scherrie Payne has no effect under UK law.

20. I will take the objection under Section 5(4)(a) first. The relevant part of the statute reads:

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

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

(b)

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

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

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

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

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

22. A point of law arises in this case as to the date at which the passing off issue must be tested.

Mr Miller put the matter as follows in his skeleton argument:

"So in order to succeed under s.5(4)(a) the Opponents must show that, as at the date of application (12th April 1995), they were entitled to prevent the use of the mark in the United Kingdom by the Applicant in relation to the goods and services for which it is proposed that the mark be registered by an action for passing off. It is submitted that the Opponents cannot possibly establish this. Under the law, the factual issues relevant to the cause of action of passing off must be tested not at the date of the Writ (or Claim Form as it is now called) but at the date when the alleged acts of passing off commenced (see *Cadbury Schweppes v Pub Squash* [1981] RPC 429 (PC) particularly Lord Scarman at p.494, lines 24-35; see also Wilberforce J. in *Norman Kark Publications v Odhams Press* [1962] RPC 163 at p.169, lines 33-39). This is an important rule. It has the effect of preventing a defendant from contending that, through his very acts that are alleged to amount to passing off, he has acquired a stronger reputation than the Claimant, or displaced the Claimant's reputation altogether, so as to defeat the Claimant's claim. Equally the rule prevents a Claimant who first used the mark in dispute *after* the defendant from succeeding in passing off against that defendant."

23. Thus, it is contended, I must have regard to the date of the commencement of the conduct complained of and the opponents' reputation must be tested at that date. It is suggested that that would put the relevant date at some time in the early 1970s probably about 1974 that being the time when Mary Wilson is said to have owned the mark and the company, The Supremes Inc, managed the group. In fact, if I understand Mr Miller correctly the precise date is not critical. It is simply the fact that it is before 1985/6 when the opponents started to perform again as The Supremes.

24. The potential difficulty inherent in applying the principles of the common law to an action which takes place within the overall context of the Trade Mark legislation is noted in the 13th edition of Kerly's Law of Trade Marks at 8-106:

"It is suggested that the issue must be determined as at the date of the application for the mark in issue. The question is whether or not use of the mark applied for is liable to be prevented as at that date. If, however, the mark the subject of the application is already in use then this may require consideration of the position at an earlier time too. The relevant date for proving reputation and goodwill in a claim for passing off is the date of commencement of the activities complained of."

25. The Act itself makes no mention of the date at which the matter must be considered. However Section 5(4)(a) is based on Article 4.4(b) of the Directive (89/104/EEC) which reads as follows:

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

(a)

- (b) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark;" (my emphasis)

26. It seems to me, therefore, that the conduct complained of is the notional and/or actual use of the applied for mark at the date of application for registration. An opponents' claim to goodwill must be assessed at that point. However if the applied for mark is also in use at that date then that use also needs to be taken into account in order to determine whether, for instance, an antecedent or concurrent right exists. To that extent I accept the proposition that the test may require consideration of the position at the earlier time too (the Kerly's point). I do not, however, accept Mr Miller's submission insofar as it would require me to determine the matter by reference to a time in this case which precedes the disbandment of the original group and a period (between 1977 and 1985) when either the name The Supremes had been abandoned or, if that is putting the matter too high, certainly there was little, if any, active use of the name.
27. However, even if I am wrong in relation to the application of the common law requirement to establish the date of the commencement of the activity complained of, I do not think it would assist the applicant. On the opponents' evidence they were approached in 1985 to reform The Supremes and it is from then that they claim to have built up their goodwill in the name. It must follow from that that they could not have had a cause for complaint in the early to mid 1970s either against Motown Records or The Supremes Inc depending on what view is taken as to who owned what rights at that time (and where).
28. Furthermore on the applicant's own claim Scherrie Payne was under contract of employment to The Supremes Inc from February 1974 (Lynda Lawrence had left the original group at or about that time). Paragraph 7 of the exhibited employment contract (MW10) required her to disclaim any ownership right to the name The Supremes. I will need to return to the employment contract in due course but for present purposes it seems to me that the applicant cannot on the one hand point to the employment contract as evidence that at that time Scherrie Payne had no rights in the name and yet on the other suggest that a cause for complaint must have existed at that time and the opponents need to show that they would have succeeded in a passing off action at that time (a time which pre-dates the disbandment of the original group).
29. The plain fact is that The Supremes ceased to exist as an active group between 1977 and 1985 and Mary Wilson made no attempt to capitalise on any existing goodwill in the name. It is on their use since 1985 that the opponents base their case. If an issue arose in relation to the date of commencement of the activity complained of it would, in my view, have to be in the period from 1985 to 1995 (the application date being 12 April 1995). But the applicant's case is not put on that basis. Moreover for reasons which I will deal with later in the decision I do not think it was open to the applicant to do so as Mary Wilson was pursuing a solo career in that period and not appearing as The Supremes. In Wadlow's 'The Law of Passing off' it is said at

7.18 that "..... it is not legitimate for the defendant to commence an abandoned business under a name or mark which has meanwhile become distinctive of the plaintiff." This action does not involve issues to do with continuing activity by Mary Wilson under the name but rather the potential resumption of previously discontinued or abandoned use by means of the application in suit. The date of application is, therefore, the relevant date for the purpose of determining the opponents' claim.

30. Before going on to consider the opponents' use I must return to the position in the mid 1970s because it is part of the applicants' case that The Supremes Inc managed the group's affairs and that Scherrie Payne was bound by the terms of an employment contract with that company. It is suggested that the employment contract has continuing effect.

31. The agreement in question was entered into on 1 February 1974. The term is said to be one year from that date (Clause 2). A subsequent supplemental agreement entered into on 19 December 1974 extends the agreement for a further one year from 1 February 1975 (with options for four further one year extensions). The agreement provides (Clause 10) for earlier termination in certain circumstances including, I note, if The Supremes do not engage in any professional income producing activities for any two month period or if serious questions are raised over rights to use of the name (10(a) and (c)). The territorial extent of the agreement and issues to do with enforcement outside the US are not clear though Mr Miller noted that Clause 5 required Scherrie Payne to maintain a valid passport in case her services were required in any location outside the United States.

32. He also placed particular reliance on Clause 7 which includes the following:

"Employee hereby acknowledges that she does not presently have, and will not acquire, any ownership or other right or interest in and to the group name "The Supremes" prior to, during or following the term hereof, and that Employee shall only utilize the name "The Supremes" in the precise manner and form approved by representatives of Company. If Employee, at any time during or following the term of this agreement, and for any reason whatsoever, is no longer performing as a member of The Supremes or working for Company, Employee shall have no further right to utilize or exploit the name "The Supremes" or to make reference to herself as a member of "The Supremes"."

33. On the basis of the above (particularly the references to "following the term of this agreement") it is suggested that use of the name The Supremes is controlled beyond the term of the agreement itself and accordingly any goodwill arising from the opponents' use (or at least Scherrie Payne) accrues to the benefit of The Supremes Inc (now Mary Wilson Enterprises, Inc).

34. In his second declaration Mr Weaver counters that the agreement relates only to the United States and that he is advised that under English law "the restrictive covenant referred to by Mary Wilson would be unenforceable especially today". I have not had evidence or submissions in support of that claim but I do have a number of problems with the agreement and the surrounding circumstances:

- issues to do with jurisdiction and enforcement are not clearly dealt with
- Clause 7 appears to be based on the presumption of ownership of rights in The Supremes by the company but
- a later letter (dated 22 April 1974) at MW16 signed by Mary Wilson and Motown Records acknowledges that:

"Motown shall have the exclusive right to secure in its name such statutory, common law or other protection of the name "The Supremes" as is now known or may hereafter be devised, including but not limited to trade name, trademark or service mark protection, and you warrant and represent that in the event you have previously applied for or obtained such protection, you will assign to Motown all right and interest thereof. You acknowledge and agree that you shall have no right to exploit the name "The Supremes" in any manner except as set forth in the Agreement, and except as used by you for performances while you are a party to an exclusive recording artist agreement with Motown as a member of "The Supremes" and are recording with said Group."

- in Mary Wilson's favour it might be said that this agreement with Motown may only have applied in the US but if Motown acknowledged Mary Wilson or The Supremes Inc's rights elsewhere it is not expressly stated
- both the employment agreement and the agreement between Mary Wilson and Motown pre-date the disbandment of the group. I would struggle to accept that the employment agreement could be held to apply in perpetuity notwithstanding that The Supremes ceased to perform between 1977 and the commencement of activities by the opponents in 1985/6. That is a different matter to an agreement designed to protect the interests of the remaining members of an active group in the event of the departure of one of the members.

35. In short I find it difficult to reconcile the terms of the employment agreement with the subsequent agreement dealing with ownership of the mark. I am left with the view that in the US at least Motown rather than Mary Wilson had the best claim to the mark. The opponents' evidence claims to show that Mary Wilson did in fact assign her entire interest and goodwill in the name The Supremes to Motown in 1974. The exhibit (SW8) which purports to show this is by no means clear on what mark was transferred and cannot be relied on. However there is collateral evidence in the applicant's Exhibit MW21 to support the view that in the US at least Motown own the name (see Mary Wilson's interview with People dated 4 May 1999). Making the best I can of what I regard as incomplete and conflicting evidence I have come to the view that it is unlikely that the employment agreement had any continuing or relevant effect and was in any case in conflict with the agreement with Motown so far as ownership of the name was concerned. There are other reasons, such as the operation of Clause 10, which point to the agreement being defunct. Further as Mr Turner pointed out there is no evidence

that Lynda Lawrence was ever bound by an employment agreement with The Supremes Inc (although it is suggested elsewhere in the evidence she was at one time under contract to Motown). I, therefore, approach the matter on the basis that any goodwill generated in the UK since 1985 accrues to the opponents and not The Supremes Inc/Mary Wilson Enterprises Inc.

36. The opponents' evidence in support of their case comes mainly from Mr Weaver. His evidence came in for some criticism at the hearing. Firstly it is said that Mr Weaver was not directly involved in many of the matters dealt with in the parties' evidence particularly events in the 1970s. Secondly he has been the opponents' record producer since 1993 (and ran their fan club from 1985 onwards). Hence it is said he has a particular interest in ensuring that the opponents continue to be able to operate as The Supremes - the attractive power of the group name being greater than that of the individuals. There may be some limited justification for these criticisms but it does not in my view disqualify him from giving evidence. His evidence like anyone else's requires substantiation and is open to challenge if the applicant considers that he is misrepresenting matters in any way.

37. The evidence on the opponents' activities in the period 1985 to 1995 takes the following main forms:

- details of concert tours
- information on the releases of singles and albums
- publicity material of various kinds
- fan club material
- newspaper/magazine reports of events and activities.

38. Paragraph 7 of Mr Weaver's second declaration records that:-

"7. The group formed by Lynda Lawrence and Scherrie Payne (hereinafter called "the New Group") made their first recording in the United Kingdom entitled "We're Back" in 1986. Since then at least 10 albums by the New Group have been published in the United Kingdom. There is now produced and shown to me marked Exhibit SW10 a list of singles and albums, and the dates of their release, all produced by the New Group. For further details of the opponents' activities, see Exhibit SW/5 to my First Declaration. There is further produced and shown to me marked Exhibit SW11 a sample single entitled "Stoned Love - The Remixes" and an album entitled "The Supremes - Reflections Hitlist". These appear as items (15) and (13) respectively in Exhibit SW10. The Opponents' activities included television appearances and tours in the United Kingdom. In 1991 the New Group appeared in a tour entitled "Legends of Motor City" which had 30 appearances throughout the United Kingdom, including Birmingham, Manchester and the Dominion Theatre, London. In 1992 the New Group appeared under the name "The Supremes" in a U.K. tour which included "The Four Tops" and "The Temptations". This tour was almost the same as the one which

took place in 1996 under the title "Giants of Motown" and which is referred to in paragraph 8 below. The 1992 tour was similar in that there were performances at the same or similar locations as those which made up the 1996 tour. In 1993, the New Group were part of another U.K. tour which made fifteen appearances throughout the United Kingdom. That tour included the group called "The Commodores" and appearances included Wolverhampton, Manchester and London."

39. Exhibit SW/5 to Mr Weaver's first declaration gives further information on the opponents' tours and record releases. Some of the material is after the relevant date and must be discounted for present purposes. Other items are undated but it is often possible to attribute a date (sufficient to place the material in the relevant time frame) by reference to known membership of the group at the particular time.
40. The promotional material that is exhibited confirms that there has been a regular programme of multi-date tours in the UK by the opponents in company with Jean Terrell or Sundray Tucker performing collectively as The Supremes. There have also been regular record releases between 1986 and 1995 (SW/6 and SW/10). One of these albums attracted particular criticism in that it featured a photograph of the original group on the cover but with the opponents singing. I have a great deal of sympathy with the applicant's criticism of this which on the face of it appears highly questionable behaviour. However I do not think this is typical. So far as I can tell from the album covers exhibited in SW/6 there is generally no misrepresentation in any photographic material as to who was involved from 1986 onwards.
41. There were other criticisms of the evidence in terms of the nature and level of substantiation. It is true that no information is given on, for instance, numbers attending the UK concerts, revenue receipts/fees earned by the opponents or record/CD etc sales. However I do not think the applicant seriously disputes that the concert tours took place or that records were released. It is precisely the sort of activity that one would expect from a group. It is also very public activity that is, therefore, open to challenge if the applicant had any doubts about the claims made. Indeed the fact that tours and record releases were regular annual occurrences is in itself confirmation of the continuing attractive power of the group. Taken as a whole I am satisfied the evidence establishes that goodwill was built up in the period 1985 to 1995 and hence by the material date.
42. Even so the applicant's claim is that the use shown does not prove that the new group had established a meaningful reputation of its own or displaced the reputation of the original group. I reject that submission along with the suggestion that the opponents were 'taking advantage of their own wrong'. It will be remembered that The Supremes had begun performing in or about 1960 and had gone through a number of changes of personnel between that time and the group's disbandment in 1977. There followed a lengthy break when the name The Supremes ceased to be in the public eye (save perhaps for any residual album sales). When the 'new group' was formed in 1985 I do not think it would have been lightly assumed that this was simply a revival of the old group. No doubt the more ardent fans of that type of music would have known who was in the old group and who was in the new. The wider public would initially have had no particular expectations given that almost a decade had passed without any public activity under the name The Supremes beyond the one-off reunion concert in 1983 (which would have been recognised for what it was). The public is however

well aware that the membership of groups changes over time. Perhaps, after a lengthy absence, the public needed to be reacquainted with The Supremes name and may initially have had cause to wonder as to membership of the group. But any such doubts would have been dispelled over the ensuing years with the result that the name had by 1995 come to be associated with the opponents and the goodwill of the underlying business accrued to them.

43. Having reached the above view on the issue of goodwill I can deal fairly shortly with the other two legs of the test, that is misrepresentation and damage. The mark sought to be registered is, of course, identical to that used by the opponents. The goods and services are also substantially the same. I say substantially the same because the specification put forward for the applied for mark covers more than just musical performances and records, CDs etc. Nevertheless to the extent that the specification goes beyond such items the goods and services concerned are ones that would be closely associated with, or with the promotion of, the activities of a music group. No representations were made at the hearing that the application should or could proceed for a more limited specification if the opponents were successful in their attack.
44. Over the decade leading up to the application filing date the UK public has come to associate the name The Supremes with the opponents and would in my view be misled if the applicant now entered the field under that name (though I do not mean to thereby imply that Mary Wilson is not entitled to describe herself by reference to her association with the original group). It follows that use of the applied for mark would constitute a misrepresentation by the applicant.
45. Turning to the matter of damage Jacob J said in *Mecklermedia Corporation v D.C. Congress Gesellschaft mbH*, 1997 FSR 627:

"Now in some cases one does indeed need separate proof of damage. This is particularly so, for example, if the fields of activity of the parties are wildly different (*e.g. Stringfellow v. McCain Foods (G.B.) Ltd* [1984] R.P.C. 501, CA, nightclub and chips). But in other cases the court is entitled to infer damage, including particularly damage by way of dilution of the plaintiff's goodwill."

46. The fields of activity here are for practical purposes identical. I consider that I am entitled to infer that damage will occur particularly as a result of potential diversion of trade.
47. Before leaving the passing off issue I should comment briefly on the applicant's claimed use. In her first declaration Mary Wilson says that she has 'continuously used the name The Supremes in relation to UK recordings and tours' since the break-up of the old group in 1977. In particular it is said:

"From 1974 to 1997 I have performed approximately 6,000 times as **THE SUPREMES** including tours in England. All these tours have been carried out independently of Motown. The shows have been advertised as **THE SUPREMES**, **THE SUPREMES SHOW**, **MARY WILSON OF THE SUPREMES** or **MARY WILSON AND THE SUPREMES**. There is now produced and shown to me marked "MW 11" copies of news letters of **THE SUPREMES' MARY WILSON** fan club

which bear my likeness and which detail **THE SUPREMES** performances and related activities throughout the 80's which include many visits to the UK."

and

"I have also continued to tour the UK including multi date tours in 1981, 1982, 1983, 1985, 1987-1998. There is now produced and shown to me marked "MW 14" a selection of material evidencing these UK tours."

48. These are significant claims. On the basis of the evidence before me they are also somewhat misleading claims insofar as they relate to the period after 1977. Although reference is made to tours under names incorporating a reference to The Supremes there is simply no substantiation by way of programmes, advertisements for the concerts, tour details etc. Exhibit MW11 is relied on but this consists of fan club newsletters. As one might expect it contains reference to Mary Wilson's former involvement with The Supremes but it does not establish continuing activity in the UK under that name. It is, however, wholly consistent with her pursuing a solo career under her own name. Exhibit MW14 which is relied on as evidencing particular UK tours singularly fails to demonstrate that any of those tours took place under the name The Supremes. The Exhibit consists of faxed messages after the relevant date dealing with tour itineraries and press interviews for Mary Wilson. I can see no reference to The Supremes.
49. The applicant's evidence fails to substantiate the claims made. Mr Miller did his best with this material on the basis that Mary Wilson herself had given the evidence and her claims cannot be dismissed as mere assertion. I am not convinced. The most that I would take from the evidence is that Mary Wilson may on occasions draw on her previous involvement with the group by referring to herself as The Supremes' Mary Wilson or the like. But that is no more than using her past association with the group as a means of establishing her credentials in a solo career. On the evidence she was not performing as The Supremes. It follows that no claim to concurrent use arises and the action under Section 5(4)(a) succeeds.
50. I turn now to the objection under Section 3(6) which provides that "a trade mark shall not be registered if or to the extent that the application is made in bad faith". The opponents' objection is put in the following terms:
- "Mary Wilson chose to leave The Supremes in 1977 and stated publicly that the group would continue without her. Mary Wilson has not used the name herself. Neither does she appear to have any intention of using the name herself. She has only toured in the United Kingdom once in the last seven years. Therefore the name the subject of the application does not belong to the applicant. We submit that application number 2017743 was made in bad faith and accordingly should be refused under the provisions of Section 3(6) of the Trade Marks Act 1994."
51. It will be apparent that this encompasses two quite separate objections, one relating to ownership of the mark and the other bearing on lack of a bona fide intention to use the mark.

52. Mr Miller took issue with the ownership objection on the basis that the inference to be drawn was that Mary Wilson's claim was to be tested against the opponents' competing one whereas at the hearing (and in Mr Turner's skeleton argument) Motown Record Corporation's position was also relied on.
53. I do not consider that I need to deal with Motown's position in relation to this aspect of the case. Motown are not a party to this opposition; their involvement seems to relate mainly to the position up to the mid 1970s; and arguably such claim as they might have relates to the US or at least does not clearly extend to the UK. What follows, therefore, deals only with the competing claims of the parties to this action in relation to bad faith in the matter of ownership.
54. The reference in the extract from the opponents' statement of grounds to Mary Wilson's public statement in 1977 is evidenced by a soundtrack cassette of her final show at which she stated "... so I do hope you will give all your support, all the wonderful love you have given to The Supremes all these years, to both Scherrie [Payne] and Susaye [Greene] in their endeavour because they will be going on as The Supremes and I will be" followed by applause and some indistinct words. Mary Wilson responds to this by saying that she did make a brief decision not to continue as The Supremes but a few months later did re-use the name. Although the re-use is not evidenced I would be reluctant to place too much reliance on the statement attributed to Mary Wilson. Comments may well be made at an emotionally charged event such as a final show which on mature reflection are regretted with the result that a different course is followed.
55. By the same token Mary Wilson's own assertion of a right to use the name (contained in the interview in Blues and Soul magazine at SW/4) must also be treated with caution. Asserting a right is one thing substantiating such a claim is a different matter. The most that can be said is that it may indicate what Mary Wilson believed to be the case.
56. I have found on the basis of the evidence that in the period leading up to the filing date the opponents had been active under the name The Supremes and that Mary Wilson was not using the name save perhaps to the limited extent that in her solo career she may have referred to her past association with the original group. But finding that a party has a superior right for Section 5(4)(a) purposes does not in itself mean that the application was made in bad faith.
57. Lindsay J considered the scope of bad faith in *Gromax Plastics Ltd v Don & Low Nonwovens Ltd*, 1999 RPC 367, as follows:
- "I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances."

58. A number of the cases referred to in the 13th edition of Kerly's at 7.203 et seq turn on the question of whether the applicant was aware that his action in filing an application was likely to be in conflict with the rights of another party. Such cases often turn on previous business relationships between the parties but that is not invariably the case. It will be useful to consider Mary Wilson's position in these proceedings in those terms. I find that:
- she would have been fully aware that following the disbandment of the original group in 1977 there had been no activity under or using the name
 - she was aware that the opponents had commenced performing again under the name. This awareness must have existed at least from 1987 because she says in paragraph 24 of her first declaration that she "performed with the opponents at The Wiltshire Ebell in 1987. I attended the show because I was aggrieved at the opponents use of the name **THE SUPREMES**. The opponents invited me on stage and due to the attendance of many of my fans in the audience I did go up on stage because if I had refused in front of my fans it would have seemed churlish, but this was not to be seen as an endorsement of the opponents activities"
 - it is highly unlikely that she would have been unaware of the opponents' regular tour, performances and record releases in the UK in the years leading up to the filing date of her application
 - there is evidence in, for instance, MW21, (her own evidence) that she recognised that in the US at least that she did not own the rights (see the extract from People dated 4 May 1999) and that she faced difficulties in Europe.
59. I think it is reasonable to infer from this that when the application was filed on 12 April 1995 it was done in the knowledge that the opponents had been performing under the name The Supremes for almost ten years. Furthermore, of course, no action had been taken against them during that period.
60. It may be that Ms Wilson feels genuinely aggrieved that, having been a founder member of the original group and a continuing member right through the period from 1960 to the group's disbandment in 1977, she has some claim to the name. She may think there is nothing wrong in her action in applying to register the mark. But the fact of the matter is that the old Supremes business was discontinued and the opponents have since been performing under that name for a considerable time.
61. The test for bad faith is (as it is for dishonesty) an objective one. The Hearing Officer in Application No 9914 for the invalidation of the trade mark AUTONET (0-257-00), dated 26 July 2000 said:
- "[Counsel] accepted that the test could include an objective element, but in his submission, it is primarily a subjective test. Clearly, if the applicant can be shown to have known he was acting dishonestly a finding of bad faith is likely to follow. But

there will be other cases where, on the basis of his own state of knowledge, values and standards, an applicant believes he is acting in good faith when most reasonable persons would disagree. It cannot be right for the matter to depend upon the morals and values of the applicant. The test must therefore include an objective assessment of the actions of the applicant in the light of the facts he or she was aware of at the time."

In *Demon Ale Trade Mark* 2000 RPC 345 the Appointed Person stated:

"I do not think that section 3(6) requires applicants to submit to an open-ended assessment of their commercial morality. However, the observations of Lord Nicholls on the subject of dishonesty in *Royal Brunei Airlines Sdn Bhd v Philip Tan* [1995]2 AC 378 (PC) at page 389 do seem to me to provide strong support for the view that a finding of bad faith may be fully justified even in a case where the applicant sees nothing wrong in his own behaviour."

62. I do not know what prompted Mary Wilson Enterprises, Inc to apply for the trade mark in 1995 but in my view the application was made in the knowledge of the opponents' activities. Not without hesitation I have come to the view that the actions of Enterprises in applying for the mark fall short of the standards of acceptable commercial behaviour that should have been observed. The opposition also succeeds in this respect.
63. It is strictly not necessary for me to consider the further ground under Section 3(6) relating to lack of intention to use the mark applied for. However I will offer a few observations in case the matter goes to appeal. Mr Miller's answer to this objection was to point to the actual use claimed by Mary Wilson in her evidence. In the light of my above views on that claimed use this defence falls away. A further difficulty for the applicant is Mary Wilson's remarks reported in *Blues and Soul* magazine to the effect that "While I myself have no intention to form any more groups of Supremes". The precise date of the interview is not given but the magazine is said to be the edition of 6-19 February 1996. Mary Wilson's attention was drawn to this article and she specifically responds to it in paragraph 29 of her first declaration claiming that she still has rights to the name. She does not deny or comment on her (publicly reported) absence of intention to form any group under the name. Even so this is perhaps too narrow a basis for a finding under Section 3(6). An interview at a later date is not conclusive as to intentions at the time the application was filed though one might have expected some explanation as to the circumstances surrounding events and intentions at the relevant time.
64. A person's intention at any particular point in time are notoriously difficult to determine particularly several years afterwards. It may be that Mary Wilson saw the prospect of obtaining a UK trade mark registration as a mechanism for addressing her sense of grievance at seeing others performing under The Supremes name. But in the absence of actual use or a bona fide intention to use that would not assist her. I, therefore, find the applicant's position to be somewhat unconvincing but as there has been no cross examination I do not propose to reach a formal view on the matter.

65. As the opponents have been successful they are entitled to a contribution towards their costs. My attention was drawn to a number of interlocutory hearings that took place during the course of the proceedings and submissions were made as to what the consequences should be in terms of the overall costs award. Having reviewed the after-hearing correspondence I think it is fair to say that both sides can claim a measure of success as a result of those hearings. Given the complexities of the case I am disinclined to favour or penalise either side in costs terms as a result of the interlocutory issues that arose. However in the light of the amount of evidence filed and the amount of preparation the case no doubt entailed I propose to make an award above the minimum of the scale. I order the applicant to pay the opponents the sum of £1200. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2 day of April 2001

**M REYNOLDS
For the Registrar
The Comptroller-General**