

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 46997

BY LYNDA LAURENCE AND SCHERRIE PAYNE

TO APPLICATION No. 2017743

TO REGISTER A TRADE MARK IN CLASS 41

IN THE NAME OF MARY WILSON ENTERPRISES INC.

DECISION

Introduction

1. This is an appeal from the refusal of the Registrar of Trade Marks to register THE SUPREMES as a trade mark pursuant to an application filed by Mary Wilson Enterprises Inc. Registration was refused under Sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 in the context of opposition proceedings brought by Lynda Laurence and Scherrie Payne.

The application

2. Mary Wilson Enterprises Inc. applied on 12th April 1995 to register THE SUPREMES as a trade mark for use in relation to the following goods and services:

Class 9:

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.

The recent amendment

3. On 30th April 2002 the applicant applied to amend its application by confining the specification to ***“musical entertainment services; concert performances; presentation of live performances”*** in Class 41. In the relevant

Form TM 21 it was stated that the applicant wished to amend the specification of its application “*due to opposition proceedings*”. This was a reference to the present opposition proceedings, then pending before me on appeal.

The opposition

4. Lynda Laurence and Scherrie Payne opposed and continue to oppose the application for registration on the basis stated in their Grounds of Opposition filed on 11th June 1997.

5. Their case was set out in paragraphs 1 to 7 of the Grounds of Opposition in the following terms:

1. Both Opponents, Lynda Laurence and Scherrie Payne, have been performing as The Supremes since the group was reformed in 1986. Lynda Laurence sang with The Supremes from 1971 to 1973. Scherrie Payne was recruited as lead singer in 1973 and sang with The Supremes until 1977.

2. The owner of the applicant, Mary Wilson, was a member of the original line up of The Supremes but left to pursue a solo career in 1977. She was never the lead singer of The Supremes. Mary Wilson was approached in 1995 (sic) to consider working with the group but declined.

3. The only country where “THE SUPREMES” is registered as a trade mark is in the United States. This registration is owned by Motown.

4. The Opponents have toured extensively throughout the United Kingdom as The Supremes. They have also released seven albums under this name.

5. Mary Wilson’s solo show is not a “Supremes” show. The majority of her act is based on non-

Supremes material. She has constantly stated that she has no intention of reforming The Supremes.

6. By reason of the Opponents extensive use of the name "THE SUPREMES" they have acquired a substantial reputation in the name. Accordingly, use by the applicant of the name would be likely to deceive or cause confusion and so be disentitled to protection in a Court of Justice. Registration of application number 2017743 should therefore be refused under the provision of Section 5(4)(a) of the Trade Marks Act 1994.

7. 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.

6. Mary Wilson Enterprises Inc. responded to these contentions in paragraphs

1 to 5 of its Counter Statement filed on 2nd October 1997:

1. Mary Wilson is an original founding member of The Supremes music group and therefore the Applicants are the rightful proprietors of the trade mark THE SUPREMES and will prove this in evidence. The Applicants contend that the opponents have no rights in the trade mark THE SUPREMES and put the opponents to strict proof of the claims made in paragraphs 1 and 2 of the Notice of Opposition.

2. The Applicants deny that the United States is the only country where THE SUPREMES is registered as a trade mark and put the opponents to strict proof of this claim. The Applicants acknowledge that the US registration is currently in

the name of Motown Record Company LP, having originally been filed in the name of Mary Wilson.

3. The Applicants deny the claims made in paragraphs 4 and 5 of the Notice of Opposition and put the opponents to strict proof of the claims made.

4. The Applicants deny the claims made in paragraph 6 of the Notice of Opposition and put the opponents to strict proof of the claims made.

5. The Applicants deny the statements made in point 7 of the Notice of Opposition. The Applicants have made extensive use of the trade mark THE SUPREMES in the UK which will be proved in evidence. The opponents are put to strict proof of the claims made in point 7.

7. It can be seen that the dispute between the parties centres on the question whether Mary Wilson Enterprises Inc. was entitled on 12th April 1995 to register itself as proprietor of the right to prevent others (especially the opponents) from using the designation THE SUPREMES to distinguish the trade origin of goods and services of the kind specified. It is important to appreciate that in 1995 those words had long been known and recognised in the United Kingdom as a means of identifying performances delivered by various recording artists who had performed together as THE SUPREMES between 1961 and 1977. Both sides claimed that they had, and the other did not have, the right to determine whose performances in addition to those delivered between 1961 and 1977 could be presented to the public in the United Kingdom as performances of THE SUPREMES. It seems to me that live and recorded performances presented to the public as performances of THE SUPREMES have at all material times been likely to be linked in the perceptions and recollections of the average consumer to a

degree which makes it commercially unrealistic to differentiate between the two modes of delivery. I propose to deal with the rival claims to proprietorship on that basis.

The evidence on file

8. The evidence in support of the opposition consisted of a first Statutory Declaration of Steven Weaver with 8 exhibits dated 29th December 1997; a second Statutory Declaration of Steven Weaver with 8 exhibits dated 14th May 1998; and a Statutory Declaration of Lynda Laurence dated 23rd July 1999.

9. The evidence in support of the application for registration consisted of a first Statutory Declaration of Mary Wilson with 19 exhibits dated 4th September 1998 and a second Statutory Declaration of Mary Wilson with 8 exhibits dated 5th April 2000.

10. I took the view that the evidence adduced by the applicant required clarification in 3 respects which appeared to be materially important to the determination of the case presented for consideration on appeal. I therefore requested further information in relation to those matters under Rule 57 in tandem with Rule 65(2) of the Trade Marks Rules 2000. The appeal was adjourned part-heard to allow time for the applicant to provide the requested clarification. Details of the matters to which the request was directed and of the steps taken by the applicant in response to the request are set out in the transcript of the decision I gave at the conclusion of a case management conference held on 26th February 2002.

11. The additional information admitted into the proceedings in response to my request under Rule 57 consisted of a Statutory Declaration of Emma Hodson with 5 exhibits dated 28th December 2001 and paragraphs 1 to 7 and 10 of a third Statutory Declaration of Mary Wilson dated 6th February 2002. Paragraphs 8, 9, 11 and 12 of the latter Declaration and a proposed additional exhibit (MW21) were not admitted for the reasons given in my decision at the conclusion of the case management conference on 26th February 2002.

The Motown connection

12. In January 1961 the members of a singing group not long previously named THE SUPREMES entered into recording contracts with Motown Record Corporation of Detroit. The singers and their successors who thereafter performed together as THE SUPREMES until 1977 were as follows:

FLORENCE BALLARD • DIANA ROSS • MARY WILSON

1961-1967

CINDY BIRDSONG • DIANA ROSS • MARY WILSON

1967-1970

CINDY BIRDSONG • JEAN TERRELL • MARY WILSON

1970-1971

LYNDA LAURENCE • JEAN TERRELL • MARY WILSON

1971-1973

CINDY BIRDSONG • SCHERRIE PAYNE • MARY WILSON

1973-1975

SUSAYE GREENE • SCHERRIE PAYNE • MARY WILSON

1975-1977

From 1967 to 1970 the group was promoted, at the behest of Motown, as DIANA ROSS AND THE SUPREMES. In 1970 Diana Ross left to pursue a solo career.

13. So far as I can tell, Mary Wilson's last performance as a member of the group was at the Theatre Royal, Drury Lane, London on 12th June 1977. I understand that although Motown had announced that the group would continue with Scherrie Payne, Susaye Greene and a new member, nothing came of that proposal and the group disbanded some months later. I see from Exhibit MW9 that Motown Record Corporation wrote to Mary Wilson on 21st October 1977 giving notice under the terms of a subsisting recording agreement that it required her to participate in "*the recording of new product involving the performances of you, Scherrie Payne and Susaye Greene together as the performing group known as The Supremes*". This seems to have been a last attempt by Motown to reconstitute the group. The attempt was not successful.

14. It appears that the singers who performed together as THE SUPREMES between 1961 and 1977 each had recording contracts with Motown Record Corporation. The terms of their contracts might well have indicated whether Motown reserved the right to determine who should be entitled to deliver performances under the name THE SUPREMES. However the only contractual documentation produced in that connection is in Exhibit MW2 and this contains nothing more than the first and last pages of a 14 page recording contract between Mary Wilson and Motown Record Corporation dated 15th January 1961.

15. Sales of Motown recordings of the various performers who had performed together as THE SUPREMES between 1961 and 1977 continued long after the group had disbanded. The fact that such recordings continue to be sold through mainstream retail outlets in the United Kingdom at the present day is a good indication of the strength of the goodwill which THE SUPREMES name continues to command by virtue of their past performances.

The relationship between the members of the group

16. Mary Wilson says that from 1973 she became the manager of the group and that The Supremes Inc. (which she describes as “*my corporation*”) subsequently obtained bookings for performances by THE SUPREMES. There is some evidence that The Supremes Inc. arranged public performances for THE SUPREMES during the period 1974 to 1976: Exhibit MW9. It is not clear who performed that function or acted as manager to the group prior to 1973.

17. Mary Wilson maintains that “*from June 1974 all individuals who performed as THE SUPREMES performed under my direction and under employment to myself or my corporation*”. Her reference to June 1974 indicates that she is there referring to Scherrie Payne, Cindy Birdsong and Susaye Greene.

18. Exhibit MW10 contains a copy of an employment agreement made between The Supremes Inc. and Scherrie Payne as of 1st February 1974 and a supplementary agreement dated 19th December 1974 which provided The Supremes Inc. with options to extend the period of the February employment agreement.

19. The February employment agreement recited that The Supremes Inc. was engaged in the business of presenting performing musical artists for appearance in various concerts, live stage productions, television shows and other personal appearances. It went on to recite that Scherrie Payne had demonstrated the desire and creative talent to perform as an active working member of THE SUPREMES and that The Supremes Inc. desired to engage her services to perform as an active member of the group. Clause 1 of the agreement confirmed that the engagement did not extend to *“performance in motion pictures, television series, dramatic roles in television or on stage or performance on records, tapes or other audio or audio-video devices.”* This exclusion would, at least in part, appear to have been required for the purpose of ensuring that there was no conflict between the employment agreement and Scherrie Payne’s recording artist contract with Motown Record Corporation.

20. The agreement provided for Scherrie Payne to be paid a specified sum per month plus 20% of the company’s net profits from her public performances as a member of THE SUPREMES.

21. Clause 7 of the agreement provided as follows:

Employee hereby grants to Company, and Company hereby accepts from Employee, the absolute ownership of all of the results and proceeds of Employee’s performances and services hereunder. Company shall have the further right to use and display Employee’s name, voice and likeness for the purpose of promoting and advertising The Supremes, any personal appearances in which Employee shall participate, and Company’s business. 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”.

22. Clause 10(c) gave each party the right to terminate the agreement with immediate effect if, during the term thereof:

“any person firm or entity shall raise a serious question over Company’s or The Supremes’ continued right to utilize the group name ‘The Supremes’ in any professional activities and such person, firm or entity is successful, by judicial process or otherwise, in preventing The Supremes from continuing to engage in the professional activities contemplated within this agreement”

It seems likely that this clause was included because Mary Wilson was at the time on a collision course with Motown Record Corporation in relation to ownership and control of the right to use the name THE SUPREMES (see paragraphs 27 to 29 below).

23. It is suggested on behalf of Scherrie Payne that her employment agreement with The Supremes Inc. related only to the United States of America. However, the agreement specifically contemplated that she might be required to perform as a member of the group in other countries of the world (see Clause 5) and I see no reason why the terms of the agreement should not have applied generally to

activities outside the United States. The matter might have been resolved by evidence as to the basis upon which Scherrie Payne was in fact remunerated for the public performances she gave outside the United States during the period 1974 to 1977. In the absence of any such evidence I think it should be assumed that the employment agreement was intended to operate without territorial limitation.

24. No employment agreements have been produced in support of the suggestion that Cindy Birdsong and Susaye Green were employed by Mary Wilson or The Supremes Inc.

25. According to Mary Wilson, the employment arrangements to which she refers operated "*from June 1974*". On that basis they would not have applied to any former members of the group, including Lynda Laurence who left in 1973. Mary Wilson nevertheless claims in paragraph 14 of her first Statutory Declaration that Lynda Laurence entered into an employment contract with The Supremes Inc. ("*my corporation*") and was until she left the group in 1973 only an employee "*with no rights to exclusive use of the group name*". No employment agreement was produced in support of that claim. Moreover, The Supremes Inc. was not incorporated until 15th January 1974. In paragraph 3 of her Statutory Declaration dated 23rd July 1999, Lynda Laurence specifically states that the claim made by Mary Wilson is not true. She goes on to say that:

"When I joined 'The Supremes' group, I signed a recording contract with Motown Records Corporation only. I have never signed with nor have I ever been a part of any other corporation ..."

In the circumstances, I am not prepared to accept that she was employed either by Mary Wilson or The Supremes Inc. to perform as a member of the group.

26. The evidence is silent as to the existence of any other contractual arrangements between or among the members of THE SUPREMES during the period 1961 to 1977. So far as I can see, no one could have become or remained a member of the group called THE SUPREMES during that period without having entered into a recording contract directly with Motown Record Corporation. It seems right to conclude that the relationship between the members of the group was essentially one of mutual endeavour directed to the fulfilment of a common desire for success as Motown recording artists under the name THE SUPREMES. The relationship appears to have been conducted at all stages upon the understanding that departure from the group would forthwith bring the commitments and benefits of membership to an end.

Motown's rights in relation to THE SUPREMES name

27. It appears from various documents produced in December 2001, in response to my request for information under Rule 57, that on 7th January 1974 Mary Wilson applied in her own name to register THE SUPREMES as a trade mark for use in the United States in relation to ***“performance of musical entertainment services by a vocal group including recording performances for phonograph records and tape recordings, performances at concerts, radio and television appearances, night club performances”***. The trade mark application was supported by a claim to first use in commerce in July 1962. Mary Wilson assigned it to Motown Record Corporation on 1st May 1974. She specifically

assigned “*all rights, title and interest in and to the said mark, together with the goodwill of the business symbolized by the mark*” (Exhibit ECAH 4). The application thereafter proceeded to registration in the name of Motown Record Corporation on 28th January 1975.

28. The assignment to Motown was preceded by an agreement dated 22nd April 1974 (Exhibit MW16) which defined the parties’ rights with regard to the name THE SUPREMES. The agreement provided that:

Motown, its affiliates, subsidiaries and/or related companies, and its and/or their successors and assigns shall have the exclusive right to exploit said name in any and every manner whatsoever now known or hereafter devised including but not limited to the right to exploit said name in connection with the designation of a recording group, including a group of which you are not a member.

With regard to protection of the name it provided 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 [Mary Wilson] 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.

For good measure it went on to provide that:

You [Mary Wilson] 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.

This reference to "the Agreement" was a reference to an "*exclusive recording artist agreement and the Rider attached thereto between you [Mary Wilson] and Motown Record Corporation ... dated March 28, 1974*".

29. The Agreement of 22nd April 1974 provided in favour of Mary Wilson that:

In the event that Motown should at any time enter into an agreement wherein all or any portion of the name "The Supremes" is valued at and sold for a specifically designated amount, you shall receive Fifty Percent (50%) of the net amount received by Motown from the sale of the said name.

For her part Mary Wilson acknowledged and agreed that this 50% and the monies payable to her under the recording artist agreement dated 28th March 1974:

shall be the only monies which you [Mary Wilson] shall be entitled to receive from the exploitation of the name "The Supremes".

She further acknowledged and agreed that no one other than her should be a beneficiary under the Agreement of 22nd April 1974.

30. It is a notable feature of the evidence on file that Mary Wilson gives no account of the dealings and discussions with Motown which resulted in the agreement of 22nd April 1974 and the assignment of the US trade mark application on 1st May 1974.

31. There can be no doubt as to the commercial significance of the name THE SUPREMES at the time of those transactions. It was an internationally famous name associated with the performances of the various Motown recording artists who had performed together as THE SUPREMES during the preceding 13 years. Motown had a strong economic interest in the sale of its recordings of their performances under that name in as many countries as possible. The agreement of 22nd April 1974 contains no territorial limitations. I can see no reason why any such limitations should be implied. On the contrary, I think it would be irrational to suppose that the agreement was intended to leave Mary Wilson free to assert rights of ownership and control in relation to the name THE SUPREMES everywhere other than the United States.

32. In my view, the agreement resolved the position with regard to ownership and control of the name on a worldwide basis as between Mary Wilson and Motown Record Corporation. It clearly envisaged that the right to determine who should be entitled to perform as a member of a recording group called THE SUPREMES would be owned by Motown, its affiliates, subsidiaries and related companies and their successors to the exclusion of Mary Wilson. It follows that Mary Wilson will not have had the right to perform or authorise others to perform under the name THE SUPREMES after 22nd April 1974 without Motown's consent.

33. The position as between Motown and other members of THE SUPREMES is far less clear. As a result of the trade mark registration obtained pursuant to the application that Mary Wilson had filed on 7th January 1974, all existing and former

members of THE SUPREMES were thereafter precluded from performing under that name in the United States without the consent of Motown Record Corporation. However, Motown could not assert its United States trade mark rights against them in relation to activities undertaken entirely outside the United States. The question whether Motown is or was in a position to assert rights against them in other countries is not addressed in the evidence. I do not think that the possibility can be ruled out.

34. The agreement made with Mary Wilson on 22nd April 1974 could be expected to count in favour of Motown in any dispute with other members or former members of the group claiming rights through or under her in relation to THE SUPREMES name. How far that might actually have assisted Motown I cannot say. The question naturally arises as to whether Motown had or has rights relating to THE SUPREMES name under any contracts made directly with members of the group other than Mary Wilson. As to that, the evidence is silent.

Mary Wilson's departure from the group

35. Mary Wilson's departure appears to have preceded the disbanding of the group by a period of several months. The evidence relating to her leaving is somewhat confusing. She does not dispute that she left the group to pursue a solo career, but says in paragraph 20 of her first Statutory Declaration "***I only left for a few months as I had to return to complete bookings for THE SUPREMES which needed to be fulfilled as Scherrie Payne refused to do so.***" In paragraph 28 she speaks of her "***brief decision not to continue as THE SUPREMES***" for a few months.

36. However, in paragraph 10 of her second Statutory Declaration she relies on the contents of an article which appeared in Ebony Magazine in 1978 (Exhibit MW 24). According to that article, Scherrie Payne and Susaye Green were left to determine the fate of THE SUPREMES when Mary Wilson departed to pursue a solo career. It appears that when they were subsequently told that Motown wanted to put Mary Wilson back into the group, they expressed concerns about that proposal and the group was disbanded. It seems likely that the decision to disband was taken not long after the letter of 21st October 1977 noted in paragraph 13 above was written.

37. I do not see how Mary Wilson's departure could have involved anything other than complete withdrawal from membership of the group if the account of events given in Ebony Magazine is correct. On the evidence as a whole, I think it is likely that she ceased to be a member of the group in June 1977 following her performance as a member of THE SUPREMES at the Theatre Royal, Drury Lane, London. Her authorisation from Motown to perform under the name THE SUPREMES was a benefit of her membership of the group. She will have relinquished it when she left the group, both in accordance with the terms of the agreement she had made with Motown on 22nd April 1974 and on the basis of the understanding which appears to have underpinned her relationship with the other members of the group (see paragraph 26 above).

The claim based on use by Mary Wilson

38. In paragraph 17 of her first, Statutory Declaration, Mary Wilson claims to have used THE SUPREMES name independently of Motown since 1974:

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 MW11 copies of newsletters 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.

She went on to say in paragraph 32 of the same Statutory Declaration:

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 MW14 a selection of material evidencing these UK tours.

39. This evidence was given in support of her contention that in the United Kingdom and elsewhere rights of ownership and control of the name THE SUPREMES resided in *“my corporation which was initially called The Supremes Inc, but changed its name to Mary Wilson Enterprises Inc”*.

40. Exhibit MW11 contains copies of newsletters published by THE SUPREMES' MARY WILSON fan club. These quite often refer to Mary Wilson's involvement in the activities of THE SUPREMES before she left the group in 1977. They also refer to her activities as a performer after 1977, but they do not demonstrate that she actually performed in the United Kingdom or anywhere else as THE SUPREMES following her departure from the group. The same is true of her Exhibit MW14.

41. The statement in paragraph 13 of Mary Wilson's first Statutory Declaration that The Supremes Inc. changed its name to Mary Wilson Enterprises Inc. was not correct. It appears from various documents produced in December 2001, in response to my request for information under Rule 57, that The Supremes Inc. and Mary Wilson Enterprises Inc. were and are separate companies.

42. The Supremes Inc. was incorporated in California under number 705167 on 15th January 1974 following execution of the company's Articles of Incorporation on 7th January 1974 (the date upon which Mary Wilson applied in her own name to register THE SUPREMES as a trade mark in the United States). The main object of the company was to engage in the production and presentation of concerts, musical and/or dramatic productions and other live shows; the production of television and radio shows; and the production and distribution of phonograph records, tapes and other audio or audio-video recordings.

43. The company changed its name to Turkessa Enterprises Inc. on 7th August 1979. On 2nd June 1980 the company's powers, rights and privileges were suspended under the California Revenue and Taxation Code for failure to file returns and/or pay taxes. In an official certificate issued on 4th December 2001 it was confirmed that the powers, rights and privileges of the company remained suspended, reinstatement never having been effected (Exhibit ECAH 2).

44. There is no evidence of any business dealings or relationship between The Supremes Inc. and Motown Record Corporation. It is said that The Supremes Inc. was "*the trading vehicle*" for the live performances which Mary Wilson claims to have given as THE SUPREMES between June 1977 and June 1980. It is not clear

what the company is supposed to have done in its role as “*trading vehicle*” for her services. The suggested commercial collaboration between June 1977 and June 1980 is not documented in the evidence on file. It is not suggested that Mary Wilson performed as THE SUPREMES independently of The Supremes Inc. during that period and there is no basis in the evidence for thinking that The Supremes Inc. might have acquired rights in relation to THE SUPREMES name from anyone other than Mary Wilson. However, Mary Wilson could not have given The Supremes Inc. the right, which she did not possess, to use that name independently of Motown Record Corporation after 22nd April 1974.

45. Mary Wilson Enterprises Inc. was incorporated in California under number 1081310 on 22nd June 1981 with the power to engage in any lawful act or activity subject to certain exceptions which need not be noted here.

46. There is no evidence of any business dealings or relationship between Mary Wilson Enterprises Inc. and Motown Record Corporation. It is again said that Mary Wilson Enterprises Inc. was “*the trading vehicle*” for the live performances which Mary Wilson claims to have given as THE SUPREMES in and after 1981. Once again, it is not clear what the company is supposed to have done in its role as “*trading vehicle*” for her services. Yet again, the suggested commercial collaboration is not documented in the evidence on file. It is not suggested that Mary Wilson performed as THE SUPREMES independently of Mary Wilson Enterprises Inc. in or after 1981 and there is no basis in the evidence for thinking that Mary Wilson Enterprises Inc. might have acquired rights in relation to THE SUPREMES name from anyone other than Mary Wilson.

However, Mary Wilson could not have given Mary Wilson Enterprises Inc. the right, which she did not possess, to use that name independently of Motown Record Corporation after 22nd April 1974.

47. In the circumstances, I consider that the claim to proprietorship of THE SUPREMES trade mark advanced on behalf of Mary Wilson Enterprises Inc. in paragraphs 1 to 5 of its Counter Statement filed on 2nd October 1997 is: (i) entirely unsubstantiated so far as it is based upon proprietorship through use of the mark; and (ii) a claim made through or under Mary Wilson which she herself was precluded from making by the terms of her agreement with Motown Record Corporation. I should add that there is nothing in the evidence on file to suggest that she has ever been released from the terms of that agreement.

48. At this point it is necessary to bear in mind that registration pursuant to the trade mark application I am now considering would enable the applicant to assert exclusive rights in relation to use of the name THE SUPREMES *per se*. Use of that name without further qualification or explanation would, in relation to services of the kind to which the application is now restricted, allow the applicant to have unabridged access to the continuing benefit and advantage of the goodwill attaching to the live and recorded performances of the Motown recording artists who had previously performed together as THE SUPREMES. In this connection I note that in paragraph 3 of her third Statutory Declaration Mary Wilson says that she is by way of the trade mark application in issue *“looking to preserve the integrity of the name THE SUPREMES in the UK for live performances which is my main area of activity”*.

49. Registration would also be an obstacle to the efforts of any other past members of the group who wished to perform in the United Kingdom as THE SUPREMES. In this connection I note that in an article published in Blues and Soul (Exhibit SW 4) Mary Wilson is quoted as saying with reference to use of THE SUPREMES name by Jean Terrell, Scherrie Payne and Lynda Laurence: ***“While I myself have no intention to form any more groups of Supremes, I am still the only member who has any rights to use the name. So if they continue to do those kinds of things they will be sued!”***

50. In the light of the evidence I have considered above and the evidence I go on to consider below, I do not think it can be doubted that the application filed in the United Kingdom on 12th April 1995 amounted to an attempt by Mary Wilson acting via the applicant company to turn back the tide of history in relation to THE SUPREMES name and restrict the freedom of action of other past members of the group with regard to use of that name in the United Kingdom.

The claim based on use by Lynda Laurence and Scherrie Payne

51. Steven Weaver is a record producer and a long time admirer of the work of THE SUPREMES. His Statutory Declarations and the documents he has exhibited are in large part directed to the proposition that THE SUPREMES ‘re-formed’ in 1985, since when the members of the ‘re-formed’ group have performed publicly as THE SUPREMES with recordings of their studio performances being marketed as recordings of performances by THE SUPREMES.

52. According to the information he has provided, the members of the 're-formed' group have been as follows:

LYNDA LAURENCE • SCHERRIE PAYNE • JEAN TERRELL

1985-1993

LYNDA LAURENCE • SCHERRIE PAYNE • SUNDRA TUCKER

1993-1996

LYNDA LAURENCE • SCHERRIE PAYNE • FREDDI POOLE

From 1996

Steven Weaver says that he has been the record producer for Lynda Laurence and Scherrie Payne since 1993.

53. I think it is a considerable over-simplification to speak of THE SUPREMES being 're-formed'. What actually happened was that three former members of THE SUPREMES decided to form a new group. Only two of them (Lynda Laurence and Jean Terrell) had been side-by-side members of the group which disbanded in 1977; the three of them had not previously performed as a trio under that name; and their group was formed independently of Motown Record Corporation. In the circumstances, the group was new to the marketplace.

54. It is none the less clear that the members of the new group wanted to pick up where the old group had left off in 1977. Hence the title to their first commercially released recording "*We're Back*". So also their later willingness to embrace the message that they were "*Keeping the legend alive ...*" (Exhibit SW7). Mr. Weaver's statement that THE SUPREMES 're-formed' in 1985

confirms the existence of a desire on the part of the members of the new group to be seen as successors to the members of the old group, but begs the question how far they were entitled to present their performances to the public simply as performances of THE SUPREMES.

55. The evidence indicates that the members of the new group started performing and recording as the FORMER LADIES OF THE SUPREMES (FLOS). I am left with the impression that they adhered to the use of that designation in the United States. By using it, the members of the new group could fairly claim to be alerting people to the fact that they were a new group born out of the old group. However, the evidence indicates that the name used in the United Kingdom in relation to live and recorded performances of the new group has since 1989/1990 been THE SUPREMES with little or no further qualification or explanation. This will have allowed the members of the new group to have unabridged access to the continuing benefit and advantage of the goodwill attaching to the performances of the Motown recording artists who had previously performed together as THE SUPREMES between 1961 and 1977.

56. The question naturally arises as to why performances by the members of the new group should have been promoted differently in the United States and the United Kingdom, with less inhibition being considered acceptable in the United Kingdom. In an International Fan Club Newsletter dated June 1992 (Exhibit SW15) it is stated with reference to 'The Supremes UK Tour. April 1992' that:

“On this tour Jean, Scherrie and Lynda have used solely the name 'The Supremes', which has been registered for their use in the UK. The situation in the

USA is different. Many US fans constantly ask why do they not perform more there? The answer lies in the situation regarding the use of the name The Supremes which Motown now claim to own. However, the ladies are presently working on this problem, they assure me of this, so all US fans please be patient, your turn will come soon!”

Beyond that, the evidence is silent.

57. The evidence relating to use of THE SUPREMES name in the United Kingdom in connection with live and recorded performances of the new group is uninformative, both as to audience sizes and as to the quantities in which recordings of their performances have been distributed for sale. Relevant dates are not in all instances identified and the dates identified are not in all instances reliable. In particular, Exhibit SW10 consists of a schedule in which release dates have been attributed to singles and albums produced by the new group. Counsel for the applicant subjected the dates in the schedule to close scrutiny in the light of information derivable from other documents in the evidence on file. His criticisms of the accuracy of the dates it contains were not refuted. I cannot be confident that the dates are accurate. On the basis of the submissions made to me, I also believe that publicity material may have been exhibited in relation to an event in the United Kingdom that was, in fact, cancelled. There is even room for doubt as to whether the new group was formed in 1985 rather than 1987.

58. The shortcomings in the opponents’ evidence are disquieting. However, the evidence still appears to me to show that there has been use of THE SUPREMES name with little or no further qualification or explanation, in the United Kingdom

since 1989/1990, in relation to live and recorded performances of the new group. The use in question cannot be regarded as commercially insignificant or insubstantial. However, the scale of it cannot be ascertained from the evidence on file.

59. There is no evidence that Motown Record Corporation (or any entity connected with it) has ever raised any objection or complaint in relation to the new group's use of THE SUPREMES name in the United Kingdom.

60. The Supremes Inc. is not a party to the present opposition proceedings. It has, as noted above, been defunct since 2nd June 1980. There is no evidence that it has ever parted with any rights it may have had to enforce Clause 7 of the employment agreement it made with Scherrie Payne in 1974 (Exhibit MW10). Any and all rights to which it may have been entitled in respect of THE SUPREMES name remain unenforced in relation to Scherrie Payne's involvement in the new group. Moreover, any attempt to enforce Clause 7 against her in the United Kingdom would be met by the objection that it is unenforceable for being in unreasonable restraint of trade according to the evidence of Steven Weaver at page 11 of his second Statutory Declaration.

61. For the reasons I have given above, I consider that Mary Wilson and Mary Wilson Enterprises Inc. have no legal right to prevent the new group from using THE SUPREMES name in the United Kingdom. However, it does not follow that the members of the new group are entitled to claim proprietorship of the goodwill attaching to that name in the United Kingdom.

62. The goodwill attaching to THE SUPREMES name by virtue of the performances of the various Motown recording artists who had performed together under that name between 1961 and 1977 was a valuable asset. It remained a valuable asset on the basis that sales of Motown recordings of their performances as THE SUPREMES had continued without interruption. The marketing of live and recorded performances delivered by the new group concurrently with the marketing of recorded performances delivered by the old group, all being presented as performances of THE SUPREMES, was apt to augment the pre-existing goodwill because the live and recorded performances were likely to be attributed to a single, continuing business undertaking in the perceptions and recollections of the average consumer. The pre-existing goodwill could not, in the context of the claims raised in the present proceedings, be regarded as the property of the members of the new group without evidence (which might be evidence of release, waiver or abandonment) sufficient to justify a finding that they became successors in title thereto.

63. The evidence on file is not sufficient to justify such a finding. It only goes so far as to indicate: (i) that the members of the new group unilaterally decided to perform in the United Kingdom as THE SUPREMES; (ii) that their live and recorded performances have, to an extent which is not insignificant or insubstantial, been presented to the public in the United Kingdom as performances of THE SUPREMES; (iii) that such use has continued undisturbed since 1989/1990 on a scale which cannot be ascertained from the evidence; (iv) that the use in question has been concurrent with the use of THE SUPREMES name in

connection with the marketing of recordings of performances delivered by the Motown recording artists who performed together as THE SUPREMES between 1961 and 1977, sales of such recordings having continued in the United Kingdom down to the present time.

64. In the circumstances, I consider that the members of the new group should be taken to have exercised, without owning, the right to determine whose performances in addition to those delivered between 1961 and 1977 could be presented to the public in the United Kingdom as performances of THE SUPREMES. There is no evidence that anyone with a tenable claim to ownership of the pre-existing goodwill in that name has questioned or denied the legitimacy of their activities. I think it follows that they are entitled to the benefit of the presumption that they are innocent of wrongdoing: see Halsburys Laws of England 4th Edn. Vol.17 paragraph 114. However, the presumption that their activities are lawful does not, on the evidence as it stands, permit or require anything more than all necessary consents to be assumed in their favour.

65. Where does that leave them? I think it leaves them with a problem. It is clear that: *“Passing off is a wrongful invasion of a right of property vested in the plaintiff, but the property which is protected in an action for passing off is not the plaintiff’s proprietary right in the name or get-up which the defendant has misappropriated but the goodwill and reputation of the business which is likely to be harmed by the defendant’s misrepresentations”*: Harrods Ltd v. Harrodian School Ltd [1996] RPC 697 (CA) at p.711 per Millett LJ. It is equally clear that use of a distinctive name with the permission of the person(s) who might

otherwise have been entitled to object to the permitted use does not, of itself, vest any right of property in the permitted user: Northern & Shell Plc v. Condé Nast & National Magazine Distributors Ltd [1995] RPC 117 at pp.121 to 123 per Jacob J. However, the person permitted to use the name may come to acquire a reputation under it which he is entitled to protect in an action for passing off if the other ingredients of liability are present. That will be the position as and when the name becomes so closely identified with his goods or services as to be misleading if used as an indication of trade origin in relation to goods or services for which he is not responsible. He may then claim an independent or concurrent right to protection at common law.

66. The question whether the name in question has become distinctive in that sense is a question of fact. It leaves “*no room for any fiction or the application of any equitable doctrine*” and clearly requires proof sufficient to substantiate the claim that has been made: T. Oertli AG v. EJ Bowman (London) Ltd [1959] RPC 1 (HL) at p.5 in the speech of Viscount Simonds. In that connection it must be remembered that evidence of use has to be evidence of use in the distinctive sense required in order to have any materiality: Bach Flower Remedies Trade Marks [2000] RPC 513 (CA) at paragraph 49 of the judgment of Morritt LJ. The assessment is likely to be fact intensive. It may lead to the conclusion that the lawful activities of the permitted user have perpetuated or extended the goodwill of the consenting party or parties: c.f. Nishika Corporation v. Goodchild [1990] FSR 371 at 376 (Knox J.). I infer from the observations of the House of Lords in Scandecor Development AB v. Scandecor Marketing AB [2001] UKHL 21 (4th

April 2001) that a conclusion to that effect can, from a common law perspective, be regarded as permissible in point of law if it is correct in point of fact.

67. The evidence in the present case shows the new group: (i) covering (in their live and recorded performances) the songs previously popularised (in live and recorded performances) by the members of the old group; (ii) emphasising that their line up featured “genuine members” of THE SUPREMES; (iii) trading on the connection between Motown and THE SUPREMES (for example, referring to “*a guest appearance by fellow Motown legend Edwin Starr*” on their album entitled ‘The Best of THE SUPREMES Live And More’ and appearing as THE SUPREMES in a ‘Giants of Motown’ tour “*featuring past and present Motown recording artists*”); and (iv) effectively projecting themselves as the most recent in direct line of succession to the original members of THE SUPREMES.

68. Their efforts seem to me to have perpetuated and extended the pre-existing goodwill attaching to THE SUPREMES name in a manner that has merged their contribution to the economic value of it with the contributions of their predecessors. I do not think the evidence demonstrates that the members of the new group had built up or acquired a “*sufficient property interest in the requisite goodwill*” (see Kerly’s Law of Trade Marks and Trade Names 13th Edn. 2001 paragraph 14-39) to be able to maintain an action for passing off on their own behalf at the date of the present application for registration.

Litigation in the United States

69. A review of Mary Wilson's book entitled DREAMGIRL MY LIFE AS A SUPREME is reproduced in the October 1986 fan club newsletter in Exhibit MW11 to her first Statutory Declaration. The reviewer noted that she had been involved in legal battles with Motown over her attempts to use the group's name.

70. This was a matter addressed by Steven Weaver in his second Statutory Declaration:

At the end of 1977 Mary Wilson tried to set up a separate group under her control called 'The Supremes'. The well-known American recording company called Motown Record Corporation immediately issued proceedings in the USA and in February 1978 obtained an injunction against Mary Wilson prohibiting her from using the name 'The Supremes' (page 6).

71. In reply to those observations Mary Wilson said:

I completely refute the claim ... that I was prohibited from using the name THE SUPREMES by Motown Record Corporation. Mr. Weaver has not filed any documentary evidence of the granting of the claimed injunction and therefore I consider that Mr. Weaver's claim should be completely disregarded.

However, she went on to exhibit as part of her Exhibit MW21 an article from The People magazine published in the United States in 1999 in which she was reported as saying in answer to the question "*Who owns the trademark of The Supremes?*":

It's owned by Motown. I can't even go out and fight the bogus groups because I don't even own the rights. That's why all these groups can pick up and become the Supremes, and that's why a judge said to me recently, 'You signed away your rights; if you wanted the name why did you sign it over to Motown?' I had to.

72. This and the other material in Exhibit MW21 was produced with reference to her activities as a Vice President of Friends Against Musical Exploitation (F.A.M.E.) of Artists Inc, a corporation formed in America in 1998 ***“to offer assistance and support to current and former recording artists who are battling the loss and/or misuse of their names and the names of their groups by counterfeit groups and individuals, whether those counterfeit groups obtained the use of such names legally or not”*** (page 1 of Exhibit MW21). Exhibit MW19 contains further material of a similar nature.

73. As part of my request for information under Rule 57, I asked for clarification of the factual basis of Mary Wilson's statement about ownership of THE SUPREMES trade mark as reported in The People article. I did so because her statement appeared to indicate that there had been litigation in the United States in relation to the agreement dated 22nd April 1974 that she had produced as her Exhibit MW16. It looked as though various of the documents exhibited in the present opposition proceedings in the United Kingdom had been extracted from litigation files prepared for use in the United States. I wished to know whether the courts in the United States had already pronounced on any of the matters I was being asked to consider.

74. At a case management conference held on 28th January 2002, I was informed that there had been three sets of litigation in the United States, two of which had been settled and one of which had resulted in a decision dated 6th July 1999 of the United States Court of Appeals, Ninth Circuit. The Court of Appeals' decision had been published as Wilson v. RSM Management Inc. 187 F.3d 651 (1999). I was given to understand that a copy of the judgment at first instance and an explanation of why the litigation had been brought would be forthcoming by 7th February 2002.

75. To my surprise, the judgment at first instance was not produced and the information provided in relation to it consisted simply of the following comments in paragraph 10 of Mary Wilson's third Statutory Declaration dated 6th February 2002:

With regard to the judicial proceedings referred to in the People May 1999 article in 'MW21', in 1997 I did bring legal proceedings in the USA against Lynda Laurence, Scherrie Payne and others for their unauthorised usage of the trade mark THE SUPREMES. The action was unsuccessful as the Judge held that because Motown owned the US trade mark registration for THE SUPREMES only they had the right to prevent such usage.

76. For completeness, I think it is necessary to refer to the Court of Appeals decision. The report of the decision confirms that Mary Wilson had brought proceedings before the District Court for the Central District of California against various parties including Lynda Laurence, Scherrie Payne and Jean Terrell as members of FORMER LADIES OF THE SUPREMES (FLOS). Having had her

claim against the members of the new group dismissed by the District Court, she appealed to the Court of Appeals. Her appeal was summarily rejected on the basis that she could not prove her case against them.

77. In its decision issued on 6th July 1999, the Court of Appeals stated:

“Wilson produced no evidence sufficient to sustain a contract claim. She provided no evidence that there was a contractual relationship between Laurence and herself, or what the alleged contract entailed, much less the requisite evidence of breach and damages ... (paragraph 3).

Motown has incontestably established its ownership of the Supremes trademark ... At best, Wilson can claim an interest as a non-exclusive licensee, on the basis of a license agreement that she later repudiated. As a licensee, her interests are dependent upon those of the licensor-owner ... Because Motown acquiesced in FLOS’s activities, any federal claim is barred ... (paragraph 4)

These findings are congruent with the conclusions I have reached as to the position of Mary Wilson and Mary Wilson Enterprises Inc. in the United Kingdom. They do nothing to allay my concern that more information would be required before it could be accepted, when assessing the position of the new group in the context of the claims made in the present opposition proceedings, that there are no relevant rights outstanding in Motown Record Corporation.

The decision under appeal

78. In a written decision issued on 2nd April 2001 Mr. M. Reynolds acting on behalf of the Registrar of Trade Marks held that the application for registration was objectionable under Section 5(4)(a) of the 1994 Act because it envisaged use

of THE SUPREMES name as a trade mark in the United Kingdom in circumstances that would render it actionable in passing off at the suit of the opponents.

79. He did so on the basis that the question whether the objection was made out fell to be determined as at the date of the application for registration (12th April 1995) because: ***“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”*** (paragraph 29).

80. He upheld the opponents’ right to maintain a claim against the applicant in passing off on the basis that ***“the name had by 1995 come to be associated with the opponents and the goodwill of the underlying business accrued to them”*** (paragraph 42). He arrived at that conclusion on the basis that between 1977 and 1985 ***“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”*** (paragraph 26).

81. In his assessment of the position after 1977 he said:

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. ...”

On this analysis of the situation, the way was completely clear for the members of the new group to adopt THE SUPREMES name and use it proprietorially in and after 1985.

82. A likelihood of misrepresentation damaging to the goodwill of the opponents’ business under THE SUPREMES name was inferred from the fact that the applicant and the opponents would be trading under that name in practically the same field of commercial activity (paragraphs 43 to 46)

83. The hearing officer then went on to uphold the opponents’ objection to registration under Section 3(6) of the 1994 Act on the basis that the application for registration had been filed in bad faith.

84. Having considered Mary Wilson’s position in the proceedings in terms of her awareness of whether the filing of the application was likely to be in conflict with the rights of another party he concluded as follows:

“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, 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.

...

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 succeeded in this respect.

...

64. A person's intentions 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."

85. The opposition was upheld, registration was refused and the applicant was ordered to pay the opponents £1200 as a contribution to their costs of the Registry proceedings.

The appeal and grounds of appeal

86. The applicant appealed to an Appointed Person under Section 76 of the 1994 Act contending in substance that:

- (1) the hearing officer overlooked the fact that Mary Wilson Enterprises Inc. and The Supremes Inc. were one and the same company and the fact that the company had been the trading vehicle of THE SUPREMES since the early 1970's:

“The exact date in the 1970s does not matter because the Opponents do not claim to have commenced building up their own reputation in the name until 1985 at the earliest. Thus it can be seen that the Opponents cannot possibly succeed in passing off against the Applicant company and likewise the Opponents cannot possibly claim an earlier right in the mark as compared to the Applicant.”

- (2) the hearing officer mistakenly equated cessation of use with abandonment of goodwill and wrongly concluded that the goodwill in THE SUPREMES name had been abandoned when the old group disbanded in 1977;
- (3) the hearing officer wrongly concluded that the activities of the new group between 1985 and 1995 had supplanted the whole of the goodwill attaching to THE SUPREMES name by virtue of the performances of the various Motown recording artists who had performed together under that name between 1961 and 1977;
- (4) the hearing officer should have rejected the opposition on the ground that the opponents were attempting to take advantage of their own wrongdoing;

(5) the hearing officer should not have held that the application for registration was made in bad faith:

“... the Applicant’s belief that it is entitled to registration of the mark “The Supremes” cannot be regarded as totally unreasonable and certainly it is not so unreasonable that the application (and the Applicant) ought to have been stigmatised by the finding that the Application was made in bad faith.”

87. In the light of the additional information provided in response to my request under Rule 57, point (1) was subsequently modified to the following effect:

“The position remains that as from about 1974 the group known as THE SUPREMES had become Mary Wilson’s group so far as concerns live performances (see in particular, Wilson I, paras. 12-17). Through one or other of her trading companies, she has continuously used the name THE SUPREMES for her live musical performances in the UK since that time. Although it is not possible to show, on the evidence, that the goodwill attaching to the business of The Supremes Inc. was formally assigned and conveyed to Mary Wilson Enterprises Inc, that does not matter: Mary Wilson Enterprises Inc. was formed over 20 years ago and almost 14 years before the date of the application in dispute (12 April 1995). The period of use prior to the date of this application is sufficient for the Applicant company to have acquired its own goodwill.”

With that modification, the points I have noted above were developed and expanded upon in the course of argument at the hearing before me.

88. I shall now address each of the points raised by the applicant in turn.

89. Point (1) as modified: On the basis of the evidence on file I consider that the applicant's claim to proprietorship through use of THE SUPREMES name is entirely unsubstantiated. Moreover, the claim to proprietorship is a claim made through or under Mary Wilson which she herself was precluded from making by the terms of her agreement with Motown Record Corporation dated 22nd April 1974.

90. Points (2) and (3): I agree with the applicant on these points. However I consider that they cut against the opponents without assisting the applicant in relation to its case under point (1). In my view, the evidence on file indicates that the members of the new group should be taken to have exercised, without owning, the right to determine whose performances in addition to those delivered between 1961 and 1977 could be presented to the public in the United Kingdom as performances of THE SUPREMES.

91. It appears to me that the opponents have not established that they had a proprietary interest of their own in the goodwill upon which their objection under Section 5(4)(a) of the Act was based. Whilst an opponent may plead and prove a case under Section 5(4)(a) based upon interference with the goodwill of another, that is not what happened or could properly be taken to have happened in the present proceedings. I consider that the objection actually raised under Section 5(4)(a) (as to which see paragraph 5 above) was not made out.

92. Point (4): I consider that the members of the new group are entitled to the benefit of the presumption that they were innocent of wrongdoing.

93. Point (5): For the reasons I gave at greater length in DAAWAT Trade Mark (10th June 2002), I consider that Section 3(6) of the Act gives effect to Article 3(2)(d) of Council Directive 89/104/EEC of 21st December 1988 as a means of ensuring that the opportunity to apply for registration is not abused by applicants claiming protection which they could not in good faith request or invoke, in relation to the relevant mark and specification of goods or services, in the circumstances existing at the date of the application for registration.

94. The application for registration in the present case appears to me to fall four square within the scope of the objection provided by Section 3(6). I say that on the basis: (i) it was filed by Mary Wilson acting via the applicant company with a view to turning other past members of THE SUPREMES into infringers for using that name in relation to “*musical entertainment services; concert performances; presentation of live performances*” and similar services (see Section 10(2)(a) of the 1994 Act); (ii) she was precluded by her agreement with Motown from requesting or invoking such protection; (iii) the applicant company had no better right than she did to request or invoke such protection; (iv) the other past members had for some years been using the name openly in the United Kingdom and apparently lawfully in the absence of objection on the part of Motown or anyone else with a tenable claim to ownership of the pre-existing goodwill attaching to THE SUPREMES name; (v) she had been pursuing a solo career and was not proposing (either alone or via the applicant company) to form any more groups of Supremes; and (vi) she and the applicant company were evidently prepared to plough ahead with the application on the basis of assertions

of proprietorship that they were unable or unwilling to substantiate in relation to the name *per se*.

Conclusion

95. The appeal from the hearing officer's determination that the application for registration was objectionable under Section 5(4)(a) of the Act is allowed

96. The appeal from the hearing officer's determination that the application for registration was objectionable under section 3(6) of the Act is dismissed.

97. Much time and effort has been spent on the task of evaluating the assertions and counter assertions made in support of the parties' claims to proprietorship of THE SUPREMES name in relation to live and recorded performances. There are deficiencies in the evidence on both sides. The applicant's evidence and the claim to proprietorship based upon it have occasioned costs out of all proportion to the position it has unsuccessfully sought to maintain. The opponents' evidence and unsuccessful claim to proprietorship did not do so to anything like the same extent. Moreover, the opponents have succeeded in preventing registration pursuant to the application in issue. Looking at matters in the round, I consider that the applicant should be required to pay the opponents a total of £1400 as a contribution to their costs of the present proceedings in the Registry and before me on appeal, payment of that sum to be made within 21 days

of the date of this decision. The hearing officer's order as to costs is set aside and replaced by an order to the effect I have just indicated.

Geoffrey Hobbs Q.C.

20th November 2002

Richard Miller Q.C. instructed by Messrs Castles appeared as Counsel for the applicant.

Don Turner of Messrs Beresford & Co appeared on behalf of the opponents.

The Registrar was not represented.