

O-117-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2328312
BY POOL FM LIMITED
TO REGISTER THE TRADE MARK:**

Pool FM

IN CLASSES 38 AND 41

AND

**THE OPPOSITION THERETO
UNDER NO 92441
BY
GARRISON RADIO LTD**

Trade Marks Act 1994

**In the matter of application no 2328312
by Pool FM Limited
to register the trade mark:
Pool FM
in classes 38 and 41
and the opposition thereto
under no 92441
by Garrison Radio Ltd**

BACKGROUND

1) On 2 April 2003 Pool FM Limited, which I will refer to as PFM, applied to register the trade mark **Pool FM** (the trade mark). The application was published for opposition purposes in the “Trade Marks Journal” on 23 January 2004 with the following specification:

radio broadcasting services, telecommunication services, electronic communication services;

production of radio programmes; provision of information over the radio.

The above services are in classes 38 and 41 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 23 April 2004 Garrison Radio Ltd, which I will refer to as Garrison filed a notice of opposition to the registration of the application. The original grounds of opposition were amended.

3) Garrison states that it was incorporated under the Companies Act 1985 on 10 April 2001 and commenced to trade as soon as it was incorporated. Garrison states that it is a Hartlepool based company that runs radio stations. Its main contract is with the British army and it provides four fully staffed broadcasting stations around the United Kingdom. It was founded in Hartlepool with assistance from accountants Horwath Clark Whitehill and its registered office has always been at the offices of Horwath Clark Whitehill in Hartlepool; where the accounts and payroll are prepared. Garrison states that from March 2001, prior to its incorporation, the promoters of Garrison planned that it should set up a radio station in Hartlepool. Garrison states that at that time Hartlepool had never had its own radio station nor had anyone else published plans to establish such a radio station. Garrison states that by May 2002 it had established its army radio stations and commenced to develop its ideas and put together plans to run a radio station in Hartlepool itself. Garrison states that it decided that an appropriate name for the radio station would be Pool FM. It states that from that point onwards it traded as Pool FM in regard to all its work on the radio station and received payments into its bank accounts with cheques made payable to Pool FM. In November/December 2002 it was decided to establish Pool FM on the ground floor of a bar in the centre of the town. Plans had already been drawn up for the necessary conversion work and it had been decided to call the bar Bar Pool FM. Garrison states

that part of the refurbishment involved installing large windows with the name Pool FM in large letters upon them.

4) Garrison states that work on renovating and converting the Sports Bar began in January 2003. The local council, 'The Hartlepool Mail' (the local newspaper), Hartlepool College and Hartlepool United were all informed of Garrison's plans to operate a radio station and that it was to be called Pool FM. Garrison states that these undertakings were informed that the first broadcast would be in April 2003. On 22 January 2003 Garrison made an application to the Radio Authority for a restricted service licence in order to begin trial broadcasting in Hartlepool under the call sign Pool FM, with a view to obtaining a permanent licence once local demand had been established. Garrison states that restricted service licences permit two four week periods of broadcasting in any twelve month period. Its application sought permission to run the first trial in the period from 8 April 2003 to 5 May 2003. Garrison states that it "received its licence on....." (sic). Following the application for a licence, Garrison states that it intensified its efforts to promote and market the new station, which efforts continued up to the launch on 8 April 2003.

5) Garrison states that on 27 February a director of Garrison, Mark Page, registered the domain name www.POOLFM.COM and Garrison commenced to publish details of the station and its planned activities. Garrison states that the website Pool FM Com featured not only Pool FM itself but also links to local institutions and businesses. Garrison states that neither it nor Mark Page was aware at the time that someone had registered the domain name www.poolfm.co.uk. Garrison states that, upon information and belief, no website was operating under the latter domain name at that time. Garrison states that in or around early March 2003 it started sending out press releases and shortly thereafter, several newspaper articles about Pool FM appeared in 'The Hartlepool Mail' and 'The Northern Echo'. Garrison states that it commenced to accept advertisements to be broadcast during the four week trial period and issued invitations through the local press for local people to apply to become radio presenters. Thirty advertisers bought advertising with Pool FM, including Hartlepool College of Further Education. Garrison states that eight years previously the college had run a month long student station called Pool FM and were supporting Garrison's Pool FM radio station by being one of its main advertisers and by station interview slots. Garrison states that from its launch on 8 April Pool FM radio station was professionally staffed; it also used local DJ talent who had been trained to broadcast. Garrison states that on launch day the station had over thirty signs placed at key roadside points across the town and fifty guests attended a champagne reception. It states that the station featured several times in the press and on the local BBC radio station. Garrison states that during April 2003 twenty thousand Pool FM leaflets were given away with newspapers in a chain of local shops. Three thousand car stickers were distributed. Five hundred posters were distributed, primarily for shops and businesses. Garrison states that for a number of weeks the station maintained a Pool FM sponsored Vauxhall Zafira motor car bearing the logo Pool FM. This car was driven around Hartlepool on promotions. Garrison states that when Hartlepool's football team was promoted from Division Three, it, trading as Pool FM, hosted a promotion party road-show attended by six thousand people on the steps of the Civic Centre. Garrison states that this road-show was shown on local television and Sky Sports, a thousand Pool FM promotional posters were given away at the event. Garrison states that it conducted a film preview at the local Warner Village cinema for

two hundred listeners. Pool FM hosted a road-show for Shopmobility on a Saturday in Middleton Grange, the North East's third largest shopping centre. Garrison states that local councillors of all parties and council leaders, the Mayor and the local MP all visited the studio as guests and to be interviewed on air. Over twenty local voluntary groups took to the airwaves via Pool FM with specially produced commercials. Many groups and organisations visited the station for interviews. Pool FM had a dedicated local news service, in conjunction with 'The Hartlepool Mail', and Hartlepool United led sports news. Garrison states that a petition of support for Pool FM, letters of support and two thousand emails were received at the station's studios at Bar Pool FM.

6) Garrison states that at the end of its first trial broadcast a survey that it conducted showed:

56% listenership in the town in four weeks;
78 % awareness in Hartlepool.

Garrison states that, based upon the town's population of 96,000, this shows that 74,880 people know of the brand, with nearly 54,000 sampling it (sic) within a five kilometre radius of Hartlepool. Garrison states that since the end of August 2003 it has run a full time Internet radio station, Pool FM.com, which is staffed seven days a week.

7) Garrison states that, consequently, by the date of the filing of the application, it had acquired a substantial reputation and goodwill in the name Pool FM. Garrison states that such was the reputation of the trade mark that members of the public when seeing it or hearing it spoken in relation to radio stations, associated it exclusively with Garrison and its radio station based at Bar Pool FM. Garrison claims that use of the trade mark by PFM is liable to be prevented by the law of passing-off because such use would amount to a false representation that PFM's radio station was connected with Garrison and that it would suffer damage as a result. On form TM7 Garrison reproduces the sign upon which it relies in relation to section 5(4)(a) of the Trade Marks Act 1994 (the Act) (the grounds of passing-off). This trade mark is reproduced below:



8) Garrison claims that save for adopting the trade mark as its company name, since which time it had remained dormant, and registering the domain name www.poolfm.co.uk, for a website that had not operated, at no time prior to the filing of the application to register the trade mark has PFM used or traded under or by reference to the name Pool FM.

9) Garrison claims that the time of the filing of the application to register the trade mark, PFM was well aware that Garrison had acquired a substantial reputation and goodwill in the name. Garrison claims that PFM is aware that the ability to use the trade mark will depend solely upon the grant of a licence by the Radio Authority to broadcast in the Hartlepool Area and PFM's actions are intended to prevent Garrison from using the trade mark by which it had already become known and/or hampering Garrison's application for a permanent licence for serving the Hartlepool area. Consequently, the application was made in bad faith and registration of the trade mark would be contrary to section 3(6) of the Act.

10) PFM filed a counterstatement in which it denies the grounds of opposition and puts Garrison to proof of the claims that it makes. PFM states the trade mark Pool FM has been used by PFM and/or its predecessor in title, Jason Anderson, who is the managing director of PFM, since 1995. PFM states that it has used the trade mark in relation to the services of the application and in July 2002 it registered the domain name poolfm.co.uk. PFM was incorporated on 21 August 2002. PFM states that it holds frequency modulation restricted service licences from the radio regulatory authority OFCOM to broadcast under the name PoolFM and is the regular provider of FM local radio services in Hartlepool upon an official basis. PFM understands that Garrison was granted one 28 day trial broadcast period by the regulatory authority from 8 April – 5 May 2003 during which Garrison used the call sign PoolFM. PFM states that when the regulatory authority became aware that the trade mark Pool FM belonged to it and was being used by it, it refused to grant a further trial period to Garrison to use the call sign Pool FM. PFM states that since that time Garrison has not broadcast under the call sign Pool FM nor has it traded as Pool FM. PFM denies that Garrison is the owner of an earlier trade mark, sign or right. PFM states that the filing of the application predates any use of Pool FM made by Garrison. PFM states that it has used and is actively using the trade mark Pool FM.

11) Both sides filed evidence.

12) The sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing. Both sides filed written submissions. Consequently, this decision is made from the evidence and written submissions before me.

EVIDENCE

Main evidence of Garrison

13) This consists of a witness statement by Mark Page. Mr Page is a shareholder in and the managing director of Garrison. Mr Page is also a shareholder in and director of Hartlepool FM Limited, which he states is a company incorporated under the name Radio Tees Limited on 14 June 2001. Mr Page states that Radio Tees Limited changed its name to Hartlepool FM Limited on 3 June 2003 by way of a protective response to the activities of PFM and its director Jason Anderson.

14) Mr Page states that Garrison radio was incorporated on 10 April 2001. It was founded in Hartlepool with assistance from accountants Horwath Clark Whitehill and its registered office has always been at the offices of Horwath Clark Whitehill in Hartlepool; where the accounts and payroll are prepared. Mr Page states that before Garrison was even incorporated his discussions with Horwath Clark Whitehill included, in addition to the army radio stations which were its initial project, the setting up of a radio station in Hartlepool. Exhibited are pages from Mr Page's diary for March and May 2001. Mr Page states that at a meeting with Peter Olsen of Horwath Clark Whitehill on 13 March 2001, he recalls discussing the viability of a radio station for Hartlepool. The copy of the entry for 13 March 2001 is illegible. At that time, so far as Mr Page was aware, Hartlepool had never had its own radio station nor was he aware that anyone else was planning such a station. By May 2002 Garrison's four army radio stations were up and running and he began to think again about a radio station for Hartlepool. During the summer he had more discussions with Mr Olsen in relation to this matter, a copy of an extract from his diary for 8 May 2001 shows a meeting with Mr Olsen. Mr Pages states that in the autumn of 2002 he began to work seriously on the project to establish a radio station in Hartlepool and had a number of meetings with Mr Olsen and his colleague Brian Beaumont. Mr Beaumont suggested that Mr Page might wish to meet with another client of Horwath Clark Whitehill, Leo Gillens, who had some premises that might be suitable for a radio station. Mr Page met Mr Gillens on 3 December 2002. Mr Page states that it transpired that Mr Gillens had been considering establishing a radio station of the ground floor of a bar which he owned in the centre of Hartlepool, Gillen's (sic) Sports Bar. Copies of diary entries for 3 and 9 December 2002 show meetings scheduled with Mr Gillens. Mr Page states that plans had already been drawn up for the necessary conversion work and he and Mr Gillens agreed that Garrison would take over the radio project and set up its local radio station for Hartlepool on the ground floor of Mr Gillens' premises. Mr Page states that by that time it had been decided that Pool FM would be a good call sign/name for the station and it was agreed that the ground floor bar was to be renamed Bar Pool FM. Part of the refurbishment involved installing large windows with the name Pool FM in large letters upon them.

15) Work on renovating and converting The Sports Bar begin in January 2003 and on 22 January 2003 an application was made by Garrison to the Radio Authority for a restricted service licence, in order to begin trial broadcasting to Hartlepool with a view to obtaining a permanent licence once local demand had been established. Restricted service licences permit two four week periods of broadcasting in any twelve month period. Its application sought permission to run the first trial in the period from 8 April 2003 to 5 May 2003. A copy of the licence application is

exhibited. Included in the application is a statement of what call sign will be used, POOL FM. The section relating to this states that the applicant must clear “all necessary right and trademarking issues”. On 27 February Mr Page registered the domain name www.POOLFM.COM. At the time Mr Page states that he was not aware that the domain name www.poolfm.co.uk had been registered by someone else. Mr Page states that in March 2003 press releases were sent out. Press releases dated 19 March 2003, 2 April 2003 and 19 May 2003 are exhibited. The press release dated 19 March 2003 states that the station will start broadcasting on 8 April. This press release is to encourage people to apply to present programmes on the station. The station is referred to both as Pool FM and Pool FM 107.5. The press release of 2 April 2003 advises that the station has launched its own website. Certain of the material exhibited emanates from after the date of application and so I will say nothing about it. An invoice dated 1 April 2003, made out to Hartlepool Action Team, is exhibited. It is for a series of commercials. The total of the invoice is £800, before VAT. The invoice states that cheques should be made to Pool FM, the invoice is headed with the name Garrison Radio. A sales order headed with the trade mark shown at paragraph 7 is also exhibited. It is noted by hand 31 March 2003 and is to HAT, Hartlepool Action Team. An invoice dated 1 April 2003, made out to Hartlepool College of FE is exhibited. It is for Pool FM breakfast sponsorship and commercials. The total of the invoice is £3,925 before VAT. It and the accompanying sales order are made out in the same way as those for HAT. A copy of an article from ‘The Hartlepool Mail’ of 20 March 2003 is exhibited. The article states that:

“VETERAN DJ Mark Page is launching a new town radio station. The former Radio 1 presenter will be heading Hartlepool’s very own station with the help of another DJ favourite, Dave Lee Travis. Pool FM 107.5 will hit the air waves next month from studios in the town centre....
...Gregg Upwards, TFM’s breakfast DJ, will host a daily show on the first four week trial run of Pool FM.....Stuart Drummond, the Mayor of Hartlepool, has welcomed the news Pool FM, which will be broadcast from newly refurbished premises in Park Road, is being launched.....”

A copy from an article from ‘The Hartlepool Mail’ of 31 March 2003 is exhibited. This article includes a picture of Mr Gillens and Mr Page holding up a sign showing the trade mark reproduced in paragraph 7. The article refers to Pool FM and Pool FM 107.5; it would seem to be the result of one of the press releases referred to above, as it advises people how they can apply to be a radio presenter on the station. Copies of various other press articles are exhibited, however, they emanate from after the material date.

16) Mr Page states that shortly after ‘The Hartlepool Mail’ article of 20 March 2003 he received a telephone call from both that newspaper and a representative of ‘The Northern Echo’. He states that the gist of the telephone calls was that a man called Jason Anderson had telephoned the newspapers claiming that the idea for a radio station in Hartlepool was his and that he owned the copyright in that idea and in the name Pool FM. Mr Page told both newspapers that he had never heard of Jason Anderson and was completely unaware of any plan by anyone else to start a radio station for Hartlepool. Mr Page states that he obtained the telephone number of Mr Anderson from one of the newspapers and telephoned him the same afternoon. Mr

Page queried the statements that Mr Anderson had made to the newspapers; he states that Mr Anderson repeated the comments in essentially the same terms. Mr Page believes that Mr Anderson told him that he had formed a company by the name of Pool FM. Mr Page states that he is not certain if it was before or after his conversation with Mr Anderson that he conducted two Internet searches. On the Companies House website he discovered the company to which Mr Anderson had referred. (Exhibited is a copy of the 363s annual return for Pool FM Limited, the return was signed on 20 October 2004. The return lists Louise Marie Anderson as the company secretary and Jason Phillip Anderson as director, both of the same address. The shareholders are listed as Mr Anderson, Danesh Kohli and Joseph Metcalf, who respectively held 750, 100 and 150 shares. Company register information is exhibited for PFM, this emanates from 26 November 2004. This shows that the company was incorporated on 21 August 2002, the last accounts were made up to 31 March 2003 when the company had the status of being dormant.) Mr Page states that he also interrogated the database of the Trade Marks Registry, where he did not discover any reference to a trade mark using the words Pool FM.

17) Mr Page states that the first Pool FM was a one-off project carried out by media students at Hartlepool College. He states that he was not originally proposing to use Pool FM as company name. However, when Mr Anderson “began his campaign by making the present application”, Mr Page decided to change the name of another company in which he was interested, Radio Tees Limited, to Hartlepool FM in order to try and protect that name for his business. Mr Page states that following the name change PFM attempted to register the trade mark Hartlepool FM, which application was refused by the Trade Marks Registry. Mr Page states that neither Mr Anderson nor any other representative of PFM ever contacted him or any other representative of Garrison directly to assert any prior interest in the name Pool FM. He states that by the time that the newspapers had informed him of Mr Anderson’s claims, Garrison was only two weeks away from the launch of the station and had expended between £7,000 and £10,000 in setting up and promoting the station under and by reference to the call sign Pool FM.

18) A copy of an article from ‘The Hartlepool Mail’ of 9 April 2003 describes Garrison’s venture as “Hartlepool’s first ever radio station.” Mr Page states that he has not seen the application made by PFM for permission to make trial broadcasts but he does not believe that it had been made by the time that that Garrison had commenced its first four week trial period. Mr Page states that the name/call sign will only be of use to whoever succeeds in obtaining the full licence for a local FM station in Hartlepool. The Radio Authority has not yet invited applications for such a licence. Mr Page goes on to comment on events after the date of application and material emanating from after the material date. He states that he believes that the website www.poolfm.co.uk had not begun to operate until after the time that Garrison had completed its trial broadcast. Mr Page states that Garrison had trial broadcasts in Hartlepool for the periods 8 April 2003 to 5 May 2003, 6 September 2003 to 4 October 2003, 4 May 2004 to 1 June 2004 and 11 October 2004 to 8 November 2004. PFM has had trial broadcast in Hartlepool for the periods 13 October 2003 to 10 November 2003, 15 April 2004 to 12 May 2003 (sic) and 22 November 2004 to 19 November (sic) 2004.

19) Mr Page states that Garrison, since early 2003, has had operational studios and offices in Catterick, Colchester, Aldershot, Tidworth and Hartlepool. He states that Radio Hartlepool did not move into its premises at the Grand Hotel, Hartlepool until September/October 2003; it had no premises or recording studio until that time. Mr Page states that the only address apparent on company documents is that of Mr Anderson's street address. PFM's registered office address is that of a firm of accountants in Middlesbrough.

Evidence of PFM

20) This consists of a statutory declaration made by Jason Phillip Anderson. Mr Anderson is the managing director of PFM.

21) Mr Anderson states that in 1995 he was working at the Hartlepool Historic Quay Museum as a tour guide information officer. His employer at the time was the Teesside Development Corporation. The Teesside Development Corporation built a radio station for Teesside's regional radio broadcaster, TFM. The completed building on the new Stockton Tees Barrage was given to TFM, along with a grant of more than £2 million, to support the Teesside Development Corporation in its initiatives. Mr Anderson states that it was then that he thought that Hartlepool would benefit from a local FM radio station. He states that from that time he started work on the project of setting up a local radio station for Hartlepool. Mr Anderson states that the first thing that he thought of was the name of the radio station, Pool FM. He was of the view that Pool FM was not just a name to be associated with broadcasting in Hartlepool but a name that could be used in relation to radio broadcasting in general.

22) Mr Anderson states that he then joined Wardsound Hospital Radio in Hartlepool in order to "study the project deeper". He states that he was interviewed by the chairman of Wardsound Hospital Radio, Stuart Leighton. Mr Anderson states that in the interview he explained about his project and introduced himself as Pool FM(sic). Mr Anderson states that Mr Leighton thought that idea of Pool FM was fantastic and took him on as a ward worker and volunteer broadcaster in order to learn the ropes of radio management. Mr Anderson states that he became Wardsound Hospital Radio's assistant manager, assistant programmer controller to the radio station manager and radio station programme controller. In 2000 he was elected to the position of vice chairman of Wardsound Hospital Radio.

23) Mr Anderson states that in 1995 he attended a meeting on the subject of local radio for Hartlepool. He states that he put forward a case for a full time radio station called Pool FM. Mr Anderson states that throughout his 'presentation' he reiterated the words Pool FM and handed out photocopied documentation about Pool FM to those present at the meeting. Mr Anderson states that since 1995 he has attended media fairs in the United Kingdom, announcing himself as Pool FM. He states that at one media fair he introduced himself to Alistair MacDonald who is a director of Beaumont and Colson; he states that Beaumont and Colson's project designer for radio station playout software was Mr MacDonald. Mr Anderson states that he told Mr MacDonald of his idea for Pool FM and Mr MacDonald gave him a lot of advice in planning Pool FM. *Exhibited at JPA1 is a letter from Mr MacDonald at Beaumont Colson Ltd dated 15 September 2004. Mr MacDonald says that the first meeting with a member of PFM was at the HBA show on 3 and 4 November 2001 at the Holiday*

Inn, Newcastle. He writes that at that time he was discussing with Mr Anderson and Jim Anderson the practicality of using Beaumont Colson's playout system for trial service broadcasts, with a view to obtaining a fulltime commercial licence. He states that this was his second meeting but cannot recall the name under which Mr Anderson was trading. Mr MacDonald states that he first reviewed Mr Anderson's business plan and early programming outlines for Pool FM in 2002 and holds a copy on record. (He has not supplied a copy of this). He writes that at this time Mr Anderson was trading as Pool FM. He says that the sale was agreed and completed but does not state when. Mr Anderson states that some time in 2000 Mr MacDonald told him that he had supplied his software playout package called Soundbox to the Ministry of Defence. He was told that his contact was Mr Page of Garrison. Mr Anderson states that Mr MacDonald suggested that he telephone Mr Page to discuss Pool FM. He did this, announcing himself as Jason Anderson of Pool FM. Mr Anderson states that he informed Mr Page on the telephone, by letters and email, to which he replied to jason@poolfm.co.uk a number of times, that he intended to commence radio broadcasting as Pool FM in Hartlepool. Mr Anderson states that these conversations were upon a friendly basis in the hope that Mr Page would give him some industry advice. Mr Anderson exhibits at JPA2 a copy of a letter dated 31 July 2002 which he states he sent to Mr Page. The email address quoted is as above. The letter includes the following:

"I have enclosed a demo tape as you suggested, and I would dearly like to visit you at Garrison FM to inform you in detail of my project and future intentions, also review Soundbox as it will be the main configuration to Pool FM."

24) Mr Anderson states in 2001 he made some "suggested" logos on his computer. He states that these logos had a CD disc in the background and had Pool FM written upon them. The primary colours were black, white and blue, resembling those of Hartlepool United. Mr Anderson states that he printed a number of the logos and showed them to friends and family in order that they could help him decide which logo PFM should use. Mr Anderson states that in 2001 he made contact with Park Place Training Ltd. He exhibits a copy of a letter from Park Place Training Ltd dated 15 September 2004. *The letter, written by a B Price, states that Park Place Training Ltd acted as consultants to PFM in respect of setting up and running a radio station to be known as Radio Hartlepool. It states that B Price has known the company as Pool FM Ltd since its incorporation in August 2002. B Price states that PFM has published articles in the name of Pool FM Ltd trading as Radio Hartlepool FM. B Price does not exhibit these articles nor state when they were published.* Mr Anderson states that Park Place Training Ltd introduced him to FIRE 1076, a Bournemouth based radio station and advised him to register the name Pool FM Ltd via his accountants. PFM was incorporated on 21 August 2002. Exhibited at JPA4 is a copy of a letter dated 2 September 2004 from G R Boagey of Chipchase Manners & Co, Mr Anderson's accountants. *It states that PFM was incorporated on 21 August 2002. Mr Boagey states that he has always known Mr Anderson's business as Pool FM. He goes on to say that on this basis he applied to Business Link to assist Mr Anderson with the preparation of a business plan that was carried out prior to September 2002. He says that PFM is an active trading company and that draft accounts for the period ending 31 March 2004 have been prepared. He says that PFM has been active from incorporation onwards.* Exhibited at JPA5 is a copy of PFM's memorandum and articles of association. It shows that PFM was incorporated

on 21 August 2002. The memorandum and articles of association appear to be in a standard off the shelf format.

25) Mr Anderson states that in 2001 he began negotiations with the managing director of the Grand Hotel in Hartlepool with a view to establishing a Pool FM radio studio and office at the hotel. He states that the negotiations were successful and in 2002 the radio studios and offices were established. Mr Anderson states that he has operated from the Grand Hotel from that time, initially under his own name and following the incorporation of PFM, under its name. *Exhibited at JPA6 is a letter from the managing director of the Grand Hotel. It is not addressed and undated. It states that negotiations for the inclusion of the PFM radio studio and office in the hotel began in 2001. In 2002 it was concluded that PFM could install a radio studio and office on part of the first floor of the hotel. It states that PFM trades continually (sic) from the hotel. The letter does not state when the station actually started trading.* Exhibited at JPA7 is a copy of a registration certificate for the domain name poolfm.co.uk, which was registered on 24 July 2002. Mr Anderson states that since that time he has added the email address jason@poolfm.co.uk and that anyone replying to his emails would reply to that address. Mr Anderson states that he made a business plan for Pool FM and handed copies of the plan out to potential investors; he states that throughout PFM's business plan the call sign Pool FM is referred to. Mr Anderson states the business plan was produced eventually to (sic) Andrea Miles of Business Link Teesside. He states that Ms Miles suggested that he use Chipchase Manners & Co to help him form a professional business plan for PFM. Mr Anderson states that PFM's business plan received government grant funding for its production from Business Link Teesside; the grant being secured and paid to the accountants in mid 2002.

26) Mr Anderson states that he has traded under the name Pool FM from the date of PFM's incorporation. He exhibits at JPA8 two name badges used by directors of PFM at the Sound Broadcasting Equipment Show on 20/21 November 2002. These are for Dr James Anderson and Rita Anderson; both are described as directors of PFM. Exhibited at JPA9 are three items. All show use of Radio Hartlepool FM in a prominent fashion, with Pool FM in a secondary manner. Radio Hartlepool is described as the call sign of PoolFM Ltd. A sales order form bears the legend PoolFM Ltd 2004, so emanates from after the material date. A Radio Hartlepool FM media pack is exhibited, this bears a copyright year of 2003. There is no indication as to when the media pack was produced. However, it refers to twice yearly 28 day licensed broadcast periods. The final item exhibited relates to advertising packages for 28 day FM. This bears a copyright year of 2003. There is no indication as to when the media pack was produced. However, it refers to 28 day broadcast periods. At the back there are details of the Radio Hartlepool website which advise that it will, ie in the future, stream live. *At JPA10 two "to whom it may concern" letters are exhibited. One is from E Riley, it is dated 19 June 2005. It says that in late 2001 Mr Anderson visited E Riley at home to show him/her some logos which had the words Pool FM in bold upon them. She/he states that they agreed that the best logo design was that "which continues to date". E Riley states that in his/her capacity as a freelance DJ "been in support of the furtherance of Pool FM as a Radio Broadcasting Company". He/she states that he worked with Pool FM as its outside broadcast co-ordinator and road-show DJ. He/she states that he/she has received payment for these services. The second letter, dated 16 June 2005, is from Donald Wayne*

Davison. Mr Davison states that he first knew of Pool FM in 1995 when Mr Anderson announced himself as Jason Anderson of Pool FM when addressing a meeting on the subject of community radio for Hartlepool. Mr Davison states that Mr Anderson put forward a powerful case for a fulltime radio station and referred to it as Pool FM. Mr Davison states that in early 2002 he saw a document entitled Pool FM "with the name Jason Anderson". Mr Davison states that he is now a volunteer community liaison officer with Radio Hartlepool.

27) Mr Anderson states that PFM holds FM restricted service licences from the Radio Regulatory Authority to broadcast under the name Pool FM and that PFM is the regular provider of FM local radio services in Hartlepool on an official basis. Exhibited at JPA11 is a copy of a letter from the Radio Authority to Close Thornton Solicitors in relation to their client, Garrison. It is dated 28 May 2003. The final paragraph states:

"It has been brought to our attention that another company has registered the name Pool FM. Therefore, we are unwilling to accept your client's application to broadcast using that call-sign. You will of course, understand that the Authority cannot intervene in any legal action regarding trademarking issues."

Mr Anderson states that Mr Page has registered the domain name www.poolfm.com in his own name rather than that of Garrison. *Exhibited at JPA12 is a letter from Joseph Metcalfe dated 16 June 2005. Mr Metcalfe describes himself as a leading steering group member and a shareholder of PFM. Mr Metcalfe's letter consists of a list of assertions and submissions.*

Evidence in reply of Garrison

28) This consists of a further witness statement by Mr Page. Most of Mr Page's statement consists of a critique of the evidence of Mr Anderson rather than evidence of fact. I will say no more about these parts of Mr Page's witness statement; although I bear his comments in mind when reaching my decision.

29) Mr Page states that the only contact with Mr Anderson which he can recall was when Mr Anderson telephoned him in July 2002 and introduced himself as the person who ran the local hospital radio station in Hartlepool. Mr Anderson asked if he could visit Garrison Radio to look at its Soundbox system. Mr Page states that he has no recollection of any mention of Pool FM during the telephone conversation. An appointment was made but Mr Anderson did not keep it. Mr Page believes that the reception staff at Garrison contacted Mr Anderson to find where he was and he explained that he did not realise that he had an appointment to visit for that date. Mr Page states that he did not receive the letter exhibited at JPA2. The first occasion that he saw the letter was after Garrison had opposed the trade mark application. In August or September 2002 Mr Anderson sent an audio tape to Garrison Radio of one of his hospital radio shows. Mr Page states that he has neither a recollection nor a record of having received any e-mails from Mr Anderson from any email address. After the telephone conversation of July 2002 the only other conversation he had with Mr Anderson was in April 2003, as described in his evidence. Mr Page states that he

exhibits at MP1 a letter from OFCOM dated 29 May 2005, however, no such letter is before me.

DECISION

Preliminary issue

30) Rule 55 of the Trade Marks Rules 2000 (as amended) (the Rules) states:

“(1) Where under these Rules evidence may be admitted by the registrar in any proceedings before her, it shall be by the filing of a statutory declaration or affidavit.

(2) The registrar may in any particular case take oral evidence in lieu of or in addition to such evidence and shall, unless she otherwise directs, allow any witness to be cross-examined on his statutory declaration, affidavit or oral evidence.

(3) Where these Rules provide for the use of an affidavit or statutory declaration, a witness statement verified by a statement of truth may be used as an alternative; the Registrar may give a direction as she thinks fit in any particular case that evidence must be given by affidavit or statutory declaration instead of or in addition to a witness statement verified by a statement of truth.

(4) The practice and procedure of the High Court with regard to witness statements and statements of truth, their form and contents and the procedure governing their use are to apply as appropriate to all proceedings under these Rules.

(5) Where in proceedings before the registrar, a party adduces evidence of a statement made by a person otherwise than while giving oral evidence in the proceedings and does not call that person as a witness, the registrar may, if she thinks fit, permit any other party to the proceedings to call that person as a witness and cross-examine him on the statement as if he had been called by the first-mentioned party and as if the statement were his evidence in chief.”

This rule is clear. There is a stipulated and clear method of adducing evidence. In this case PFM has put in various letters. Some of these were clearly solicited for and born of these proceedings; I have identified such letters in the summary of the evidence by using italic script. If PFM wished the writers of the letters to give evidence it should have got them to file evidence in the correct manner, by statutory declaration, affidavit or witness statement. Instead of following the prescribed course of action it attempted to adduce the evidence into the proceedings by way of exhibits to the declaration of Mr Anderson. A witness statement does not require the intervention of professionals, it does not require the subscription of an authorised person. It is a simple procedure. PFM should have adduced the evidence in the appropriate form. I will not take cognisance of any of the contents of letters which I have identified by noting them in italic script.

31) If the contents of the letters had been taken into account it would have had no effect on the overall outcome of the case.

Passing-off – section 5(4)(a) of the Act

32) Section 5(4)(a) of the Act states:

“(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.”

I adopt the guidance given by Geoffrey Hobbs QC, sitting as the appointed person, in the *Wild Child case* [1998] RPC 455. In that decision Mr Hobbs stated that:

“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] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] A.C. 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."

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact. In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.""

33) The material date for passing-off is the date of the behaviour complained of (see *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group Plc* [2004] RPC 8 and 9). Section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 of December 21, 1998 which states:

“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”.

Consequently, the material date cannot be later than the date of application for registration of the trade mark. There is an implication in the evidence of PFM that it had rights in Pool FM prior to the date of application.

34) The position of both sides has to be considered in relation to the use of the sign Pool FM as of 2 April 2003, the date of the filing of the application. It appears that the first user of Pool FM in relation to a radio station was Hartlepool College of Further Education for a short one off period in 1995. PFM was incorporated on 21 August 2002, the domain name was registered, in Mr Anderson's name, on 24 July 2002. In November 2002 two people representing PFM visited the Sound Broadcasting Equipment Show. Mr Anderson makes claims about Mr Page's knowledge of his intentions. Mr Page denies receipt of the letter exhibited at JPA2 and the various claims that Mr Anderson makes about the former's knowledge of the latter's plans. Mr Anderson refers to emails being sent, however, none are exhibited. Mr Anderson states that from the date of registration of PFM's domain name he has used an email address linked to that domain name. For the email address to work, the website would need to be running. The implication that the website was up and running from the date of the registration of the domain name is somewhat surprising to me. Mr Anderson does not say when the website became active, despite the matter being raised by Mr Page in his evidence in chief. On the basis of the evidence I cannot decide on which version of events is the truth or closer to the truth. Mr Anderson refers to the business plan but does not furnish a copy. He refers to the logos that he designed but does not exhibit any of them. The matter exhibited shows no Pool FM logo; although it does show a Radio Hartlepool logo in a similar format to that described by Mr Anderson in relation to the Pool FM logo; a CD disc being in the background and similar colours being used. Absent from Mr Anderson's evidence are any details of turnover or broadcasting. However, Mr Page gives details of the broadcasting the PFM has effected under temporary four week licences. There has been no denial of the truth of these details. These show that the first broadcast by PFM was 13 October 2003. There is a lack of contemporaneous third party evidence supporting his claims. There is no doubt that he set up PFM on 21 August 2002, that a domain name was registered, in the name of Mr Anderson, on 24 July 2002 and that there was a visit to a trade show by representatives of PFM in November 2002. There is an absence of any evidence of a business or a trade. The evidence also shows that the radio station is known as Radio Hartlepool, Pool FM being used as a company name.

35) Garrison did not start broadcasting until after the date of application. However there were two articles about its intentions in 'The Hartlepool Mail' prior to the date of application. An article after the date of application, 9 April 2003, refers to Garrison's venture being the first radio station in Hartlepool. Until Mr Anderson contacted 'The Hartlepool Mail' it appears that it, the local paper of what is a small town, appeared to know nothing about PFM or Mr Anderson's hopes and intentions. By the date of application Garrison had already conducted business in relation to the sign Pool FM as is shown by the two invoices for advertising sent to Hartlepool Action Team and Hartlepool College of Further Education. The publication of

articles about the radio station prior to the date of application would have made a number of people aware of it; one assumes those passing the premises and seeing the name on the windows would have created awareness of it. The paying customers of commercial radio stations are advertisers; in economic terms they are relevant persons for passing-off purposes. The listening public are a necessary adjunct but it is not paying the bills, it is not conducting a business with the broadcaster. Despite not having broadcast at the date of the application Garrison had a business in relation to the sign Pool FM, it had conducted business, it had customers. As a local radio station for a small town the potential number of listeners and advertisers will be limited. From the evidence it appears that at various times three groups of persons have thought about a radio station for Hartlepool and considered using the sign Pool FM in relation to it. The latter two might well have been influenced by the first use described by Mr Page. Some see coincidence whilst others see conspiracy. However, this is not an issue of who first thought of using the sign Pool FM. In *Burberrys v J C Cording & Co Ltd* [1909] 26 RPC 693 Parker J ruled:

“The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other’s injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but property in the trade or good-will which will be injured by its use. If the use of a word or name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business.”

A principle confirmed in more recent times by Millet LJ in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697:

“I find that analysis more helpful in that (1) it makes it clear that it is incumbent on the plaintiff to establish, not a reputation in his brand name or get-up, but a goodwill or reputation *attached to the goods or services which he supplies* by association with the identifying name or get up; and (2) it takes the first and fourth elements of Lord Diplock’s formulation together. Given the nature of the inquiry in a passing off action, I do not consider it desirable, or in most cases possible, to consider whether a misrepresentation has been made separately from the effect on the minds of the public of the use by the defendant of the name or get up which he has adopted. It is well settled that (unless registered as a trade mark) no one has a monopoly in his brand name or get up, however familiar these may be. Passing off is a wrongful invasion of a right of property vested in the plaintiff; but the property which is protected by 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 his business which is likely to be harmed by the defendant’s misrepresentation: see *Reddaway v. Banham* [1896] A.C. 199 per Lord Herschell; *Spalding v. Gamage* (1915) 32 R.P.C. 273 at page 284 per Lord Parker; *H.P. Bulmer Ltd. and Showerings Ltd. v. J. Bollinger SA* and

Champagne Lanson Pere et Fils (the Bollinger case) [1978] R.P.C. 79 at page 93-4 per Buckley L.J.”

The standard definition of goodwill is still that of Lord Macnaghten in *IRC v Muller & Co's Margarine Ltd* [1901] AC 217:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade. One element may preponderate here and another element there. To analyse goodwill and split it up into its component parts, to pare it down as the Commissioners desire to do until nothing is left but a dry residuum ingrained in the actual place where the business is carried on while everything else is in the air, seem to me to be as useful for practical purposes as it would be to resolve the human body into the various substances of which it is said to be composed. The goodwill of a business is one whole, and in a case like this it must be dealt with as such. For my part, I think that if there is one attribute common to all cases of goodwill it is the attribute of locality. For goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business, and the goodwill perishes with it, though elements remain which may perhaps be gathered up and be revived again."

Owing to the unfortunate short hand, reinforced by the drafting of the Act, reference is made to unregistered trade marks despite the case law that denies them (there are specific and different issues to deal with Community Trade Marks as per *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41). In "The Law of Passing-Off" (third edition) by Christopher Wadlow, the author is fairly dismissive of the idea that "mere" preparations for trading can create goodwill. The fact that the word mere is used in the heading is fairly indicative of the attitude to the issue. Reference is made to *Lawson v Bank of London* [1856] 139 ER 1296, *Amway v Eurway* [1974] RPC 82 and *Athlete's Foot v Cobra Sports* [1980] RPC 343 in support of his position. In the case of *Amway v Eurway* the plaintiff arranged interviews for prospective senior personnel and acquired a warehouse. However, there were no actual staff. In the case of *Athlete's Foot v Cobra Sports* there was only a possible franchisee in the United Kingdom. *Fletcher Challenge v Fletcher Challenge* [1982] FSR 1 is effectively dismissed by Mr Wadlow. The facts of that case are totally different to this case and it is an Australian case. I cannot see that PFM's case even approaches the cases referred to by Mr Wadlow. At the date of the application PFM cannot claim any goodwill in any business. Being on the register of Companies House does not generate goodwill, visiting a trade show with the possibility of purchasing equipment does not generate goodwill. Customers create goodwill, at the date of application PFM had no customers. **Consequent upon the above I have reached the conclusions that follow. At the date of application PFM did not have a goodwill in a business and so cannot claim a parallel or earlier goodwill to any that**

Garrison might have at the date of application. The registering of a company name, a domain name and visiting a trade show under the company name do not represent the behaviour complained of. The behaviour complained of is the intention, stated by making the application, of using the sign Pool FM in relation to various broadcasting services. It is Garrison's contention that such use is liable to be prevented by the law of passing-off, this is the behaviour of which it complains. Therefore, the material date in this case is that of the date of application for the trade mark. These findings bring me on to whether at the date of the application Garrison had a goodwill in the business in relation to the sign Pool FM.

36) Pumfrey J in *South Cone Inc v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 stated:

“27 There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28 Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

Professor Annand, sitting as the appointed person, in *Loaded* BL O/191/02, accepted that proof of goodwill could be accomplished by other means. There is objective proof of a business prior to the material date; from the invoices. Garrison had not started broadcasting but it had started its business, it was trading; the advertisements would be heard when the broadcasts were made just as in the case of a manufacturer goods will come after orders. The extent of the trade is limited, two customers, but it is a real trade. It represents the attractive force generated by custom. The nature of a local radio station working on a limited period licence means that trade is likely to be limited. There is also no contradiction of Garrison already having a business arising from its army radio stations, although not in relation to the same sign. Indeed all that Mr Anderson states confirms this. In relation to *Allen (WH) & Co v Brown Watson Ltd* [1965] RPC 191 and *The British Broadcasting Corporation v Talbot Motor Company Ltd* [1981] FSR 228 Mr Wadlow comments:

“In reality, neither *Allen v. Brown Watson* nor *B.B.C. v. Talbot* actually turned on the existence of goodwill. It is irrelevant to ask whether either advertising or actual use generated goodwill in the title or name itself, because the right protected by passing-off is not a right of property in a particular name or mark, but the goodwill in the plaintiffs' business as a whole. W.H. Allen was a long established business with ample goodwill. So was the B.B.C.”

In *BBC v Talbot* the Vice Chancellor held:

“I begin with the goodwill claimed by the BBC to have been built up in CARFAX as applied to their scheme. Although that scheme has not yet been launched, that does not prevent the BBC from having built up goodwill in it which is entitled to protection: see *W.H. Allen & Co. v. Brown Watson Ltd.* [1965] R.P.C. 191, where the title of an unpublished book was held to have become distinctive of that book, so that it could be protected against publication of a rival book under the same name. Here, there is ample evidence that a significant part of the public knew about the name CARFAX as distinctive of the BBC's system.”

Garrison starts off with already having a goodwill; more than that, it has established prior to the date of application a trade in relation to the sign Pool FM and so a goodwill in relation to this. The application is not limited to locally provided services but the reality of the dispute is that it relates to them. The specification will also cover local broadcasting services and so to that extent must be considered in relation to such services. Taking into account the nature of the business, and the proposed business and their localness, and bearing in mind *Stannard v Reay* [1967] FSR 140, I am of the view that at the date of application Garrison had a goodwill capable of protection in relation to the sign shown in paragraph 7 or Pool FM on its own; taking into account the nature of the business it is not a trivial goodwill that is not capable of protection as per *Hart v Relentless Records Ltd* [2003] FSR 36. It has not been determinative of my decision in any way, but it should be noted that the period for building up goodwill was severely shortened by PFM filing its application in what it appears to be a reaction to the publicity surrounding the launch of Pool FM by Garrison.

37) The goodwill that Garrison has is for radio broadcasting and production of programmes, even if no broadcasting had taken place at the date of the application. The trading with the advertisers had clearly taken place in relation to these basic services of a radio station. There is no dispute that these are similar/identical services to those of the application. There is no dispute to the similarity/identity of the signs. Confusion will be inevitable. Taking into account the identity/high degree of similarity of the sign and the trade mark and the identity/high degree of similarity of the goods, I have no doubt that three of the classic causes of damage would occur:

- Diverting trade from Garrison to PFM.
- Potentially injuring the trade reputation of Garrison if there were any failings in the services of PFM.
- By the injury which is inherently likely to be suffered by any business when on frequent occasions it is confused by customers or potential customers with a business owned by another proprietor or is wrongly regarded as being connected with that business.

(See *Habib Bank Limited v Habib Bank AG Zurich* [1982] RPC 1)

38) The opposition under section 5(4)(a) succeeds and the application is to be refused in its entirety.

Bad faith – section 3(6) of the Act

39) Section 3(6) of the Act states that:

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

In *Gromax Plastics Limited v. Don and Low Nonwovens Ltd* [1999] RPC 167 Lindsay J established what has become the basis of considerations of bad faith:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes 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.”

Sir William Aldous in *Harrison v Teton Valley Trading Co* [2005] FSR 10 made it clear that bad faith was not synonymous with dishonesty:

“20. Mr Silverleaf Q.C. who appeared for the applicant submitted that the words "made in bad faith" required that the application should be made "dishonestly". I reject that submission. If dishonesty was the test then that word would have been used in the 1994 Act and in the Directive. No doubt an application made dishonestly will be made in bad faith, but it does not follow that if dishonesty is not established, bad faith cannot have existed.”

Sir William Aldous also commented on how Lindsay J’s judgment was to be applied:

“33. The judge applied the statement of Lindsay J in *Gromax* which is cited above in paragraph 18. He was right to do so. The words "bad faith" are not apt for definition. They have to be applied to the relevant facts of each case. The test is the combined test and the standard must be that of acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area being examined. I stress "acceptable commercial behaviour" to exclude behaviour that may have become prevalent, but which would not upon examination be deemed to be acceptable”

It has now been confirmed that the test in relation to bad faith is not a subjective one, ie it is not based on what an applicant may consider acceptable behaviour. In *Ajit Newspaper Advertising, Marketing & Communications Inc v Sadhu Singh Hamdard Trust* BL O/004/06 Professor Annand, sitting as the appointed person stated:

“41. I believe the parties are agreed that the upshot of the Privy Council decision in *Barlow Clowes* is: (a) to confirm the House of Lords’ test for dishonesty applied in *Twinsectra*, i.e. the combined test; and (b) to resolve any

ambiguity in the majority of their Lordships' statement of that test by making it clear that an enquiry into a defendant's views as regards normal standards of honesty is not part of the test. The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of that knowledge, the defendant's conduct is dishonest judged by ordinary standards of honest people, the defendant's own standards of honesty being irrelevant to the determination of the objective element. I also bear in mind the observations of Lawrence Collins J. in *Daraydan Holdings Ltd v. Solland International Ltd* [2005] 4 All ER 73 at 93 concerning the affirmation of recent decisions of the Privy Council made by serving Law Lords after full argument."

(The reference to *Barlow Clowes* relates to (1) *Barlow Clowes International Ltd. (in liquidation)* (2) *Nigel James Hamilton and*(3) *Michael Anthony Jordon v (1) Eurotrust International Limited (2) Peter Stephen William Henwood and (3) Andrew George Sebastian* Privy Council Appeal No. 38 of 2004.)

40) Garrison claims that the application was made in bad faith because PFM was aware of Garrisons reputation and goodwill in relation to Pool FM at the time of the filing of the application and the application was made to hamper its use of its trade mark and to hamper its application for a permanent broadcasting licence to serve the Hartlepool area. The application was a spoiling tactic.

41) Taking into account the publicity in 'The Hartlepool Mail', Mr Anderson's contacting the press and the date of his application, I have no doubt that the application was made as a response to his becoming aware of the plans of Garrison. Prior to the publicity surrounding the launch of Garrison's radio station, PFM had been incorporated as a company and Mr Anderson had registered a domain name including Pool FM. Taking this into account and the claims that Mr Anderson has made about his intention to use Pool FM as a call sign, it could be considered that PFM was trying to protect its position rather than spoil that of Garrison. The radio station that PFM has run with temporary licences is called Radio Hartlepool FM rather than Pool FM. PFM's plans may have changed because of the dispute in relation to the name. In his evidence Mr Anderson does not state why the application was made despite the allegations of Garrison. In *The Athletes Foot Marketing Associates Inc v Cobra Sports Ltd and another* [1980] RPC 343 Walton J stated:

"Of course, again, it may very well have been that the defendants advanced their own use of the name when they realised, as a result of Mr. Parkin's "cautious conversation" that someone else was about to use their chosen name first. This would be ordinary commercial prudence. All this means legally is that they got their foot in the door first."

The above was a passing-off case. Taking into account Mr Anderson's previous actions, the application could be seen as an attempt to preserve a position in relation to use of Pool FM. That preservation might spoil the position of Garrison but that does not stop it being a defensive reaction. It could be seen as showing "ordinary commercial prudence". I cannot see that it was not acceptable commercial behaviour;

it appears to be reasonable reaction in the circumstances. **I dismiss the grounds of opposition based upon section 3(6) of the Act.**

COSTS

42) Garrison Radio Ltd, having been successful, is entitled to contribution towards its costs. I order Pool FM Limited to pay Garrison Radio Ltd the sum of £1950. 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 28th day of April 2006

**David Landau
For the Registrar
the Comptroller-General**