

O-094-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2440001
BY LOLLIPOP UK LIMITED
TO REGISTER THE TRADE MARK:**

**DROP
BEATS
NOT BOMBS**

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION NO 95221
BY DAVID WHITTALL**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2440001
By Lollipop UK Limited
to register a trade mark in class 25**

and

**IN THE MATTER OF Opposition No 95221
By David Whittall**

Background

1. Lollipop UK Limited ("*Lollipop*") applied for its trade mark on 29 November 2006. Registration is sought for clothing, footwear and headgear. The trade mark itself is:

**DROP
BEATS
NOT BOMBS**

2. Registration is opposed by Mr David Whittall on grounds under sections 3(6) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Mr Whittall's claim under section 5(4)(a) arises because DROP BEATS NOT BOMBS is the name of his company and that it is has been used by him (since 2001) as the name of a twice-yearly music festival (with such use extending to promotional material and t-shirts). Under section 3(6), Mr Whittall claims that *Lollipop* would have been aware of his use and, therefore, *Lollipop's* application was made in bad faith.

3. Both sides filed evidence (this is summarised below) and the matter came to be heard before me on 23 January 2009. At the hearing, *Lollipop* were represented by its director, Mr Perry Andre. Mr Whittall did not attend the hearing, however, he did file written submissions which I will take into account.

Mr Whittall's evidence

4. Mr Whittall gives evidence by way of witness statement. He states that he has been organising music events as "Drop Beats Not Bombs" since November 2002. He lists the dates on which such events have taken place and provides the flyers that were produced to promote them (Exhibits DW1 through to DW11b). Eleven events have taken place (or in the case of event 8, planned to take place), all in Birmingham, on the following dates:

- 1) April 2003
- 2) 03/9/2003

- 3) 20/3/2004
- 4) 27/11/2004
- 5) 30/4/2005
- 6) 03/12/2005
- 7) 26/4/2006 - 30/4/2006 (a four day event)
- 8) 11/11/2006 (this event, although advertised, was cancelled)
- 9) 04/5/2007 - 06/5/2007 (a three day event)
- 10) 14/9/2007
- 11) 10/11/07

5. Mr Whittall states that the domain name www.dropbeatsnotbombs.co.uk was registered to him on 9 August 2005. A letter confirming registration is shown in Exhibit DW12. Exhibits DW13 and DW14 are a bank letter and copy of a cheque book which shows that Mr Whittall's business account is called DROP BEATS NOT BOMBS.

6. Evidence is then given in relation to t-shirts that were produced for the DROP BEATS NOT BOMBS events. Mr Whittall states that for the first two events, crew t-shirts were produced by a local printing company called *MissionPrintWear Ltd*. He states that members of the public asked if such t-shirts were available for sale. As a result of this, Mr Whittall states that t-shirts were subsequently manufactured and sold. The first event at which sales took place was the event in April 2004 (I note that the earlier evidence does not list an April 04 event, it is listed as 20 March 2004) and sales have continued at every event since. Exhibits DW15-DW24 are images of the different t-shirt designs produced. All of the designs feature the words DROP BEAT NOT BOMBS in some way on the front of the t-shirt. Mr Whittall states that the t-shirts are sold to the general public and are not merely promotional items. Exhibit DW25 is an invoice (dated 28 April 2005) from the t-shirt supplier, the invoice lists 35 "crew" t-shirts and 50 "Punter" t-shirts.

7. Reference is then made to Exhibit DW26 which consists of an extract from *DJ Mag*, a nationally distributed music magazine. The extract contains an article entitled "Top 10 Nights in the Land" and it lists DROP BEATS NOT BOMBS as number 9. Mr Whittall states that this highlights that the name has been used and that it has a considerable reputation within the UK.

8. Mr Whittall completes his evidence by referring to Exhibit DW27. This consists of a photograph of a musician called MC Angel (who has appeared at his events). She is sporting a DROP BEATS NOT BOMBS t-shirt. Mr Whittall states that she chose to purchase this *Lollipop* t-shirt because she believed that it was affiliated to the DROP BEATS NOT BOMBS events.

Lollipop's evidence

9. *Lollipop's* evidence (by way of two witness statements) is given by its director, Mr Perry Andre. He states that the trade mark DROP BEATS NOT BOMBS was first used in the UK in 2006. Exhibit L1 consists of a screen shot from the *Adobe Illustrator* software package showing the sign DROP BEATS NOT BOMBS (stylised as per the application). He states that the "date of creation" is carried on this document. The only date is a "date modified" date of 18 October 2006, but I take this

to be the date of creation to which Mr Andre refers. Exhibits L2a, L2b and L2c show further screenshots for what Mr Andre describes as “original slogan designs” for PICK FLOWERS NOT FIGHTS, BLOW BUBBLES NOT BOMBS and BUST STYLES NOT MISSILES.

10. Mr Andre states that all of these “designs” were created by him. He states that the “design” DROP BEATS NOT BOMBS was first used on 19 October 2006, exclusively on t-shirts. Exhibit L3 contains physical samples of the t-shirts in *Lollipop’s* range, four of which prominently carry the words DROP BEATS NOT BOMBS. I note that both the swing tag and the neck label carry the sign LOLLIPOP and not the words DROP BEATS NOT BOMBS.

11. Exhibits L4 and L5 contain copy invoices from the companies *The Magic Touch* and *Continental*. The *Magic Touch* invoices relate to purchases (by *Lollipop*) of transfer paper and toner. They range in date from 4 September 2006 to 9 November 2006. The *Continental* invoices are for the purchase (by *Lollipop*) of t-shirts. They range in date from 25 September 2006 to 17 November 2006. Mr Andre explains that the DROP BEATS NOT BOMBS t-shirts were “heat pressed” (using the transfer paper) on to blank t-shirts (from *Continental*). He explains that later on (the date is not specified), screen printing was instead used. I note that only the *Lollipop* name appears on these invoices.

12. Mr Andre states that the sales of goods before the application date (in the period 19/10/06 to 29/11/06) were £19931.56. It is not clear whether this relates to the DROP BEATS NOT BOMBS t-shirt, or, alternatively, to the range of *Lollipop’s* t-shirts. The sales were generated by *Lollipop’s* t-shirt concession in *Top Shop*, Oxford Circus. A “set up form” between *Lollipop* and *Top Shop* is shown in Exhibit L6 relating to this concession. It shows that the concession was launched on 11 June (no year is stated). Various invoices relating to the *Top Shop* sales (prior to 29 November 2006) are provided in L7. This is not broken down by t-shirt range.

13. Reference is then made to the amount spent on promotion of the goods prior to the date of application. This is said to be £5767.29 between 19/10/06 and 29/11/06. This was paid to *Top Shop*, Mr Andre explaining that a concession fee of 34% net sales was paid and that this helped to promote the goods within *Top Shop*, Oxford Circus, which has an estimated foot fall of 200,000 people per week. He refers to other promotion via an ITV2 programme called WAGS Boutique. He supplied t-shirts (at cost price) which featured in this programme. An invoice to the show produces is provided in Exhibit 8. Press exposure relating to this programme is shown in Exhibit L9 which shows footballers’ wives wearing the *Lollipop* t-shirts including DROP BEATS NOT BOMBS; reference is made to *Lollipop* as the supplier. Further press exposure is shown in L10-O15. These include national newspaper articles featuring the *Lollipop* t-shirts, some, but not all, are for DROP BEATS NOT BOMBS. Some, but not all, mention *Lollipop*. These articles carry dates in 2007 or carry no date at all.

14. Mr Andre states that *Lollipop* won an award from *Top Shop* for its t-shirt collection (Autumn/Winter 2006). He states that DROP BEATS NOT BOMBS t-shirts have been sold in *Top Shop* stores in Oxford Circus, York, Glasgow, Canterbury & Dublin and in *New Look* stores in Aberdeen, Hemsel, Hastings, Bolton, Stirling,

Lancaster, Craigleith, Coventry, Burrow-in Furness, Doncaster, Chichester, Manchester, Nottingham, Belfast and Torquay. He also refers to direct wholesaling to independent retail chains *Bank Fashion*, *CULT Clothing*, *Ark Clothing*, *Triple S Clothing*, *Moist Clothing*. Various towns are listed where the DROP BEATS NOT BOMBS t-shirts have been sold via these chains.

15. Mr Andre then gives submissions rather than factual evidence. These centre on the fact that Mr Whittall's club-night has no national reputation (being confined to Birmingham) and that even in Birmingham it may not be well known. He states that all of his t-shirts carry a LOLLIPOP swing ticket (Exhibit L17) which associates the goods with *Lollipop* and that the name (given *Lollipop's* own use) is associated with his company.

16. Mr Andre's second witness statement gives, for the most part, submissions (including a critique of Mr Whittall's evidence) rather than being evidence of fact or, alternatively, it repeats some of the evidence he gave earlier. He does, however, categorically state in this second witness statement that he had no knowledge of Mr Whittall's event when he made his application for registration. He also states that he undertook a search of the IPO¹ web-site before submitting the application and that he filed applications for all of his successful slogans.

The section 3(6) ground of opposition – bad faith

17. Section 3(6) of the Act reads:

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

18. The standard underpinning bad faith was set out in *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] R.P.C. 367. It includes dishonesty but also includes dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. However, whether *Lollipop's* standard of behaviour in making its application fell below this standard can only be assessed on the basis of what it (or more correctly its directors etc.) knew about Mr Whittall's business. A useful summary of all this was given by Ms. Anna Carboni (sitting as the Appointed Person) in *OTO*, BL O/157/08 when she stated:

“120. To summarise the guidance given by the English courts and United Kingdom Appointed Persons, one must ask what the Applicant knew when it applied to register the Marks (the subjective element) and whether, in the light of that knowledge, its decision to apply for registration would be regarded as in bad faith by persons adopting proper standards (the objective element). The applicable standard for the objective element of the test is acceptable commercial behaviour in the eyes of a reasonable and experienced person standing in the shoes of the Applicant. My job is to try to be that person.”

¹ Intellectual Property Office

19. On the basis of the above, I must firstly assess what *Lollipop* knew about Mr Whittall's use of DROP BEATS NOT BOMBS when the application for registration was made. In this respect, I consider it fair to make the assessment on the basis of Mr Andre's knowledge as, from his evidence, he is a director of *Lollipop* and is the major (perhaps only) player within the company. Furthermore, from his evidence, he appears to be the person who made the application for registration.

20. It is clear from Mr Andre's evidence that he claims to have known nothing about Mr Whittall's use when *Lollipop's* application was made. Mr Andre makes various statements to this effect in his evidence, such as:

"I had no knowledge of Mr Whittall's Drop Beats Not Bombs event and did not file an application for Drop Beats Not Bombs in bad faith."

and

"We believe that people all over the UK, like ourselves, would not have been aware of David Whittall's events...."

and

"I originated Drop Beats Not Bombs completely and independently for use on t-shirts"

21. In his written submissions, Mr Whittall states:

"a cursory glance of the term drop beats not bombs on any internet search engine generates literally thousands of website hits referring to my events and the brand name Drop Beats Not Bombs. A man of Mr Andre's experience and intelligence would undoubtedly have utilised such a search engine and would definitely have been aware of my company"

and

"I would also ask why it is that Mr Andre is only trying to gain the trade mark for Drop Beats Not Bombs and not for any of the other slogan t-shirts he produces."

22. Mr Whittall is clearly challenging Mr Andre's evidence. However, I must bear in mind what Mr Richard Arnold QC (sitting as the Appointed Person) stated in *EXTREME* [O-161-07], namely:

"Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence."

23. Mr Whittall has not requested that Mr Andre be cross-examined on his evidence. Mr Whittall's challenge was made in the form of written submissions shortly before the hearing that took place before me. This cannot constitute advance notice. There is nothing incredible in Mr. Andre's evidence. On this basis, I must, therefore, accept what Mr Andre has said regarding his state of his knowledge. There is, in any event, further support for Mr Andre given that he was clearly engaged in creating a series of slogans for use on t-shirts all of which appear to carry an anti-war message. There is, therefore, nothing particularly surprising in the independent adoption of the name in question given these circumstances. The fact that *Lollipop* may have only applied for DROP BEATS NOT BOMBS and not its other slogans (although Mr Andre disputes this) does not shed any further light on the matter.

24. It may be true that *Lollipop* should have carried out an Internet search. However, failure to do so cannot, in itself, be classified as an act of bad faith. It is not as though *Lollipop* were trying to shield itself from discovering something that they did not wish to know. In any event, even if it did carry out an Internet search, there is no evidence to show what would have been discovered. Mr Whittall refers to "the thousands of web-site hits" but none of this has been filed in evidence. Even if the worst case scenario was true and Mr Andre did know of the music event being run in Birmingham, this does not, in any event, strike me as an act of bad faith given the goods he seeks to register.

25. For all of the above reasons, the ground of opposition under section 3(6) of the Act fails.

The section 5(4)(a) ground of opposition – passing off

26. Section 5(4)(a) of the Act reads:

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

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

(b)

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

27. There are three elements (often referred to as "the classic trinity") to consider in a claim for passing-off, namely: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position quite succinctly when he stated:

"The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must

establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff...Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

28. For the benefit of both parties, neither of whom have professional representation, the tort of passing-off protects not the name itself but the property in the business or goodwill that it is likely to be injured by a relevant misrepresentation. It is not, therefore, a question about the proprietorship of the name. In terms of the relevant misrepresentation, this relates to the deception of a substantial number of persons (see the findings of the Court of Appeal in *Neutrogena Corporation and Anr. V. Golden Limited and Anr.* [1996] R.P.C. 473). In relation to damage, it is also useful to consider the comments of Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 where he stated that the claimant must prove:

"That he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill attaches."

At what date should I assess this claim?

29. I must firstly decide the date at which I should assess Mr Whittall's claim. I will refer to this as the "material date". A number of cases² have established that the material date is the date on which the conduct (in this case *Lollipop's* conduct) is first complained of. I also bear in mind that section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 which states:

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

30. On the basis of the above, the date complained of can be no later than the date on which *Lollipop* applied for its trade mark. It can, however, be from before the date of application in appropriate circumstances. An appropriate circumstance could be

² *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] R.P.C. 429 and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2004] R.P.C. 8 and 9

Lollipop's pre-application use. On this, Mr Andre states that the trade mark has been used since 19 October 2006, namely, one month and 10 days before the making of its application for registration. However, it is not clear from Mr Andre's evidence whether these goods were sold from 19 October 2006 or whether sales started later. It seems difficult, if the name was created on 18 October (Exhibit L1), for the goods to have started to be sold the next day. Further doubt relates to the sales figures in the period 19/10/06 to 29/11/06 as it is unclear whether this relates to the DROP BEATS NOT BOMBS t-shirts or to *Lollipop's* full t-shirt range. The invoices (Exhibit L7) filed in support of the turnover make no mention of DROP BEATS NOT BOMBS and does not differentiate between t-shirt type.

31. Whilst it may be true that the DROP BEATS NOT BOMBS t-shirt was made available for sale prior to the application date, it is difficult, on the basis of the evidence before me, to accurately assess the timing and significance of this. For all these reasons, I must conclude that the material date should be the date of *Lollipop's* application. I should add that although this gives Mr Whittall an additional one month and 10 days of potential goodwill to rely on, I doubt, in the context of the evidence presented, that this will make much of difference to the outcome. **The material date is 29 November 2006.**

Did Mr Whittall's business have a goodwill at the material date?

32. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as follows:

"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."

33. Although the above statement comes from an old case, it was utilised by the Court of Appeal in *Phones 4u Ltd v Phone4u.co.uk Internet Ltd*, [2007] R.P.C. 5, so it still holds true today. It should also be noted that to qualify under the law of passing off, the goodwill must be of more than a trivial nature (see the decision in *Hart v Relentless Records* [2002] EWHC 1984). However, being a small player does not rule out possession of goodwill (see *Stacey v. 2020 Communications Plc* [1991] F.S.R. 49) neither does trading in a localised (as opposed to national) manner (see *CHELSEA MAN Trade Mark* [1989] RPC 111).

34. Mr Whittall is clearly running a business (see Exhibits DW13 & DW14) which consists, essentially, of organising a music event. The first event took place in April 2003 and has continued, twice yearly, up to the material date. Although this cannot be described as particularly long-standing use, it is, none the less, a reasonable history. However, what strikes me most about the evidence is that no attendance figures have been provided nor any turnover figures. Therefore, I have no information as to the success, or otherwise, of the event. This makes it difficult to deal with questions regarding goodwill, not only regarding whether it exists or not, but also regarding its size and nature; the latter two points being important when considering misrepresentation.

35. The promotional flyers that have been issued for each event have been provided in evidence (exhibits DW1 through to DW11b). Although there is no evidence as to the amount of flyers that were distributed, they at least show that the events featured multiple performers, and some (particularly those from April 2005 onwards) list multiple establishments where tickets could be purchased. Whilst addressing the content of the flyers, I also observe that in some of them (DW1 & DW7) the use of the words DROP BEATS NOT BOMBS strikes me not as any sign pointing towards the name of the event itself, but merely as an anti-war message. The flyers in DW7b, c & d do not carry the name at all. Nevertheless, the references to DROP BEATS NOT BOMBS in DW2, DW3, DW4, DW6, DW6 & DW8 are likely to be taken as the name of the event. The flyers for events beyond DW8 are from after the material date so I cannot take them into account for the purpose of establishing a goodwill. I also note that all of the events appear to have taken place in Birmingham.

36. There is also the reference in *DJ Mag* (Exhibit DW26). Mr Whittall suggests that this highlights that the name has been used and that it has a considerable reputation within the UK. Whilst I agree that this supports that the name has been used, it does not, in my view, support a considerable reputation. The writer of the "Top 10 Nights in the Land" may simply be listing his own personal preferences in order to recommend events to the magazine's readers, it does not, necessarily, reflect a more general reputation (or even a knowledge) by the public at large, even for the public who enjoy the type of music concerned. Even though this article may have been read by the readers of *DJ Mag*, without this being followed up with further promotion on a national scale it is unlikely to have had a significant impact. I should add that the date of this publication is not at all clear, however, I have been able to see that the night referred to for DROP BEATS NOT BOMBS is 30 April. Whilst the year is not given, it is clear from Mr Whittall's evidence that the only event that has taken place on a 30th April was the event in 2005; this, therefore, places the article prior to the material date.

37. I must consider the evidence in totality. Having done so, I am prepared to accept that the business of Mr Whittall would have generated a goodwill and that the words DROP BEATS NOT BOMBS is the sign which is used to identify this business. Whilst the evidence provides little to assist me in assessing the size of its goodwill, it certainly strikes me as more than trivial. The goodwill is in the nature of a small (the lack of evidence means that I cannot infer anything greater) music event run in the Birmingham area. The event, from what I can see, relates to DJ/Clubbing type music. Any goodwill is likely to exist only in the Birmingham area and would be limited to a sub-set of the general public that have an interest in the type of music I have identified.

38. In relation to t-shirts, the evidence clearly shows that some have been produced for sale at Mr Whittall's events. However, there is, again, a lack of evidence in terms of actual sales and turnover in relation to these goods. One invoice (DW25) from April 2005 relates to 50 "punter" t-shirts. These were presumably offered for sale at the event that took place around that time. Whether this represents the totality of the t-shirts that were sold at the event, or, indeed, whether all 50 were actually sold, is not set out in the evidence. I also take the view that the use of the words DROP BEATS NOT BOMBS is placed on the t-shirts primarily in order for the event goer to be able to purchase a memento of his visit to the event. There is no evidence of a

separate trade in t-shirts distinct from sales at the event. There is no evidence to suggest that the t-shirts carry a DROP BEATS NOT BOMBS swing tag or neck label. Given this, and given what I can only find to be the small nature of t-shirts sales, I come to the view that Mr Whittall's business has no separate and independent goodwill in relation to a trade in t-shirts. Nevertheless, for some (but not necessarily all) of those who have attended Mr Whittall's events, they may know that t-shirts are also sold in conjunction with the event itself.

Is there a relevant misrepresentation and damage?

39. I have touched on the relevant tests in paragraphs 27 & 28 above. To summarise, I must be persuaded that a substantial number of persons will be deceived into believing that *Lollipop's* t-shirts (or other articles of clothing) are actually the responsibility of Mr. Whittall's business and, as a result of this, substantial damage will be caused to Mr. Whittall's business. Such deception need not be intentional, it can be caused by an innocent trader. The localised nature of the goodwill (to Birmingham) is a factor to consider, but this does not, in itself, rule out misrepresentation. This is particularly so given that *Lollipop's* application is for a national registration and is not limited away from the Birmingham area. Use of *Lollipop's* mark must, therefore, be notionally taken into account which includes use in the Birmingham area. Indeed, from Mr Andre's evidence, it is clear that his goods are now being sold in Birmingham (through *Bank Fashion & CULT Clothing*).

40. The nature of the sign is another important factor to consider. The words DROP BEATS NOT BOMBS will be seen as a slogan with an anti-war message rather than a more traditional sign of trade origin. The tort of passing-off can be utilised to protect distinctive slogans whereas non-distinctive slogans are generally not. However, it is not always black and white. A slogan with weak or low distinctive character (even if not completely lacking in distinctiveness) is an important factor to consider amongst all the other relevant factors. To my mind, the anti-war message is clear. It encourages the dropping of beats (a musical reference) rather than bombs. I am not saying that the sign cannot function as a trade mark, but it, nevertheless, strikes me as the sort of sign that other traders may well come up with independently to promote their goods. This, therefore, lessens the likelihood of a consumer who is aware of the DROP BEATS NOT BOMBS events being deceived into believing that goods in a different field are the responsibility of the event organiser.

41. In relation to the goods and services being considered, the fact that I have found Mr Whittall's (small) goodwill to exist in relation to the musical event rather than t-shirts per se does not, in itself, prevent him from succeeding. There is no requirement in passing-off for goods or services to be similar. However, in *Harrods Ltd v Harrodian School* [1996] RPC 697 Millett LJ stated:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”
and

“The name "Harrods" may be universally recognised, but the business with which it is associated in the minds of the public is not all embracing. To be known to everyone is not to be known for everything.”

and

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

42. In relation to the goods and services here, whilst Mr Whittall has shown that he sells some t-shirts at his events, and whilst I am prepared to accept that this will happen for other musical events, there is no evidence to suggest that it is common for undertakings who provide musical entertainment services to provide t-shirts as a distinct trade, distinct from the actual event taking place. Whilst the provision of t-shirts at musical events creates something of a link, the link cannot be particularly strong if such goods are only ever sold at the event itself.

43. In relation to deception, Mr Whittall referred in his evidence to MC Angel who, apparently, chose to purchase a *Lollipop* t-shirt because she believed that it was affiliated to the DROP BEATS NOT BOMBS event. There are three problems with this evidence. Firstly, the evidence is given by Mr Whittall and not by MC Angel. This means that the evidence is, essentially, hearsay evidence. Secondly, a point compounded by the previous point, there is little by way of explanation to demonstrate the circumstances under which she purchased the t-shirt and her full impressions and assumptions. Thirdly, even if I could place more weight on this evidence, it is, at the end of the day, only one person’s opinion. This may not, therefore, be the common reaction of the public to seeing *Lollipop’s* goods. For all these reasons, this evidence is of little assistance.

44. Mr Andre highlighted at the hearing that the brand managers at *Top Shop* would have not have stocked his t-shirt if they thought that there was any dispute in the offing and, furthermore, that the foot fall around Oxford Street was very large and, despite this, no one highlighted any form of deception. These comments, also, are of little assistance. I do not know what degree of “due diligence” *Top Shop* has gone through, furthermore, the fact that they did not identify a problem themselves is neither here nor there. In relation to absence of deception, this is always a difficult proposition because a consumer may not know that they have been deceived because the deception is so complete. However, the position is starker here because, as identified earlier, any goodwill that Mr Whittall possesses seems to me to exist in the Birmingham area (and to a particular sub-set of the general public), therefore, use in London is unlikely to have generated much, if any, opportunity for deception.

45. Mr Andre also highlighted that given the extensive press coverage and sales of *Lollipop’s* goods then this will, now, rule out the possibility of deception with Mr Whittall’s more limited business. I understand the argument, however, the fact remains that the matter must be judged at the material date, by which time only limited use had been made (as a t-shirt slogan rather than a sign of trade origin) and

it is not clear whether the evidence relates purely to DROP BEATS NOT BOMBS or to the full range of *Lollipop's* goods. The use does not, therefore, assist greatly on this point.

46. A further consideration when deciding whether a substantial number of persons would be deceived is the normal nature of trade in relation to articles of clothing. I must assess this on the basis of notional use rather than merely limiting my analysis to, for example, sales in *Top Shop*. I must consider a range of uses including use in high street stores, in supermarkets, on clothing web-sites etc. Mr Whittall sells his t-shirts at his music events, if *Lollipop's* goods were sold at the same events then there would, inevitably be deception. However, this does not strike me as a notional circumstance to which I should give much significance, firstly because this does not strike me as a typical or normal route for a clothing manufacturer to get his goods to market and, secondly, it seems to me unlikely that this circumstance could ever arise and to count potential misrepresentation on this basis would be focusing the question far too narrowly (and artificially).

47. As I have said earlier, I must consider the position in relation to possible misrepresentation in the Birmingham area. Whilst this is fully legitimate, this, straightaway, reduces the numbers of members of the public and the prospect of finding substantiality. Furthermore, I have found that the music event run by Mr Whittall is only a small affair and, therefore, the degree of knowledge even in the Birmingham area may not be great and, where it is known, it is only likely to be known by a subset of the public who are interested in this type of music. This further reduces (but does not rule out) the prospect of a substantial misrepresentation. I also take the view that even those members of the public who know of the DROP BEATS NOT BOMBS music events (and even those who know that t-shirts are also sold at the events) will not necessarily be led, if they encountered a t-shirt sold under the sign DROP BEATS NOT BOMBS in a normal trading activity (as described in the preceding paragraph), to believe that such goods are the responsibility of Mr Whittall's business. This is because the sign itself is not particularly distinctive, sending, as it does, an anti-war message, and, furthermore, the nature and size of Mr Whittall's events would not engender a belief that Mr Whittall's business has branched out into a normal t-shirt trading activity. In my view, this will be the view of the vast majority. There may be a minority who believe that there is some form of economic link or affiliation, however, given the small localised goodwill that exists to a sub-set of the public, this can not, in my view, constitute a substantial number of persons as required under the law. Most will put down the sharing of the name to a co-incidental happening on the choice of the same anti-war message underpinning the mark. Mr Whittall's business may be brought to mind, but not to the extent that the majority would assume a connection. Without the required misrepresentation there can be no substantial damage of any kind. I should add that, although I have focussed on t-shirts in my primary reasoning, Mr Whittall can be in no better position in relation to other items of clothing.

48. As mentioned earlier, the law of passing-off is not concerned with the rights of the name itself and who may or may not have created it, it is a question of whether Mr Whittall's business will be damaged by a belief that *Lollipop's* goods are those of Mr Whittall – for all the reasons given above, this is not made out. **The ground of opposition under section 5(4) of the Act fails**

Costs

49. *Lollipop* has been successful and is entitled to a contribution towards its costs. I hereby order Mr. David Whittall to pay Lollipop UK Limited the sum of £900. This sum is calculated as follows:

Considering notice of opposition	£150
Filing counterstatement	£200
Considering Mr Whittall's evidence	£150
Filing evidence	£300
Preparation for, and attendance at, the hearing	£100
Total	£900

50. It should be noted that when calculating the above costs, I have taken into account the fact that *Lollipop* has not been legally represented and the guidance given by the Appointed Persons on the relevance of this factor³.

51. The above sum should 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 7th day of April 2009

**Oliver Morris
For the Registrar
The Comptroller-General**

³ See the decisions of Mr Simon Thorley QC in *Adrenalin* (BL O/040/02) and Mr Richard Arnold QC in *South Beck* (BL O/160/08).