

O/110/12

TRADE MARKS ACT 1994

APPLICATION No. 2497223B

BY THE FLYING MUSIC COMPANY LIMITED

TO REGISTER THE TRADE MARK 'THRILLER LIVE' IN CLASSES 9 & 41

AND

OPPOSITIONS Nos. 99636 & 99638

BY TRIUMPH INTERNATIONAL INC. & JOHN BRANCA AND JOHN

McCain AS SPECIAL ADMINISTRATORS OF THE ESTATE OF THE LATE

MICHAEL JACKSON

THE BACKGROUND AND THE MATTERS IN DISPUTE

1. On 10 September 2008, The Flying Music Company Limited applied to register THRILLER LIVE as a trade mark for:

Class 09:

Recordings of live entertainment shows; recordings of sounds and images in any media; carriers of audio signals and/or video signals; film recordings; recordings of music; audio and video cassettes; compact disks; DVDs; CD ROMs; computer software relating to music; computer games software; computer games; digital music (downloadable) provided from the Internet; video recordings (downloadable) provided from the Internet; downloadable electronic publications provided on-line from databases or the Internet; electronic publications in any media; downloadable artwork provided on-line from databases or the Internet; electronic artwork in any media; screensavers; background artwork for electronic displays; all of the above relating to live entertainment consisting of popular music songs.

Class 41:

Theatrical and show business entertainment services; entertainment services in the form of musical theatre; entertainment services; production of musicals and any and all adaptations thereof; production of sound recordings, concerts, dramas, stage shows, television programmes and films; theatrical, musical, television and film entertainment services; ticket agency services; providing theatre facilities; presentation of live performances; providing entertainment information; providing education regarding music, musicals and the theatre; information relating to entertainment provided on-line from a computer database or the Internet; publication of books, texts and journals on-line; providing digital video and audio recordings (not downloadable) via a computer network such as the Internet; providing on-line electronic publications (not downloadable) on-line from databases or the Internet; providing electronic images and artwork (not downloadable) on-line from databases or the Internet; all of the above relating to live entertainment consisting of popular music songs.

2. On 12 October 2009, two oppositions were filed against the application. The first was from John Branca and John McCain as Special Administrators of the Estate of the late Michael Jackson. The second was from Triumph International, Inc., which is a company incorporated in California to which Michael Jackson is said to have assigned any trade mark rights he held in THRILLER in 1984. The grounds of the oppositions are identical. In summary, they are that:

- i) THRILLER is work of pop music, dance and video (“the Work”) created by Michael Jackson. A pop album and accompanying video were released under that name in the UK in 1982 and has been sold continuously ever since. It quickly became the best selling album of all time. The album was re-released in “special edition format” in 2001 and as a 25th anniversary edition in 2008.

- ii) The work has been merchandised in the UK and elsewhere on a substantial scale through the sale of costumes, clothing, hats, belts, buckles, mugs, plates, glasses, wallets, pocket books and bags.
- iii) The goodwill associated with the work and associated merchandise is owned by Triumph International Inc., a company that was wholly owned by Michael Jackson and now by his Estate.
- iv) The application covers goods produced by Michael Jackson as well as goods and services which would have been obvious areas for expansions of his trade.
- v) An effect of granting the application could be to deny the opponent the right to continue to sell the album and to commercialise it for a range of goods and services.
- vi) The applicant is engaged in an unauthorised West End musical called THRILLER LIVE, which is a story of Michael Jackson's life illustrated by his songs. The applicant's use of the mark would mislead consumers as to the commercial origin or authenticity and approval of the goods and services covered by the application.
- vii) Use of the mark would therefore be contrary to the law of passing off and registration should therefore be refused under s.5(4)(a) of the Act.
- viii) Further, THRILLER is a well known mark protected in the UK under s.56 of the Act. Consequently, registration should be refused:
 - a. under s. 5(2)(b) of the Act because the THRILLER mark is well known for the Work and the applicant's goods and services are similar and there is a likelihood of confusion;
 - b. under s.5(3) of the Act because the applicant's use of THRILLER LIVE would, without due cause, take unfair advantage of the well known mark by "riding on its coat tails", and it would dilute the distinctiveness of the mark and severely limit the opponents legitimate marketing of the Work in ways that would be natural and usual having regard to the nature of the Work.
- ix) Further still, the applicant was aware of the fame associated with the album and associated media and merchandise and that it was owned by Michael Jackson, who was still alive when the application was made, or by an entity connected with him. The application was therefore an attempt to monopolise the

intellectual property of another and was made in bad faith, contrary to s.3(6) of the Act.

3. The applicant filed counterstatements denying the grounds of opposition and putting the opponents to proof of any goodwill and reputation under the name THRILLER or that the name attracted any trade mark rights. The applicant claims that the name THRILLER has only been used as the title of a copyright work, that the copyright work is not owned by the opponents, and in any event, no copyright can be claimed in the title of a work. I note, in particular, that:

“It is denied that the opponent has a right to prevent third parties from performing the song known as Thriller, because the opponent does not own any trade mark rights or copyrights in the music or lyrics of the song Thriller”.

4. The proceedings were consolidated.

5. I understand that two oppositions were filed so as to remove any doubt that one or other of the opponents was entitled to claim to be the owner of any trade mark rights in THRILLER. I am satisfied that if there are any trade mark rights, they must be owned by one or another of the opponents. Consequently, I will hereafter treat the oppositions as one.

THE EVIDENCE

6. The opponents' evidence is contained in a witness statement by John Branca. Mr Branca is the co-executor of the estate of the late Michael Jackson. Mr Branca provides a copy of an assignment *nunc pro tunc* which purports to assign any trade mark rights that Michael Jackson owned in THRILLER to Triumph International Inc. The assignment was completed in August 2011, after Michael Jackson died, but claims effect from March 9, 1984.

7. Mr Branca describes Mr Jackson's career, but it is so well known that it needs no repeating here. Exhibits 3 and 14 to Mr Branca's statement provide support for the opponents' claim that THRILLER is the best selling music album of all time. I note, for example, that exhibit 3 includes a copy of an article from the Daily Telegraph website dated June 2009 which records that THRILLER sold 109 million copies worldwide, the only album to exceed 100 million sales. Mr Branca states that Michael Jackson sold over 200 million albums worldwide during his career. This suggests that THRILLER accounted for around half of the albums bearing his music.

8. The album was released in 1982. The title single from the album was released in 1983 and was supported by a video featuring the song, dance routines and a storyline in the horror genre. Mr Branca says that the album won a Grammy award in 1984 for best album. In the same year the THRILLER album won a Brit award for 'Best Selling Album'. The following year the THRILLER video also won a Grammy award. The THRILLER album

was re-released in special format in 2001 and again as a 25th anniversary edition in 2008.

9. According to Mr Branca, Michael Jackson performed numerous sell-out concerts throughout the UK. During the 'Bad World' tour in 1988, Mr Jackson played seven concerts at Wembley to 504k people. In March 2009, Mr Jackson announced plans for a 50 date residency at London's O2 Arena, due to commence July 2009. The 750k tickets sold out within days.

10. In March 2010, Mr Jackson's estate entered into a record deal with Sony Music reportedly worth \$200-250m. The agreement licensed Sony Music to produce 10 new albums of Michael Jackson songs, including his back catalogue and also previously unreleased songs. Mr Branca says that the agreement also gives Sony Music the right to exploit Mr Jackson's music in video games and theatrical performances.

11. Also after Mr Jackson died (and therefore well after the date of the opposed application), Triumph International Inc. authorised licences for world wide sales of THRILLER merchandise, including bags, clothing, belts, buckles and posters. Additionally, the song THRILLER was included in the music video game, 'Michael Jackson, The Experience', which was sold "*in Europe*".

12. Mr Branca says that he is aware that the applicant is the producer of a musical production called THRILLER LIVE that has been staged in London since at least 2 January 2009. Mr Branca notes that such musicals have become common in recent times and are often named after a famous song of the artist or group concerned. In this respect he cites 'We Will Rock You' (a long running musical based on the music of Queen), 'Mamma Mia' (a musical based on the music of Abba) and others. According to Mr Branca, the public expect such shows to be connected with, or endorsed by, the artists concerned.

13. The applicant filed no evidence, but written submissions were received on its behalf.

THE HEARING

14. The matter came to be heard on 16 January 2012 when the opponents were represented by Mr James Abrahams of Counsel, instructed by Arnold and Porter (UK) LLP. The applicant was not represented, but I will take account of the written submissions filed on its behalf.

THRILLER – WELL KNOWN MARK?

15. Section 5(2) and (3) of the Act are as follow:

- (2) A trade mark shall not be registered if because -
- (a) -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3) A trade mark which –
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

16. Section 6(1)(c) of the Act is as follows:

6. - (1) In this Act an “earlier trade mark” means -
(a) -
(b) -
(ba) -
(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

17. 56(1) of the Act is as follows:

56. - (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who-
(a) is a national of a Convention country, or
(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in the United Kingdom.
References to the proprietor of such a mark shall be construed accordingly.

18. There is no doubt that Triumph International Inc. and Michael Jackson were, at the date the application was filed, in business and/or resident in the USA, which is a Convention County. Further, I do not doubt that the music album THRILLER and the associated video were well known in the UK at the date of the application.

19. The applicant argues that THRILLER was not used or known in a trade mark sense. This is because it has been used as the name of a creative work rather than as a sign that distinguished the commercial source of the Work.

20. The opponents argue that the name also functions as a trade mark. Mr Abrahams submitted that this could be tested by asking whether someone going into a music retailer and seeing an album named THRILLER would immediately understand that it was an album of Michael Jackson. Mr Abrahams submitted that the evidence indicated that they would.

21. Although Mr Branca asserts that Michael Jackson was the creator of the Work there is no specific claim in the evidence that he owned the copyrights in the music and lyrics for the songs on the album, or the copyright in the screenplay for the video recording. In this connection, I note that the application was also opposed by a Rodney Temperton¹ who claimed that he owned the copyright in the music of the title track. However, it seems likely that Mr Jackson would, at least, have been entitled to the principal performing rights in the Work and would have been in position to prevent these from being re-produced without his consent. For the purposes of the opposition, this appears to me the most relevant legal right.

22. Copyright material and work protected by performing rights can, and often are, commercialised by others having the licence or consent of the rights holders. It does not therefore seem to me to necessarily follow that the title of such a work distinguishes the commercial source of goods embodying the work².

23. In this connection, I note that in *R v Johnstone*³ Lord Nicholls of Birkenhead considered the use of the name of a recording artist on counterfeit compact discs and said:

“If the name of the artist or group affixed to the compact disc and displayed on the packaging is *exclusively* an indication of the name of the performer whose performance is recorded on the compact disc, and if this use of the name of the performer is not likely to be understood as indicating any other connection between the performer and the compact disc, then such use would be descriptive only. By identifying the performer it would be descriptive of the contents of the disc and nothing more. It would not be an indication of the trade 'origin' of the disc itself. Whether particular labelling and packaging satisfy this test, and consequently are innocuous for trade mark purposes, is a question of fact in each case.”

24. Most people would intuitively feel that the name of the performer of a creative work was less purely descriptive, i.e. capable of saying more about the commercial source of it, than would normally be the case with just the title of the work.

25. As regards live performances, there is no suggestion that Michael Jackson ever used the name THRILLER as a trade name to distinguish the commercial source of live performances. None of his tours were entitled THRILLER, although he no doubt used the name to identify some of the individual works he performed on tours and in other live performances. Further, there is no evidence that the applicant's claimed use of the name THRILLER LIVE as the name of a theatre musical has caused confusion.

¹ See BL O/440/11

² I note that the General Court took a similar view of the matter in *Eugenia Montero Padillo v OHIM* Case T-255/08, with regard to the name of the owner of copyright in musical scores.

³ [2003] UKHL 28, at paragraph 36.

26. I have not taken into account the opponents' claims that the name THRILLER was licensed for merchandise because, even if this is potentially relevant, it did not occur until after the relevant date in these proceedings⁴.

27. Consequently, absent evidence that consumers perceive THRILLER in a trade mark sense (of which there is none) rather than simply as the title of a well known song, album and music video, there is no basis on which to conclude that THRILLER was a well known trade mark in the UK at the date of the opposed application.

28. The grounds of opposition under s.5(2)(b) and s.5(3) therefore fail.

THE PASSING-OFF RIGHT CLAIM

29. This brings me to the s.5(4)(a) ground of opposition. Section 5(4)(a) of the Act states that 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”

30. The requirements to succeed in a passing-off action are well established and are summarised in *Halbury's Laws of England* 4th Ed. as being that:

- i) the claimant's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- ii) there is a misrepresentation by the defendant (whether or not intentional) which is likely to deceive the public into believing that the defendant's goods or services are those of the claimant; and
- iii) the claimant has suffered or is likely to suffer damage as a result of the erroneous belief created by the defendant's misrepresentation.

31. In *The Law of Passing-Off* by Professor Christopher Wadlow, 4th ed., it is stated at paragraph 8-124 that:

“Cases on the title of an individual book, or that of a play, film or similar work, raise an issue which is fundamentally different to that of the title of a periodical such as a magazine. When many different issues of a work have a common title then that title may properly be regarded as having trade mark significance. The same applies to works such as legal or medical textbooks which go into many editions, perhaps under different editors. The same conclusion does not apply to a single work. The distinction has often been overlooked, and discussion of the titles of books (and of plays, films and the like) has often proceeded on the assumption that the title is either descriptive or is distinctive of the publisher in the same way as for periodicals. It is possible for an action based on the title of a book to fail because the title is not exclusively associated

⁴ According to s.6(1)(c) of the Act, this is the date of the application.

with the claimant's work, for instance because it is prima facie descriptive, hackneyed, used by others, or used on too small a scale or too long ago to be remembered. However, even a title which is novel, striking, arbitrary and universally known cannot normally be said to be distinctive of the publisher of that book. If it is distinctive at all, it is distinctive of the book itself."

32. This appears to mean that, like a band name used only to indicate the performers on a music disc, as in the example given in *R v Johnstone* above, the title would normally designate the content of the book rather than its trade source. A music album is a single work like a book. Mr Abrahams submitted that as an album is a collection of musical recordings, it is more analogous to a magazine than to a book. I do not agree. The distinction between a book and a periodical is that there are many different issues of a periodical over a period of time and this presents the factual situation in which the title of the periodical may also function as a trade name. By contrast, an album is a one-off work like a book, albeit composed of a number of shorter pieces of music. I do not think that re-releasing the work on a number of subsequent occasions changes this.

33. I am prepared to accept that at the date of the application⁵ and in the context of musical recordings, the name THRILLER was associated with certain recorded performances of Michael Jackson. It may be that the opponents' true complaint should have been that the use of THRILLER LIVE by the applicant in relation to musical recordings, without any additional indications as to the content of the performances, would misrepresent their content⁶. However, the opponents have opted to base their case on a traditional passing off claim alleging misrepresentation arising from the "*commercial origin or authenticity and approval of the goods and services covered by the application*". In this connection, I take "*authenticity and approval*" to mean that the quality of the applicant's goods and services have not been approved or endorsed by the opponents. That is a particular type of commercial connection with the opponents.

34. I have taken account of the evidence that other musical theatre shows staged in London and named after a well known song of a famous artist, or artists, have been backed or endorsed by the artist(s) concerned. I accept that such a trend might indicate that the public had come to expect that shows so named are endorsed by the artist(s) concerned in the relevant sense that the artist(s) is endorsing the quality of the entertainment. However, the only such musical that has been shown to be publicly associated with the original artist(s) at the relevant date is 'We Will Rock You'. There is no evidence that the other musical theatre shows named in Mr Branca's evidence were being publicly staged at the relevant date, or that using the title of a famous 'hit' as the name of the shows was taken by the public as meaning that the shows were endorsed by the original artist(s).

⁵ Which is the date at which the opponents' earlier right must be assessed: see the judgment of Mr Daniel Alexander Q.C. as The Appointed Person in Case BL O/410/11 at paragraphs 35-45.

⁶ By analogy with *Erven Warnink v Townend* [1980] R.P.C. 31, HL

35. I find that the use of THRILLER LIVE by the applicant in relation to the goods and services covered by the application would not misrepresent the commercial source of those goods because THRILLER has not been shown to be distinctive of the commercial source of music albums and videos. In the absence of misrepresentation, the passing off right claim must fail. The s.5(4)(a) case fails accordingly.

THE BAD FAITH OBJECTION

36. Section 3(6) of the Act is as follows:

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

37. In *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*⁷, the Court of Justice of the European Union (CJEU) considered the conditions necessary for a Community trade mark application to be found to have been filed in bad faith and stated that:

“...in order to determine whether the applicant is acting in bad faith within the meaning of Article 51(1)(b) of Regulation No 40/94, the national court must take into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration of the sign as a Community trade mark, in particular:

- the fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought;
- the applicant’s intention to prevent that third party from continuing to use such a sign; and
- the degree of legal protection enjoyed by the third party’s sign and by the sign for which registration is sought.”

38. As Article 51(1)(b) of the Community Trade Mark Regulation is identical to the corresponding provision of the Trade Mark Directive on which section 3(6) is based, the findings of the CJEU are equally applicable to the interpretation of the national law.

39. I also take account of the judgment of Mr Geoffrey Hobbs Q.C. in *Ian Adams Trade Mark*⁸ in which he stated:

33. The line which separates legitimate self-interest from bad faith can only be crossed if the applicant has sought to acquire rights of control over the use the sign graphically represented in his application for registration in an improper manner or for an improper purpose. The appropriate remedy will in that case be rejection of the offending application for registration to the extent

⁷ Case C-529/07, CJEU

⁸

necessary to render it ineffective for the purpose which made it objectionable in the first place.

34. In a case where the relevant application fulfils the requirements for obtaining a filing date, the key questions are: (1) what, in concrete terms, is the objective that the applicant has been accused of pursuing? (2) is that an objective for the purposes of which the application could not properly be filed? (3) is it established that the application was filed in pursuit of that objective? The first question serves to ensure procedural fairness and clarity of analysis. The second question requires the decision taker to apply a moral standard which, in the absence of any direct ruling on the point from the Court of Justice, is taken to condemn not only dishonesty but also *'some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined'*: *Gromax Plasticulture Ltd v. Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 (Lindsay J). The third question requires the decision taker to give effect to the principle that innocence must be presumed in the absence of evidence sufficient to show that the applicant has acted improperly as alleged.

35. In assessing the evidence, the decision taker is entitled to draw inferences from proven facts provided that he or she does so rationally and without allowing the assessment to degenerate into an exercise in speculation. The Court of Justice has confirmed that there must be an overall assessment which takes into account all factors relevant to the particular case: *Case C-529/07 Chocoladefabriken Lindt & Sprüngli AG v. Franz Hauswirth GmbH* [2009] ECR I-4893 at paragraph [37]; *Case C-569/08 Internetportal und Marketing GmbH v. Richard Schlicht* [2010] ECR I-00000 at paragraph [42]. As part of that assessment it is necessary as part of that approach to consider the intention of the applicant at the time when the application was filed, with intention being regarded as a subjective factor to be determined by reference to the objective circumstances of the particular case: *Chocoladefabriken Lindt & Sprüngli GmbH* (above) at paragraphs [41], [42]; *Internetportal and Marketing GmbH* (above) at paragraph [45]. This accords with the well-established principle that 'national courts may, case by case, take account -on the basis of objective evidence -of abuse or fraudulent conduct on the part of the persons concerned in order, where appropriate, to deny them the benefit of the provisions of Community law on which they seek to rely': *Case C16/05 The Queen (on the applications of Veli Tum and Mehmet Dari) v. Secretary of State for the Home Department* [2007] ECR I-7415 at paragraph [64].

40. Applying the above guidance to the facts in this case is complicated by the absence of evidence from the applicant, which could have answered the criticism of the purposes of the application. Consequently, although the applicant is entitled to a presumption of innocence, if the opponents have established a *prima facie* case of bad faith, the objection will succeed.

41. The opponents claim that registration of THRILLER LIVE may prevent them from continuing to exploit their rights in the Work known as THRILLER or prevent them from exploiting the Work in recordings, or for goods and services that are natural ways to commercially exploit the Work.

42. Given their interest in producing a musical theatre show about Michael Jackson and his songs, I do not think that there is any doubt that the applicant knew that third parties, including Mr Jackson or his assigns, had a commercial interest in the sale of recorded music and images entitled THRILLER. This is because the applicant would have been aware that performance rights existed in Mr Jackson's performances of THRILLER. As THRILLER is the world's best selling album of all time and had been re-released twice before the application, the applicant would have known that this interest continued. This appears to justify the opponents' criticism that awareness of the above facts should have prevented the applicant from applying for a trade mark granting it the exclusive right to the use of the words THRILLER LIVE in relation to recorded music and images.

43. One possible answer to such a criticism might have been that the applicant's trade mark would not prevent Michael Jackson or his assigns from continuing to use THRILLER in a descriptive sense just as the title of an album or video. Indeed that would be the logical consequence of the applicant's claim that the uses of THRILLER on which the opponents rely are not sufficient to establish any trade mark rights. However, the applicant has neither expressly taken that position, nor has it explained how its own intended use of THRILLER LIVE in relation to recorded music and images qualifies as trade mark use, when the uses of THRILLER on which the opponents rely do not. This means that the applicant should have considered that one possible result of the application would be that Michael Jackson, or his assigns, might have to obtain a trade mark licence in order to continue to commercialise the performing rights in the work entitled THRILLER. In my view, making an application which has this effect is not something that a reasonable person in the relevant field of commerce would consider as observing the normal standards of commercial behaviour.

44. I therefore find that in applying to register the trade mark for recorded music and images in class 9, the applicant acted in a manner that *prima facie* indicates bad faith.

45. In reaching this conclusion I have taken account of the difference between THRILLER and THRILLER LIVE, but as 'live' simply describes the nature of the recorded performance, and THRILLER remains the name by which the work will be known, I find that the addition of this word makes no difference.

46. Further, as all the goods in class 9 are recorded music and images on various media, or are goods in which such works may be incorporated, I do not consider that the applicant's intentions could have been any different for any of the goods in class 9.

47. The same applies to the services described as 'entertainment services; production of musicals and any and all adaptations thereof; production of sound recordings, television programs and films; musical, television and film entertainment services; providing education regarding music; providing digital video and audio recordings (not downloadable) via a computer network such as the Internet; providing on-line electronic publications (not downloadable)

on-line from databases or the Internet; providing electronic images and artwork (not downloadable) on-line from databases or the Internet; all of the above relating to live entertainment consisting of popular music songs' in class 41. This is because all of these are services through which the opponents' performing rights in the Work could be incorporated. This conclusion is most apparent in relation to 'television and film entertainment services', 'providing digital video and audio recordings (not downloadable) via a computer network such as the Internet' and 'providing electronic images and artwork (not downloadable) on-line from databases or the Internet', but in fact these services are subsumed in all the other descriptions of services. In this connection I note that 'on-line electronic publications' is wide enough to cover 'providing electronic images'.

48. The remaining services include 'Theatrical and show business entertainment services', 'presentation of live performances' and 'production of concerts, dramas, stage shows'. Michael Jackson was still alive at the date of the application. Although it has not been shown to my satisfaction that Michael Jackson alone was entitled to commercialise new performances of the music or dance routine known as THRILLER (as opposed to reproducing or broadcasting, without consent, Mr Jackson's performances of the Work), section 3(6) is capable of preventing the registration of a trade mark in circumstances where there are no relative grounds for refusal⁹. Mr Jackson plainly had a commercial interest in giving further live performances of his most famous song and dance routine. The applicant's application to register THRILLER LIVE as a trade mark for the above services therefore raises the same question as with recordings; namely, whether one of the purposes of the application was to limit the circumstances in which Mr Jackson was able to provide further live performances in the UK by reference to the name THRILLER. If that was one of the applicant's intentions then I consider that making the application to register the mark for these services also fell short of the normal standard of commercial behaviour observed by reasonable people in the relevant field of business.

49. The applicant's failure to file evidence denying the allegation and explaining its intentions again counts against it, decisively. I find that the bad faith objection also succeeds for all the goods in class 9 and for the services listed in the paragraph above. In this connection, I note that 'Theatrical and show business entertainment services' is wide enough to cover any live performance of the song and dance routine known as THRILLER.

50. This leaves me to consider the application to register the trade mark for the remaining services:

Entertainment services in the form of musical theatre; providing theatre facilities; providing entertainment information; information relating to entertainment provided on-line from a computer database or the

⁹ See the decision of Mr Geoffrey Hobbs Q.C. as The Appointed Person in *Fianna Fail/Fine Gael* BL O/043/08

Internet; publication of books, texts and journals on-line; ticket agency services.

51. Although Mr Branca gives evidence that after Mr Jackson's death, one of the opponents sold Sony Music the right to exploit his music in, inter alia, theatrical performances, there is no evidence that Mr Jackson had ever given musical theatre performances under the name THRILLER. The agreement with Sony is not in evidence. It is therefore difficult to see whether it covers more than just the reproduction of copyright works.

52. Further, I do not accept that it would have been obvious in 2008 that Mr Jackson himself had any intention to provide musical theatre services under the name THRILLER.

53. Further still, although the applicant has said nothing about its own commercial exploitation of THRILLER LIVE, it has not denied the opponents' claim that it was staging West End musical theatre performances under the name THRILLER LIVE prior to filing the application. Thus this fact is uncontested and it presents a *prima facie* legitimate reason for the applicant to apply to register the trade mark for these services.

54. So far as 'providing theatre facilities', 'publication of books, texts and journals on-line', 'providing entertainment information; information relating to entertainment provided on-line from a computer database or the Internet' and 'ticket agency services' are concerned, I see no sufficient connection between these services and any commercial rights or expectations that it should have been clear to third parties that Mr Jackson had at the time of the application in order to establish a *prima facie* case of bad faith.

55. Taking all of these factors into account, I reject the opponents' claim that the application to register the trade mark for the services listed in paragraph 50 was made in bad faith.

COSTS

56. Both sides have achieved a measure of success, the opponents more so than the applicant. I will therefore order the applicant to pay the opponents half of the usual scale costs.

57. I order the applicant to pay each of the opponents the sum of £750, i.e. £1500 in total. This is made up of 2 X 50% of:

£400 for filing the Notice of Opposition, including the official fee

£200 for considering the counterstatement

£300 for filing evidence

£100 for considering the applicant's written submissions

£500 for attending the hearing and filing a skeleton argument

58. The above sum to be paid within 7 days of the end of the period permitted for appeal.

Dated this 9th Day of March 2012

**Allan James
For the Registrar**