

O-446-19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. 3231134

IN THE NAMES OF JESSIE TSANG, CAROLYN BALDWIN,

CAROLYN LUCAS GRIFFEY & LUCAS GRIFFEY

IN RESPECT OF THE TRADE MARK:

Soul Train Records

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 502026 BY BET ST LLC

Background and pleadings

1. The trade mark **Soul Train Records** stands registered in the names of Jessie Tsang, Carolyn Baldwin, Carolyn Lucas Griffey & Lucas Griffey (“the proprietors”). It was applied for on 15 May 2017 and entered in the register on 8 September 2017. It stands registered for the following goods and services:

Class 9 - Musical sound recordings;

Class 35 – Merchandising;

Class 41 - Theatre entertainment.

2. On 28 March 2018, BET ST LLC (“the applicant”) filed an application to have this trade mark declared invalid under the provisions of sections 47(1)/47(2)(a) and sections 3(6) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The relevant provisions read as follows:

“47 (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b)...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if—

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes—

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered,

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

.....

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

And:

“3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

5(2) A trade mark shall not be registered if because –

(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. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

4. The objection under section 5(2)(b) is based upon the following trade marks:

(1) United Kingdom trade mark no. 2206036 for the series of two trade marks shown below which were applied for on 16 August 1999 and which were entered in the register on 9 August 2002. The applicant indicates that it relies upon all the goods and services for which the trade mark is registered (shown below):



“Mark Description/Limitation

The applicant claims the colours pink, blue and white as an element of the second mark in the series.”

Class 9 - Recording materials bearing recorded information; recording materials included in Class 9 featuring musical performances; video tapes, digital video display tapes and video CDs; audio tapes, cassettes, discs, compact discs and records; Read-Only-Memories and CD-Roms; magnetic data carriers; inter-active CDs; information stored in or on electronic, magnetic

and/or optical means; electronic publications; providing on-line electronic publications (downloadable) from the Internet.

Class 16 - Printed publications; printed matter; books; periodicals; magazines; journals; newspapers; brochures; stationery; postcards and greeting cards; posters and programmes; photographs; diaries and calendars; instructional and teaching materials.

Class 41 - Entertainment services; presentation of live performances; presentation of musical performances and shows; concert services; presentation of soul concerts; live band performances; audio recording services and recording studio services; show production services; management services for performing artists; information relating to music provided on-line from a computer database or the Internet; electronic game services provided by means of the Internet; provision of on-line publications relating to music (not downloadable); publication of electronic books and journals on-line relating to music; information and advisory services relating to all the aforesaid services.

(2) United Kingdom trade mark no. 2205267 for the trade mark **SOUL TRAIN** which was applied for on 7 August 1999 and which was entered in the register on 8 March 2002. The applicant indicates that it relies upon all the services for which the trade mark is registered i.e.

Class 41 - Entertainment services, being television, radio and live shows; theatrical and motion picture performances; documentaries.

(3) European Union Trade Mark ("EUTM") no. 1951003 for the trade mark **SOUL TRAIN** which was applied for on 13 November 2000 and which was entered in the register on 16 May 2002. The applicant indicates that it relies upon all the goods and services for which the trade mark is registered i.e.

Class 9 - Apparatus and instruments included in class 9 bearing recorded information; apparatus and instruments included in class 9 featuring musical

performances; video tapes, digital video display tapes and video CDs; audio tapes, cassettes, discs, compact discs and records; read-only-memories and CD-Roms; magnetic data carriers; interactive CDs; information stored in or on electronic, magnetic and/or optical means; electronic publications; providing on-line electronic publications (downloadable) from the Internet.

Class 25 - Articles of clothing, footwear and headgear.

Class 41 - Entertainment services, being television, radio and live shows; theatrical and motion picture performances; documentaries.

5. In relation to its objection based upon section 3(6) of the Act, the applicant states:

“8. The mark "SOUL TRAIN" was originally used in respect of an American music-dance television programme. This television programme was created by an individual named Don Cornelius. Further, the mark SOUL TRAIN RECORDS was an American record label founded in 1975 by Don Cornelius. Acts signed to SOUL TRAIN RECORDS included the "SOUL TRAIN GANG", who performed one of the Programme's theme tunes, SOUL TRAIN '75.

9. In 1977, SOUL TRAIN RECORDS was shut down by Don Cornelius so that he could focus his energies on the television programme SOUL TRAIN.

10. Thereafter, all right, title and ownership of SOUL TRAIN RECORDS passed to the Applicant' predecessor in title, with the result that the Applicant owns the rights to the television programme as well as the associated Awards show and Soul Train Records.

11. The Applicant therefore now owns the legal rights to the Programme, Awards and Soul Train Records. The Proprietors have no legal interest in SOUL TRAIN RECORDS and, therefore, the filing of the application which resulted in the Registration amounts to an abuse of the trade mark registration system because the Proprietors filed it for an ulterior purpose, such as to leverage a right in Soul Train Records.

12. Further or alternatively, the Second, Third and Fourth Proprietors appear to be relatives of the late Richard Gilbert "Dick" Griffey. After Don Cornelius closed down Soul Train Records, Dick Griffey reconstituted the record label under the name SOLAR Records in 1977 (ie, SOUND OF LOS ANGELES RECORDS). Therefore, given Dick Griffey's affiliation with Don Cornelius and Soul Train Records, it is implausible that the Second, Third and Fourth Proprietors were not aware of Programme, Awards and the earlier SOUL TRAIN Registrations."

6. Although in their counterstatement the proprietors admit a number of the points raised in the applicant's Statement of Grounds, they deny the application should succeed.

7. In these proceedings, the applicant is represented by Maucher Jenkins ("MJ"). Although unrepresented up to the appointment of the hearing, from 25 April 2019, the proprietors have since been represented by Wood IP Limited ("WIPL"). Both parties filed evidence. The matter came before me at a hearing held on 15 May 2019, at which the applicant was represented by Ms Katherine Cameron of MJ and the proprietors by Mr Aaron Wood of WIPL.

The applicant's evidence-in-chief

8. This consists of two witness statements. The first, comes from Ms Donna Blackman. Ms Blackman explains that the applicant is owned by the BET Networks Division of Viacom, adding that she has worked for the applicant/Viacom for five years and has "a detailed knowledge of the history and operations of [her] company." While she confirms that the information she provides "is taken from [her] own personal knowledge, or from the records of [her] company, to which [she] has unrestricted access", she does not explain what position she holds in the applicant company. Ms Blackman explains:

"3. BET Networks, a subsidiary of the Applicant, acquired the Soul Train brand from InterMedia Partners and The Yucaipa Companies in April 2016. The deal included the rights to the American music-dance television program,

Soul Train (the "Programme"), the Soul Train Music Awards (the "Awards") and the SOUL TRAIN Marks. The deal was widely reported in the media..."

9. Exhibit DB1 consists of articles dated 5 April 2016 from marketwatch.com, 6 April 2016 from billboard.com, 4 April 2016 from deadline.com and 5 April 2016 from rockol.com, respectively, in support. Ms Blackman states:

"4. The Programme originally aired in the United States from October 1971 to March 2006 and featured performances from well-known R&B, soul, dance, pop, hip hop, funk, jazz, disco and gospel artists. The Programme was created, produced and hosted by Don Cornelius. Over its 35-year history, over 1,100 episodes of the Programme were produced and broadcast. The Programme is well-known in the European Union, including the United Kingdom and highlights and clips of it are accessible by UK consumers via the applicant's YouTube and social media sites..."

5. The Awards is an annual award show dedicated to Black music and entertainment. Past hosts for the Awards include well-known music artists...The Awards have been aired in the European Union on Black Entertainment Television ("BET"), a television channel owned by the Applicant since 27 February 2008..."

10. Exhibit DB2 consists of "broadcast dates for the awards", which indicate that the 2014, 2015, 2016 and 2017 Awards shows aired on "BET France" and the 2016 and 2017 shows aired on "BET Int UK IMM" in the UK. Ms Blackman explains that the Awards shows mentioned have also been available to stream in the EU and in the UK since 2016 via the BET Play App. Ms Blackman states:

"6. Although the Applicant did not take assignment of the SOUL TRAIN Marks until September 2016, the marks have clearly been in use since 1971 by the previous owners and use of the SOUL TRAIN Marks has been made by the Applicant in France since 6 December 2015 and in the UK since 21 May 2017 through the broadcast of the Awards...Such use amounts to use during the Relevant Period in respect of all the Class 41 services covered by the SOUL

TRAIN Marks and, in particular, *"entertainment services, being television, radio and live shows; theatrical and motion picture performances"*.

11. She adds that the applicant promotes the Awards on its BET International UK website, betintl.co.uk. Exhibit DB3 consists of a screenshot containing a copyright date of 2015 which contains a reference to "SOUL TRAIN AWARDS." Ms Blackman states:

"9. The Soul Train brand has regularly been featured in press coverage throughout the European Union, including the United Kingdom, and is referred to under the SOUL TRAIN Marks. This regular press coverage has raised the profile and reputation of Soul Train throughout the European Union, including the United Kingdom..."

12. Exhibit DB4 consists of a number of "press articles" from: premiergospel.org.uk (November 2016), uk.businessinsider.com (November 2017), eonline.com (November 2017), dailymail.co.uk (October 2015) and theboom.box.com (November 2014), all of which refer to Soul Train Awards. Ms Blackman notes that the November 2016 article from premiergospel.org.uk refers to:

"Catch all this and more on the Soul Train Awards 2016 premieres...only on BET – Sky 187/Virgin 184/Freesat 140."

She adds:

"10. The Applicant actively promotes the Soul Train brand through social media and has tens of thousands of followers across these platforms including, but not limited to Facebook, Twitter, Instagram and YouTube, including in the United Kingdom and across the European Union."

13. Exhibit DB5 consists of an image obtained using the Wayback Machine of the Soul Train Facebook page i.e. www.facebook.com/OfficialSoulTrain at 12 December 2012, indicating that at that point in time, Soul Train had 55,963 "likes". This, explains Ms Blackman, is the most recent snapshot available within the

relevant period. Exhibit DB6 consists of an image of the Facebook web page as at 28 June 2018, which indicates that at that date Soul Train had 472,415 "likes" and is followed by 464,423 people worldwide. Ms Blackman states:

“11...In relation to the European Union I confirm that at the date of this Statement [i.e. 13 September 2018] the official Soul Train Facebook page had 12,134 fans in the United Kingdom, 8,912 in France, 4,945 in Germany and 3,614 in Italy.”

14. Exhibit DB7 consists of search results for "soul train" on the official BET International Facebook page www.facebook.com/pg/BETIntl at 7 August 2018, which includes references to the "Soul Train Awards" dated within the relevant period.

15. Exhibit DB8 consists of pages from www.instagram.com/soultrainofficial at 28 June 2018 indicating that at that date Soul Train had 17.1k followers worldwide. Ms Blackman states:

“13...I can confirm that 4% of these followers are located in the United Kingdom and 1% from Germany...”

16. Exhibit DB9 consists of pages from the same Instagram account pages showing images taken at the Awards. Ms Blackman notes that the first and last pages are dated 23 March 2017 and 29 November 2014, respectively.

17. Exhibit DB10 consists of pages obtained using the Wayback Machine from <https://twitter.com/soultrain> at 21 December 2016, indicating that at that date Soul Train had 16.9k followers worldwide and 7,043 tweets. Exhibit DB11 consists of pages from the official Soul Train and BET International Twitter pages, many of which are from within the relevant period.

18. Exhibit DB12 consists of results of a search for 'Soul Train' within BET Network's YouTube page at 28 June 2018 which, Ms Blackman explains, includes "recaps, highlights and promos from the 2013, 2015 and 2016 Awards." Ms Blackman states:

“16. **Exhibits DB4 to DB12** therefore show that SOUL TRAIN has tens of thousands of followers across a number of social media platforms under the SOUL TRAIN Marks, with a significant number of these being located in the United Kingdom and European Union. It is therefore clear that Soul Train enjoys a very substantial reputation under the SOUL TRAIN Marks in the United Kingdom and European Union, and that it did so at the time the Applicant filed the invalidity action against the opposed mark. The use of the SOUL TRAIN Marks through these social media platforms also amounts to use during the Relevant Period in respect of *"electronic publications"* and *"providing on-online electronic publications (downloadable) from the Internet"* in Class 9. Further, given that many of the posts on the aforementioned social media platforms contain video clips of or about the Programme and Awards, these posts also amount to use of the SOUL TRAIN Marks during the Relevant Period in respect of the Class 41 services covered by the SOUL TRAIN Marks.”

19. In relation to advertising, Ms Blackman states:

“17. The Applicant has invested considerable sums and creative effort in developing and promoting the SOUL TRAIN Marks in the United Kingdom and European Union since it first began broadcasting the Programme and Awards, including through the Website and through the use of social media, as outlined above. It is evident from this that the Applicant has made significant efforts over the years to raise and maintain the profile of the SOUL TRAIN Marks in the musical and entertainment fields during the Relevant Period.”

20. Finally, in relation to the objection based upon 3(6) of the Act, Ms Blackman states:

“18... Soul Train Records was an American record label founded by Don Cornelius in 1975, subsequent to the creation of the Programme, and was shut down by him in 1977. After the cessation of Soul Train Records, Dick Griffey founded SOLAR Records in 1977. Indeed, the Proprietors are the sole

directors of Solar Records Limited which owns UK registration no. 3137473 for



(SOLAR RECORDS), which was filed on 23 November 2015. To date, however, the Proprietors have provided no evidence that Dick Griffey owns or owned rights in Soul Train Records.

19. Further or alternatively, para. 10 of the Proprietors' Counterstatement suggests that, even if Dick Griffey did retain an interest in Soul Train Records, this was sold to Unidisc Music in 2005, prior to the filing of UK trade mark registration no. 3231134 for SOUL TRAIN RECORDS on 15 May 2017. However, this transaction only comprised of the musical back catalogue of Soul Train Records and has no bearing or effect on the Applicant's ownership of the rights to the Programme, Awards or the SOUL TRAIN Marks."

21. Exhibit DB13 consists of a page obtained from www.thediscoparadise.com which includes the following:

"SOUL TRAIN – Record label created in 1975 by Don Cornelius and Dick Griffey in Los Angeles, CA and closed down in 1978. The catalog is now owned by Unidisc Music."

22. The second statement comes from Ms Cameron. As it consists primarily of submissions it is neither necessary or appropriate for me to summarise these submissions here; I will, of course, bear them in mind in reaching a conclusion.

23. Insofar as it does contain evidence of fact, exhibit KC1 consists of extracts obtained from: (i) the IPO's website indicating that trade mark no. 3137473 for the trade mark shown in paragraph 20 was filed on 23 November 2015 in the name of Solar Records Limited ("SRL") for "musical sound recordings" and that the address of SRL is identical to the address of the proprietors in these proceedings, and (ii) the website of Companies House indicating that the name of the secretary/directors of SRL (company no. 09868043) are identical to the proprietors in these proceedings. In relation to this evidence Ms Cameron states:

"17...It is submitted that the "good faith" application was, in fact, that filed under Number 3137473 for the mark "SOLAR RECORDS", considering that it is clear that the original Mr Dick Griffey set up the SOLAR RECORDS Label, as set out in the original Statement of Grounds and confirmed by the Proprietors themselves in their Counterstatement. This does not, however, transform the Application which led to the current Registration from one filed in bad faith to one filed in good faith."

The proprietors' evidence

24. This consists of three witness statements. The first, is from Jessie Tsang. Ms Tsang explains that she is, inter alia, the CEO of SRL and confirms she is authorised to speak on behalf of her co-proprietors. Ms Tsang states:

"1...I have represented and administrated the business interests of the Griffey family since 2006 and have access to the business archives of the late Richard 'Dick' Griffey co-founder of Soul Train Records and CEO of Solar Records.

2. I am considered knowledgeable in the field and history of soul music and have had a 20 year career in the UK and USA music industry...I have worked as a booking agent, manager, PR and Marketing manager for music releases by celebrity artists."

She adds:

“3...“Soul Train” (TV and Awards Show) has always has been a separate entity to “Soul Train Records”...”

And:

“4...Soul Train Records was founded in 1975 by both Don Cornelius and Dick Griffey. Soul Train Records was a division of Cornelius-Griffey Entertainment. This company promoted music releases and concert tours in the USA, Europe and Asia...This sale of Don Cornelius partnership share to Dick Griffey can also be further substantiated in a letter from Don Cornelius own legal counsel/Attorney Mel Katten to Margaret Nash head of Dick Griffey's Publishing Company...”

25. Exhibit JT2 consists of the letter mentioned. It is dated 15 February 1982 and is in relation to “Spectrum VII Music Co. – 1981 Royalty Payments”. I note it contains the following:

“...These amounts were paid during the first four or five months prior to the sale of the partnership interests to Dick Griffey...”

26. Ms Tsang states:

“6. We refute [the applicant's] claim that our registration was made in bad faith. The applicant had never owned, acquired or traded under 'Soul Train Records' in the UK. Our registration was made on the basis that the current Proprietors Carolyn Lucas Griffey, Carolyn Baldwin and Lucas Griffey family and successors of the late Dick Griffey. Dick Griffey was the co-founder of Soul Train Records and later purchased Don Cornelius share of Soul Train Records, becoming the sole owner of all Soul Train Records assets including the mark. The Soul Train Records mark was first used in commerce in the UK in 1977 and is still distinctively recognised by the public today. The UK public recognise the artists and musical releases and concert tours associated with

Soul Train, Dick Griffey and Solar Records...The Proprietor Carolyn Lucas Griffey and her husband the late Dick Griffey had invested into the founding of Soul Train Records and Dick Griffey later purchased all rights to Soul Train Records.”

27. Exhibit JT1 consists of an undated Google search for the words “Soul Train Records”. The first and final listing is for (i) “SOLAR Records – Wikipedia” and (ii) “Soul Train Record Label – The Disco Paradise”, respectively. The listings (which have not been expanded) contain the following:

(i) “SOLAR was an American record label founded in 1977 by Dick Griffey, reconstituted out of Soul Train Records only two years after it was founded with Soul...”

(ii) “Record label created in 1975 by Don Cornelius and Dick Griffey in Los Angeles, CA and closed down...”

28. Exhibit JT3 consists of an extract from an article which appeared in Billboard Magazine dated 28 September 1974 which attests to the fact that a business relationship existed between Mr Corenlius and Mr Griffey.

29. Ms Tsang states:

“10. In an interview with TV One for the episode titled 'Shalamar Unsung' on June 21st 2009 Dick Griffey stated; *"Don Cornelius of Soul Train and I were partners and I suggested that we should start a record company. So that's what we did. We cut a theme song for Soul Train by a group we called 'The Soul Train Gang' but was made up of young people from Soul Train (TV Show). He wanted out, so I ended up buying him out and that's when we went from Soul Train to Solar. Sound of Los Angeles Records"*.

30. Exhibit JT4 consists of the above quotation together with the details of a link to youtube. Although no copy of the actual interview has been provided, there is nothing to suggest the quotation provided is inaccurate.

31. Exhibit JT5 consists of an excerpt from a 2014 book available in the UK entitled "Issues in African American Music" edited by Portia Maulsby, which contains a photograph of three gentlemen under which there appears the following:

"Soul Train Records Executives...Don Cornelius (co-founder), Logan Westbrookes (Vice President of Marketing), and Dick Griffey (co-founder)."

32. Exhibit JT6 consists of an extract from a 2004 book available in the UK entitled "African-American Business Leaders and Entrepreneurs" by Rachel Kranz which includes the following:

"In 1973, Griffey had been approached by producer and television personality Don Cornelius, who was then hosting the popular black music show Soul Train. Cornelius asked Griffey to book acts onto the show. In 1975, they cofounded Soul Train Records, getting a limited deal with RCA records to distribute their albums...In 1978, Griffey and Cornelius dissolved their partnership, and Griffey changed the company's name to SOLAR..."

33. Ms Tsang states:

"13. Soul Train Records acquired its distinctiveness in commerce in the UK through the success of the artists and musical releases and continual radio airplay of Soul Train Records musical releases in. Even in 2018 the public associate Soul Train Records with Dick Griffey, Solar Records and the artists Carrie Lucas, The Whispers and Shalamar. A significant proportion of the public in the UK, EU, USA and Asia identify the relevant artist, goods and services with both Dick Griffey and also Solar Records...Soul Train Records was a division of Cornelius Griffey Entertainment Co and also demonstrates that in 2018 there is still public recognition of 'Soul Train Records' products and artists in commerce."

34. The following exhibits are provided in support of the above:

JT7(a) - an album sleeve from 1976 for “The Soul Train Gang” which bears the following: “Soul Train Records – A Division of Cornelius-Griffey Entertainment”;

JT7(b) –a screenshot from the BBC website said to date from 2018 which refers to “Soul Train 75” and “Soul Train Gang”;

JT8(a) and (b) are the front and back of the sleeve of the 1977 album “Uptown Festival” by Shalamar; the back cover contains the same reference mentioned in exhibit 7(a) above, but which also includes the word “CO.” after the word “Entertainment”;

JT8(c) – is a further screenshot from the BBC website also said to date from 2018 which contains the following: “Uptown Festival – Shalamar”;

JT9 - is a further screenshot from the BBC website also said to date from 2018 which contains the following relating to Carrie Lucas: “Carrie Lucas...in 1976 she was signed to Soul Train Records. Lucas made six albums over seven years with Soul Train and Solar Records...”

35. Ms Tsang states:

“14. Dick Griffey purchased all business assets of Soul Train Records from Don Cornelius...Attorney Virgil Roberts negotiated and oversaw the sale of Don Cornelius share of Soul Train Records to Dick Griffey for the sum of \$300,000. At no time did Dick Griffey sell the rights to the goodwill associated with the name Soul Train Records. Dick Griffey invested in, built, worked and promoted Soul Train Records. It was his prerogative if he chose to use the name that he purchased the rights to. No other party or entity acquired the rights to the mark from him. At the time of his passing, the UK public still recognised Dick Griffey as co-founder and owner of 'Soul Train Records'...”

15. After Dick Griffey's death in 2010 the rights to the Soul Train Records trade mark passed on to his successors. Soul Train Records as a trade mark is and now owned by Dick Griffey's widow, children and a 25% share was assigned to myself which I, Jessie Tsang registered to protect all shares. The current Proprietor Carolyn Lucas Griffey aka Carrie Lucas is the widow of the late Richard 'Dick' Griffey and the other two named Proprietors are Carolyn Baldwin and Lucas Griffey, children of the late Dick Griffey. Dick Griffey was the co- founder and later full owner of all Soul Train Records assets in the USA, UK and Europe.”

36. Exhibit 10 consists of an Asset Purchase Agreement dated 21 March 2005 (with an effective date of 1 March 2005) between J Hines Company, Inc d/b/a Solar Records a Californian Corporation (previously known and doing business as SOUND OF LOS ANGELES RECORDS, INC) and Unidisc Music Inc a Canadian Corporation. The Agreement is, I note, signed by Dick Griffey. Of this Agreement, Ms Tsang states:

“16...The Unidisc Asset Purchase Agreement purchase agreement was for the USA and Canada and not the UK and there was no sale of the Soul Train Records trade mark in this agreement. There was the sale of the Solar and Constellation trade mark in the USA and Canadian territories. However page 24 of the agreement lists the album 'Uptown Festival' by Shalamar which was part of the Soul Train Catalogue originally owned by both Don Cornelius and Dick Griffey and later paid for in full by Dick Griffey as stated by Attorney Virgil Roberts in his witness statement. This Assets purchase agreement demonstrates that Dick Griffey purchased the Soul Train Records assets in order to be in the position to sell them to Unidisc in 2005 in the specified Territories...”

37. Ms Tsang concludes her statement in the following terms:

“17. We have provided evidence that Soul Train Records is a recognisable entity to the public among music fans and even today. The products produced in commerce to this very day are played on UK radio and written about in

books and publications as demonstrated in the exhibits. There is and never has been any confusion between Soul Train Records and Soul Train TV Show and Awards. The public are aware of the historical connection of Don Cornelius and Dick Griffey. This is publicly documented...”.

38. The second statement comes from Carolyn Adair Lucas Griffey aka Carrie Lucas. Mrs Griffey states:

“1...I have a detailed knowledge of the history of and operations of The Soul Train Recording Company aka Soul Train Records in the UK. In 1975 I invested \$1 million USD in the Soul Train Records with my husband the late Richard 'Dick Griffey'. I can confirm that the information contained within this witness statement is taken from my own personal first-hand experience and knowledge of being there during the creation of Soul Train Records, the building, trading and sale of the entire company and all assets to my late husband Richard 'Dick' Griffey.”

39. Exhibits CG1 and CG2 consist of a marriage certificate (from 1974) and death certificate (from 2010) respectively, provided in support of the above.

40. Mrs Griffey explains that she is “professionally and internationally known as the recording artist and songwriter Carrie Lucas...” and in 1976 she signed to Soul Train Records. She states that in 1977 she toured the UK while signed to Soul Train Records to promote her album “Simply Carrie” and a copy of the album sleeve and album is provided as exhibit CG3.

41. Mrs Griffey states:

“4. My late husband Dick Griffey was the premier music promoter who promoted concert tours for Stevie Wonder, Ike and Tina Turner, Aretha Franklin, The Jacksons and many other international music stars. He had industry connections and was able to book these stars for Don Cornelius to appear on Don's Soul Train American TV Show. This TV show was not

syndicated of known in the UK at the time. My husband was the Talent Co-Ordinator on Don's TV Show 'Soul Train'.

5. Don Cornelius was a personal friend as well as the business partner of my late husband...He was known to me personally and professionally. I performed numerous times on the Soul Train TV Show alongside other artists signed to Soul Train Records.

6...I do not make any claim to the intellectual property rights to the Soul Train TV Show or Soul Train Awards Show and any of their products of which the applicant has provided evidence. The Soul Train TV and Awards Show was always a separate business entity to Soul Train Records. However I will assert my ownership and right to the trade mark and goodwill associated with the name 'Soul Train Records'. I personally invested in this company and my husband was a 50% shareholder of this company alongside Don Cornelius.

7. In 1975, I personally took \$1 million dollars to the home of the late Don Cornelius of personal funds that belonged to both my husband and I. This money was the investment for The Soul Train Recording Company/Soul Train Records. Don Cornelius also invested into the company approximately \$200,000. Aside from Attorney Virgil Roberts, I am the only living person who was there first hand and who has the specific knowledge and insight into the business partnership of my late husband and Don Cornelius and The Soul Train Recording Company. This includes and the founding, operation and sale of Don Cornelius share of Soul Train Records to my late husband.

8. When Don Cornelius no longer wanted to be part of Soul Train Records my late husband purchased his share of the business along with Don's share of the goodwill associated with Soul Train Records which had built by trading in commerce through the release of music by myself, the Whispers and Shalamar. To my knowledge we received the sum of \$300,000 which was more than Don had initially invested into the Soul Train Recording Company. All artist contracts and music catalogs were transferred to my husband Dick Griffey including my own artist contract and publishing to the songs I

composed. The artist roster and Catalog music included myself, The Whispers, Shalamar and Soul Train Gang.”

42. The third and final statement comes from Virgil Roberts, an Attorney at Bobbit & Roberts of Culver City, California. Mr Roberts states:

“1. I am an attorney at law duly licensed to practice before all courts State and Federal in California, USA. I have personal knowledge of the facts stated in this witness statement and if called and sworn to testify in a court of law, I could and would competently testify to all facts stated in this witness statement.

2. I have practised law in California since December 1972. Since the mid 70's I have represented clients in the entertainment industry, primarily in the music recording industry. I have in the past and continue to represent recording artists, record producers, songwriters, music publishers, record companies and publishing companies. I believe I am generally considered by my peers to be an expert in the field. Martindale Hubbell has given me their highest rating "AV". I have been recognised by 'Black Enterprise Magazine' as one of America's Top Black Lawyers and in 'Los Angeles Magazine' as a 'Super Lawyer'.

3. Both Don Cornelius and Dick Griffey were known to me in a professional and personal capacity. I first met Dick Griffey in 1977 and provided him with legal counsel until his death in 2010. From 1982 I served as Vice President and Legal Counsel to Solar Records with access to all company documents and lists of company assets. To my knowledge Don Cornelius was the sole owner of the Soul Train TV Show and Awards Show. Don and Dick Griffey worked together when Dick Griffey was the Talent Co-ordinator for the Soul Train TV show.

Separate to the TV show, I confirm that Dick Griffey and the late Don Cornelius were business partners operating under Cornelius-Griffey

Entertainment Company and Soul Train Recording Company aka Soul Train Records. Soul Train Records was as a division of the Cornelius-Griffey Entertainment Company. They also operated as business partners of the Soul Train Club in San Francisco. The Soul Train Recording Company was a separate legal and business entity to the Soul Train TV Show and Award Show. At the time of operation Don Cornelius and Dick Griffey were equal partners with equal ownership stakes.

Don Cornelius was not the sole owner of The Cornelius-Griffey Entertainment Company/Soul Train Recording Company. There existed an equal business partnership between Don Cornelius and Dick Griffey. All of the Soul Train Records products produced for sale from 1975 to 1978 bear the company information as described; Cornelius-Griffey Entertainment Company and or Soul Train Recording Company/Soul Train Records. Soul Train Records musical releases by The Soul Train Gang, Carrie Lucas, The Whispers, and Shalamar distributed in the USA, UK and Europe. The goodwill associated with the name Soul Train Records was built in the UK through the release of these recordings and the success of the artists promoted. The following Soul Train Records albums had several singles released, promoted and played on UK radio.

1976 One for the Money - The Whispers

1977 Simply Carrie - Carrie Lucas

1977 Open Up Your Love - The Whispers

1977 Uptown Festival - Shalamar

4. I first met Carrie Lucas wife and widow of the late Dick Griffey in 1979. To my knowledge she personally took the initial investment of \$1 million as Dick Griffey's share of the investment into the Soul Train Recording Company/Soul Train Records. Carrie Lucas was also an artist and songwriter signed to Soul Train Recording Company/Soul Train Records.

5. I served as legal counsel in Dick Griffey's purchase of Don Cornelius share of the Soul Train Recording Company. Dick Griffey purchased all of the Soul

Train Recording Company's assets for the sum of \$300,000. In purchasing Don Cornelius share of the company, Dick Griffey also purchased the goodwill associated with the trading name Soul Train Records. The Soul Train Recording Company label was losing money and Don Cornelius no longer wanted to be part of it. Don Cornelius complained that he had lost a couple of hundred thousand dollars on Soul Train Records and Dick Griffey agreed to pay Don \$300,000 which was to compensate him for his losses and to insure that Don would have no claim to any current or future Solar Records assets.

6. Dick Griffey renamed Soul Train Records, Solar Records. All Soul Train Records assets which included existing artist music and contracts and goodwill that existed from trading under the Soul Train Records name were transferred to Dick Griffey. I negotiated that arrangement with lawyers that Don had in Chicago. I recall that we received a release of all claims from Don at the time.

7. In later years, when I oversaw the licensing and sale of the Solar Records Catalogs, the former Soul Train Catalog was included, however I will specify that Dick Griffey never sold or licensed the use of the Soul Train Records name in any of those licensing or asset purchase agreements. The intellectual property or goodwill of a business is separate to the sale of specific music titles.

8. In my possession I have copies of several asset purchase agreements for Solar Records which include some of the Soul Train Records Catalog which demonstrate Dick's ownership of the Soul Train Records assets. I have provided these for the current proprietors of Soul Train Records. It must be noted that Dick Griffey did not sell the Soul Train Records goodwill or trademark in any of these asset purchase agreements. Upon his passing in 2010 all intellectual properties would have automatically passed on to his widow and children, the current proprietors of Soul Train Records in the UK.

- 1994 Castle Copyright for UK, Europe,
- 2005 Unidisc for USA and Canada
- 2007 Unidisc for Africa.”

The applicant’s evidence-in-reply

43. This consists of a further statement from Ms Cameron. As it consists of submissions rather than evidence, it is not necessary for me to summarise it here. I will, as before, keep its contents in mind in reaching a conclusion.

44. That concludes my summary of the evidence filed to the extent I consider it necessary.

DECISION

The objection based upon section 3(6) of the Act

45. The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), as follows:

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the

application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes 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": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

Preliminary point – the applicant’s pleading

46. In her witness statement filed in reply to the proprietors’ evidence, Ms Cameron stated:

“9. The statements made in this Witness Statement do not provide evidence that the present Registration was not filed in bad faith. Indeed...Carolyn Lucas Griffey states that "I do not make any claim to the intellectual property rights to the Soul Train TV Show or Soul Train Awards Show and any of their products of which the applicant has provided evidence. The Proprietors have provided evidence of use of their earlier marks (as admitted by Ms Griffey) in Classes 9 and 41. The present Registration covers "musical sound recordings", "merchandising" and "theatre entertainment". If Ms Griffey does not make any claim to the goods and services in respect of which the Proprietors have provided evidence of use, then these goods and services should not have been covered in the present Registration, and it was therefore filed in bad faith.” (my emphasis)

In her skeleton argument, Ms Cameron stated:

“6. Carolyn Lucas Griffey... "I do not make any claim to the intellectual property rights to the SOUL TRAIN TV SHOW or SOUL TRAIN AWARDS show and any of their products of which the applicant has provided evidence. No bona fide intention to use the mark in at least Classes 9 and 41.” (my emphasis).

47. At the hearing, Ms Cameron modified her position. While she conceded that the allegation of no bona fide intention to use in relation to the proprietor's goods and services in classes 9 and 35 was "more tenuous", she maintained that it applied to the proprietors' services in class 41.

48. At the hearing, I explained that having reviewed the applicant's pleadings in relation to section 3(6) of the Act (paragraph 5 above refers), I was unable to detect any reference to an allegation of no bona fide intention to use; Ms Cameron accepted that was correct. Consequently, even if the paragraph from Ms Cameron's witness statement I have reproduced above could be construed as an admission by the proprietors that they had no bona fide intention to use their trade mark in relation to the goods and services in classes 9 and 41 (which I very much doubt), at the hearing, she confirmed that the applicant had not made any request to amend its pleadings to add such a claim and she made no request to amend the applicant's pleadings in this regard at the hearing. In view of the above, at the hearing, I concluded it was not open to the applicant to rely upon such a claim and, as a consequence, I need say no more about it in this decision.

49. As to the claims pleaded, I begin by reminding myself of, inter alia: (i) the relevant date for assessing a claim to bad faith is the date the application was filed i.e. 15 May 2017, (ii) the proprietors are assumed to have acted in good faith unless the contrary is proven, (iii) bad faith is a serious allegation which must be distinctly proved, and (iv) it is not enough for the applicant to prove facts which are also consistent with good faith.

50. In reaching a conclusion, I must assess all the relevant factors, including what the proprietors knew about the matters in question and whether, in the light of that knowledge, their conduct is dishonest or falls short of the standards of acceptable commercial behaviour judged by the ordinary standards of honest people.

51. The applicant's evidence comes from Ms Blackman whereas the proprietors' evidence comes from, inter alia, Mrs Griffey and Mr Roberts. Mrs Griffey and Mr Roberts were personally involved when Soul Train Records was created; Ms Blackman was not.

52. Mrs Griffey and Mr Roberts' statements are accompanied by statements of truth. I note that the applicant's submissions in reply contained the following in relation to the evidence of Mr Roberts.

"11. The statements made [in Mr Robert's statement] do not provide evidence that the present registration was not filed in bad faith..."

53. However, as Mr Wood pointed out at the hearing, there has been no request to cross-examine either Mrs Griffey or Mr Roberts upon their evidence. He also urged me to give considerable weight to Mr Robert's evidence who, as a lawyer himself, would, he argued, be acutely aware of the consequences of giving false or misleading evidence. That, in my view, is a reasonable submission and it is upon Mr Robert's evidence I will focus, whilst not losing sight of the fact that his account of events is consistent with that of Mrs Griffey.

54. There appears to be no dispute that the SOUL TRAIN TV programme first aired in the USA in 1971 and that it was Mr Cornelius who created, produced and hosted the programme. In his evidence, Mr Roberts confirms that Mr Cornelius "was the sole owner of the Soul Train TV Show and Awards Show." Mr Roberts explains that Mr Cornelius and Mr Griffey worked together on the Soul Train TV Show, the latter as the "Talent Co-ordinator." While the applicant states it was Mr Cornelius who, in 1975, founded the record label SOUL TRAIN RECORDS, in his evidence, Mr Roberts explains that "separate to the TV show", Messrs. Cornelius and Griffey were business partners operating under Cornelius-Griffey Entertainment Company and Soul Train Recording Company aka Soul Train Records and that Soul Train Records was a division of Cornelius-Griffey Entertainment Company. He further explains that the Soul Train Recording Company was a separate legal and business entity to the Soul Train TV and awards shows and that Mr Cornelius and Mr Griffey were equal partners with equal ownership stakes. He recounts the events mentioned by Mrs Griffey in relation to Mr Griffey's share of the financial investment in Soul Train Records.

55. In his skeleton argument, Mr Wood stated:

“12...It is to be noted that the agreement between [Messrs. Cornelius and Griffey] to buy out Cornelius’ rights was more than 40 years ago and so it is unsurprising that the documentary evidence of the transaction is no longer available...”

56. Whilst documentary evidence would, of course, have been preferable, given the passage of time since the events occurred, that is not, in my view, an unreasonable submission. There is, however, the letter from 15 February 1982 to Dick Griffey productions from Melvin L Katten (who it is said was Mr Cornelius’ legal counsel) and which was copied to Mr Roberts which, as I noted earlier, contains a reference to “...the sale of the partnership interests to Dick Griffey.”

57. The evidence shows that the proprietors of the challenged registration are the widow and children of the late Dick Griffey and Ms Tsang, who explains that she has “represented and administrated the business interests of the Griffey family since 2006...” and that following Mr Griffey’s death in 2010 “the rights to the Soul Train Records trade mark passed to his successors...and a 25% share was assigned to [her].”

58. At the date the application was filed in May 2017, the proprietors would have been familiar with the business relationship that had existed between Mr Cornelius and Mr Griffey, the creation of Soul Train Records by Mr Cornelius and Mr Griffey and that Mr Griffey acquired the assets of Soul Train Records including the trading name Soul Train Records and the goodwill in that name. As Mr Roberts explains, they would also have been aware that Mr Griffey never sold or licensed the use of Soul Train Records in any licensing or asset purchase agreements. Finally, when Mr Griffey died in 2010, Mr Roberts further explains that “all intellectual properties automatically passed on to his widow and children.”

59. In their counterstatement, the proprietors intention is, explains Ms Tsang, to “begin recording and releasing music once again”. The proprietors of the trade mark in dispute are also the controlling minds behind SRL which owns the SOLAR

RECORDS trade mark which, I remind myself, was the name adopted by Mr Griffey to replace Soul Train Records.

60. In the application, the applicant alleges that the proprietors filed the application for registration “for an ulterior purpose, such as to leverage a right in Soul Train Records” and in her witness statement which accompanied the applicant’s evidence, Ms Cameron stated:

”25. At paragraph 13 of the Counterstatement, the Proprietors state that the current application was filed "with the intention to begin recording and releasing music once again". This appears somewhat to be an attempt by the Proprietors to capitalize on the Applicant's legitimate and continuous use of the SOUL TRAIN mark over many years, and also an attempt to capitalize on the existence of the back catalogue of SOUL TRAIN recordings which, as stated by the Proprietors, has already been sold to a third party.”

61. However, as Mr Wood pointed out at the hearing, no evidence has been filed in these proceedings which supports these assertions. As I mentioned earlier, bad faith is a serious allegation that must be both distinctly alleged and proved. Given the factual matrix I have described above, I am unable to identify any bad faith in the filing of the application by the proprietors, the consequence of which is that the objection based upon section 3(6) of the Act fails.

Conclusion under section 3(6) of the Act

62. For the reasons I have identified, the opposition based upon section 3(6) of the Act fails and is dismissed accordingly.

The objection based upon section 5(2)(b) of the Act

63. Under section 5(2)(b) of the Act, the applicant is relying upon the three trade marks shown in paragraph 4 above, all of which qualify as earlier trade marks under the above provisions. Given the interplay between the dates on which the applicant’s trade marks were entered in the register and the date of the application for

cancellation, all are subject to proof of use. In its application, the applicant states that it has used its earlier trade marks in relation to all the goods and services for which they are registered.

64. I remind myself that prior to the hearing, the proprietors were unrepresented. Approached on that basis, I note that when completing the Form TM8, the proprietors ticked box 7 indicating that they wanted the applicant to provide proof of use and, in paragraph 11 of their counterstatement, added:

“We request that the applicant provides proof of specifically using the name/trade mark 'Soul Train Records' in commerce in the UK within the last 5 years...”

Ms Tsang repeated the request for proof of use of “Soul Train Records” in paragraph 3 of her statement.

65. However, as Ms Cameron pointed out in paragraph 13 of her first statement and again in paragraph 3 of her statement in reply, as the trade marks upon which the applicant relies are, broadly speaking, for the words “SOUL TRAIN” and not “Soul Train Records”, “the requests for proof of use of SOUL TRAIN RECORDS are therefore misplaced and should be discounted.” That is clearly correct and is likely to stem from a misunderstanding on the proprietors’ behalf. Regardless, despite that misunderstanding, I note that in her statement, Ms Blackman states:

“2. For the purposes of these proceedings, the applicant has been asked to prove genuine use of the following marks and the goods and services for which they are registered...”

66. It is therefore clear that the applicant has proceeded on the basis that the proprietors’ request was to be construed as requiring it to demonstrate genuine use of the trade marks and goods and services relied upon. That was a sensible approach and was the basis on which both the proceedings continued and upon which it was approached by the parties in both their skeleton arguments and at the hearing.

Proof of use

67. In reaching a conclusion I must apply the same factors I would as if I were determining an application for revocation based upon non-use. In her statement, Ms Blackman defined the relevant period as 16 May 2012 to 15 May 2017, the latter date being the date the trade mark the subject of these proceedings was filed. In his skeleton argument, Mr Wood, by reference to sections 47(2B)(a)(i) and (ii) of The Trade Marks Regulations 2018 (“TMR 2018”), suggested that two periods were relevant. However, as the application for cancellation was filed on 28 March 2018 and the TMR 2018 only came “...into force on 14 January 2019”, at the hearing, it was agreed that the relevant period for present purposes is the five year period ending with the date the application for cancellation was filed i.e. 29 March 2013 to 28 March 2018.

68. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114...the CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

69. As one of the earlier trade marks relied upon is an EUTM (no. 1951003), the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Marken BV v Hagelkruis Beheer BV*, Case C-149/11 are relevant, in which the Court noted:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the

reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial

borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

70. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

"228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however,

it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

71. The General Court ("GC") restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This

applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

72. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown.

73. In paragraph 4 of her skeleton argument, Ms Cameron stated:

“Use has been shown in respect of the following:

Class 41: Entertainment services, being television, radio and live shows; theatrical and motion picture performances;

Class 9: Electronic publications; providing electronic publications (downloadable) from the internet.”

74. At the hearing, Ms Cameron restricted this list still further by deleting “motion picture performances”. While at the hearing Ms Cameron accepted that at least insofar as the trade marks relied upon were concerned the applicant’s strongest case lies with the versions of its trade mark presented in block capital letters, she further argued that the use of these trade marks was sufficient to constitute use of UK no. 2206036 within the meaning of section 47(2C)(a) of the Act.

75. Both in his skeleton argument and at the hearing, Mr Wood made a range of criticisms of the applicant’s evidence, many of which have considerable force.

Although I will keep these criticisms in mind, I do not consider it necessary to record them here. In approaching the applicant's evidence, I remind myself of the comments of Mr Daniel Alexander Q.C. acting as the Appointed Person in *Awareness Limited v Plymouth City Council* (Case BL O/236/13), in which he stated:

“22. The burden lies on the registered proprietor to prove use...However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

76. The decision of Mr Geoffrey Hobbs Q.C. (again as the Appointed Person) in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13 is also relevant, when he stated:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction

is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

Overview of the applicant’s evidence

77. Although Ms Blackman fails to identify what position she holds in the applicant company, she nonetheless explains the history of the SOUL TRAIN television programme and its broadcast in the United States between 1971 and March 2006. While there appears to be no indication as to when the first Soul Train Awards Show was held, it appears that all the Soul Train Awards Shows have taken place in the United States. Ms Blackman states that the Soul Train Awards Show has been shown in the European Union on the applicant’s BET channel. Air dates for the Soul Train Awards Show in France (from December 2015) and the UK (from May 2017) are provided, as are the times the programmes were broadcast and their duration. However, as Mr Wood pointed out, no indication is provided of the viewing figures these programmes achieved. Nonetheless, I note that all but one of the 20 occasions

on which the Soul Train Awards Show was broadcast in France occurred within the relevant period as did all but three of the 42 occasions within the UK. Since 2016, it has also been possible for those in the UK to stream the Soul Train Awards Show via the applicant's BET Play App, although no figures in this regard are provided.

78. References to, inter alia, The Soul Train Awards have appeared in the press and on the applicant's various web and social media sites. As of 12 December 2012, the applicant's Soul Train Facebook page had 55,963 "likes" with the figure in June 2018 increasing to 472,424 "likes" and 464,423 "followers" worldwide. Although no corroborative evidence is provided in support, it is stated that as of 13 September 2018, there were the following number of "fans" in the countries mentioned: 12,134 (UK), 8,912 (France), 4,945 (Germany) and 3,614 (Italy). Soul Train and the Soul Train Awards have been promoted on the applicant's BET International Facebook page and on the "official Soul Train" Instagram page, the latter of which had 17.1k followers at of 28 June 2018, of which it is said 4% are located in the UK and 1% in Germany; once again, no corroborative evidence is provided in support of the percentage figures provided.

79. As of 21 December 2016, the applicant's Soul Train Twitter page had 16.9k followers worldwide. The words Soul Train have also appeared on BET International's Twitter page and on BET Network's YouTube page. In her evidence, Ms Blackman stated:

"17. The applicant has invested considerable sums and creative effort in developing and promoting the SOUL TRAIN marks in the United Kingdom and European Union...".

However, not even estimates of the sums referred to have been provided.

80. Insofar as the trade marks relied upon are concerned, the evidence shows use in a range of formats including: "SOUL TRAIN AWARDS" (stylised) – a fairly typical example of which appears below:



“Soul Train”, “#SoulTrainAwards”, “SoulTrain Awards”, “SOUL TRAIN”, “soultrainofficial”, “SOUL TRAIN” (stylised), “@soultrain” and “soultrain.com”.

81. In light of the above summary, I must now decide if the applicant has made genuine use of the trade marks upon which it relies (or an acceptable variant) in relation to the now limited range of goods and services upon which it relies i.e.

Class 9: Electronic publications; providing electronic publications (downloadable) from the internet.

Class 41: Entertainment services, being television, radio and live shows; theatrical performances.

Class 9

82. In relation to this class the applicant relies upon its stylised trade mark UK no. 2206036 and plain word EUTM no.1951003. In her statement, Ms Blackman argues:

“16...The use of the SOUL TRAIN Marks through these social media platforms also amounts to use during the Relevant Period in respect of *"electronic publications"* and *"providing on-online electronic publications (downloadable) from the Internet"* in Class 9.

83. I begin by noting the web and social media information relied upon by the applicant which I have commented upon above. As I mentioned earlier, no indication

has been provided of the “considerable sums” the applicant states it has invested in promoting its SOUL TRAIN trade mark, nor, I note, have even estimates been provided of any income generated under this trade mark in relation to the goods now being relied upon. Regardless, simply using a trade mark on a web or social media platform does not, in my view, constitute creating or maintaining a market for electronic publications, whether those publications are, or are not, downloadable. As a consequence, the applicant is not, in my view, entitled to rely upon the goods it has identified in class 9 in these proceedings.

Class 41

84. In relation to this class, the applicant relies upon all three earlier trade marks. I note that the specifications of UK no. 2205267 and EUTM no. 1951003 are identical, whereas the specification of UK no. 2206036 includes the term “entertainment services” at large which is, of course, broad enough to include all the services upon which the applicant relies. For present purposes, I shall focus on UK no. 2205267 for the plain words SOUL TRAIN which, at the hearing, Ms Cameron agreed represented the applicant’s strongest case. In her statement, Ms Blackman argued:

“6...use of the SOUL TRAIN Marks has been made by the Applicant in France since 6 December 2015 and in the UK since 21 May 2017 through the broadcast of the Awards, as set out...Such use amounts to use during the Relevant Period in respect of all the Class 41 services covered by the SOUL TRAIN Marks and, in particular, *“entertainment services, being television, radio and live shows; theatrical and motion picture performances.”*

And:

“16...Further, given that many of the posts on the aforementioned social media platforms contain video clips of or about the Programme and Awards, these posts also amount to use of the SOUL TRAIN Marks during the Relevant Period in respect of the Class 41 services covered by the SOUL TRAIN Marks.”

85. While the evidence shows that within the relevant period the Soul Train Awards show has been broadcast in the UK on 39 occasions, as I mentioned above, no indication is provided of the number of viewers those broadcasts enjoyed. As I also mentioned above, the applicant has not provided any evidence of either the sums it has invested in promoting its SOUL TRAIN trade mark in, inter alia, the UK nor have even estimates been provided of, for example, any income generated by the broadcast of these programmes.

86. In reaching a conclusion, I also note the social media information mentioned above and that the applicant relies upon, inter alia, the video clips which appeared on these social media platforms in support of its claim to genuine use in relation to class 41.

87. At this point, I remind myself of the comments of Mr Alexander Q.C., in *Awareness Limited v Plymouth City Council* which are shown above.

88. In light of those comments it ought, in my view, to have been relatively straightforward for the applicant to provide the sort of evidence to which I have referred above, for example, income generated, marketing spend, viewer numbers, number of downloads/streams etc. Without such information, I am unable to conclude that its use is sufficient to create or maintain a market in the services upon which it relies. In addition, insofar as the applicant's social media activity is concerned, in my view, the mere fact that, for example, a person views a website or expresses an interest on a social media platform falls some way short of establishing that the applicant has been creating or maintaining a market in the UK in relation to the services being relied upon.

89. Even though the applicant's use in the UK assists it in relation to its EUTM, its position is no better, with its evidence suffering from the same defects I have already identified. Although the evidence shows that in addition to its use in the UK the Soul Train Awards show has also been shown on BET France since 2015, it was only shown on 20 occasions. Similarly, although the applicant is said to have 17,471 Facebook fans in Europe (in addition to those in the UK) and 171 Instagram

followers (in addition to the UK), that evidence does not assist the applicant for the reasons I have already explained.

Conclusion on proof of use

90. On the basis of the evidence provided, I am not satisfied that within the relevant period, the applicant has made genuine use of the trade marks upon which it relies in relation to the now limited range of goods and services mentioned above. As the applicant has not, in my view, established genuine use, it is not able to rely upon the earlier trade marks mentioned. As a consequence, its opposition based upon section 5(2)(b) of the Act falls at the first hurdle.

Conclusion under section 5(2)(b) of the Act

91. For the reasons I have identified, the application based upon section 5(2)(b) of the Act fails and is dismissed accordingly.

Overall conclusion

92. The application based upon sections 3(6) and 5(2)(b) of the Act have failed and, subject to any successful appeal, the proprietors' trade mark will remain registered.

Costs

93. As the proprietors have been successful, they are entitled to a contribution towards their costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. In reaching a conclusion, I remind myself that up until the hearing, the proprietors were not professionally represented; I shall return to this point shortly. At the hearing, Ms Cameron confirmed that, in her view, costs should follow the event and be on the scale. Mr Wood maintained the position adopted in his skeleton argument (shown below) urging me to also keep in mind the applicant's late failed attempt to rely upon the lack of intention to use point mentioned earlier.

“44. Insofar as there is consideration of costs, we say that the approach depends on your view as to the case. There are, in our view, 2 egregious steps by BET which are sharp practice and make this case one where an award above the scale should be made in the case of rejection of the application, or heavily reduced in the case of success:

a. The claim as to bad faith: we say this was speculative, was bound to fail, and that it must have been known to be the case on receipt of the defence. BET has put the Registered Proprietor to the trouble of the witness statements and has misrepresented the law and the evidential burden at each turn. This is unsatisfactory behaviour which has added to the cost and workload of the parties and the Tribunal.

b. The claim as to use: we say that it must have been clear to BET that it has not used the mark for the specifications as at the date of signature of the application for invalidity. In stark contrast to an opposition (where an initially wide claim may be understood as the result of late instructions) there is no deadline to file this document and so BET could (and should) have carefully considered the claims to use before filing it. Following the completion of the evidence, BET and its representatives must have known for sure that the claim as to use could not be maintained. The knowing misstatement of its use, the failure to limit their case to a sensible specification and their failure to remove reliance is unsatisfactory behaviour adding to the cost and workload of the parties and the Tribunal.

45. This behaviour looks all the worse when it is recalled that until recently the Registered Proprietors were not legally represented, and so mis-stating the law and the burden of evidence is all the more problematic.”

94. At the conclusion of the evidence rounds, the tribunal wrote to the parties. The letter, dated 21 February 2019 sent to the proprietors, included the following paragraph:

“If you intend to make a request for an award of costs, complete and return the attached pro-forma by **21 March 2019**. If it is not completed and returned, no costs, other than official fees arising from the action (excluding extensions of time), will be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour.”

95. As a review of the official record suggested that the tribunal had not received a copy of the completed costs pro-forma (possibly because on 5 March 2019 a hearing was requested by MJ), on 7 June 2019, the tribunal wrote to the parties. In that letter WIPL was asked to either provide a copy of the original costs proforma if one had been filed, or if one had not been filed and the proprietors were seeking an award of costs in respect of their actions prior to the appointment of WIPL, to provide a completed costs pro-forma within 7 days. WIPL was advised that any response provided should be copied to MJ who was then allowed 7 days to provide any comments it considered appropriate.

96. In an email dated 19 June 2019 (copied to MJ), Mr Wood responded to the above. He stated:

“I have now been provided by my client with the amounts as follows:

Notice of Defence £135, Preparing Evidence £675, Preparing for hearing £135, Attending hearing £135, Travel to hearing, £10.

I am informed that this reflects the fact that the client Jessie Tsang needed to take days off and this equated to the "loss" of a day's work at a value of £135 per day, rather than on the basis of Ms Tsang or the other owners logging time spent on the matter. I believe that it is appropriate to assign 7.5 hrs as a working day to those days. Using the multiple of £19 per hour this makes the amounts using that calculation as follows:

Notice of Defence £142.50, Preparing Evidence £712.50, Preparing for hearing £142.50, Attending hearing £142.50, Travel to hearing, £10.”

97. MJ elected not to respond to the above.

98. On 25 June 2019, Mr Wood wrote to the tribunal again. In that email (copied to MJ), he stated:

“Following the oral hearing in the present matter, the UKIPO has handed down its decision in case O-340-19 CARRY ON...We believe that it is relevant, and invite the Hearing Officer to consider it as part of the decision-making process...”

99. The applicant was given an opportunity to respond to the above and in its email of 10 July 2019 (copied to WIPL), it stated:

“In conclusion, therefore, it is clear that the factual matrix described in Case No O-340-19 is entirely different from the factual matrix in the current case and that accordingly the findings of the Hearing Officer in that case should not be relied on in the current case, but that rather genuine use should be found to have been made of the Cancellation Applicant’s earlier marks.”

100. Having already concluded (on the basis of the evidence provided and the submissions both written and oral) that the applicant has not satisfied the tests for genuine use, I do not consider it necessary to review the matter any further in light of the above decision and decline to do so.

101. The proprietors’ submissions in relation to costs are shown above. If successful, they seek costs above the scale because, broadly speaking, in their view, the claim to bad faith was bound to fail, the applicant failed to approach the specification upon which they may be able to rely in a realistic fashion and for raising at the last moment a previously un-pleaded claim to bad faith based upon a lack of intention to use. Although I have concluded the applicant’s claim to bad faith fails and that on the basis of the evidence provided I am not satisfied it has established genuine use in

relation to its earlier trade marks, there is, in my view, nothing which suggests that the applicant did not consider its case to be viable or that its pursuit of its various objections was in anyway abusive. While it is true that the applicant attempted to introduce a late alternative claim to bad faith without seeking permission to do so, that was dealt with fairly succinctly at the hearing and ought not, in my view, to have increased the proprietors' costs to any material extent. In short, I am unpersuaded that an award of costs above the scale is appropriate.

102. As I mentioned earlier, prior to the substantive hearing, the proprietors were unrepresented. In terms of the costs claimed prior to the hearing, the applicant has chosen not to comment upon the figures provided by Mr Wood in his email of 19 June 2019. When considered in relation to the sums claimed in relation to each category of work, the amount of time said to have been spent by the proprietors (i.e. Ms Tsang) on the various categories of work is, according to my calculations, as follows:

Activity	Hours spent	Amount claimed
Reviewing the application and filing a counterstatement	7.5 hours	£142.50
Preparing evidence and considering the other side's evidence	37.5 hours	£712.50
Preparing for the hearing	7.5 hours	£142.50
Attending the hearing:	7.5 hours	£142.50
Travel to the hearing		£10

103. As Ms Tsang is unlikely to have been familiar with the invalidation process and the associated law and rules and as it would have been necessary for her to liaise with her three co-proprietors, I accept it is likely to have taken her more time to complete the various activities mentioned above than might otherwise have been the case. Approached on that basis, given the nature of the application and the

proprietors' response to it, having spent 7.5 hours equating to **£142.50** on the first activity appears to me to be reasonable.

104. As to the second activity, in relation to which the proprietors state they have spent 37.5 hours, I note the applicant filed three witness statements, the first two of which were accompanied by thirteen exhibits and two exhibits, respectively. I am satisfied that those statements would have taken some time for Ms Tsang to review and discuss and having done so, for the proprietors to formulate an appropriate response. In reply, I note the proprietors filed three witness statements, one from Ms Tsang (accompanied by ten exhibits) together with the statements from Mrs Griffey (accompanied by three exhibits) and Mr Roberts (who is not a party to the proceedings). I have little doubt that Ms Tsang's statement and the associated exhibits would have taken some time to compile. Similarly, I am also satisfied that liaising with, inter alia, Mrs Griffey and Mr Roberts (both of whom are resident in the United States) in relation to their statements is likely to have been time consuming.

105. In relation to this activity, the TPN mentioned above states:

“From £500 if the evidence is light to £2200 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence.”

106. Although that guidance is provided in relation to parties who are professionally represented, it does, in my view, provide a useful context in which the proprietor's claim ought to be assessed. Considered on that basis, I am award the proprietors **£570** in relation to this activity (which equates to 30 hours @ £19 per hour).

107. Insofar as the third activity is concerned, as WIPL were appointed to represent the proprietors somewhat late in the day, I accept that Ms Tsang's input was likely to have been sought by Mr Wood during his preparation for the hearing and, as a consequence, the 7.5 hours spent (**£142.50**) in relation to this activity appears to be reasonable.

108. In relation to the fourth activity, for the reasons already mentioned, I understand why Ms Tsang's presence at the hearing was of benefit to Mr Wood and at the hearing he took instructions from her on a number of occasions. However, as the hearing only lasted 80 minutes, even allowing for discussions between Mr Wood and Ms Tsang prior to and after the hearing, the time sought appears to me to be excessive. Considered on that basis, I award the proprietors **£76** (i.e. 4 hours @£19 in respect of this activity).

109. Finally, in relation to the £10 sought in relation to "travel to the hearing", as no explanation is provided as to what this £10 might relate, I make no award in this regard.

110. As to WIPL's involvement, as required, Mr Wood provided a skeleton argument in advance of the hearing and the duration of the hearing was as mentioned above. Considered in the context of the guidance in relation to this activity mentioned in the above TPN, I award the proprietors an additional **£500** in this respect.

111. In summary, I award the proprietors the following sums in respect of the following categories:

Reviewing the application and filing a counterstatement	£142.50
Preparing evidence and considering the other side's evidence	£570.00
Preparing for and attending the hearing:	£718.50
Total	£1431

112. I order BET ST LLC to pay to Jessie Tsang, Carolyn Baldwin, Carolyn Lucas Griffey & Lucas Griffey, jointly, the sum of **£1431**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of July 2019

C J BOWEN

For the Registrar

The Comptroller-General