

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 1486681
BY MR GORDON GEOFFREY NUGENT
TO REGISTER A TRADE MARK IN CLASS 41**

AND

**IN THE MATTER OF OPPOSITION NO. 43140 THERETO
BY GEORGE COLLINGS**

**IN THE MATTER OF APPLICATION NO. 1497084
BY GEORGE COLLINGS TO REGISTER A TRADE MARK IN CLASS 41**

AND

**IN THE MATTER OF OPPOSITION NO. 43123
BY GORDON GEOFFREY NUGENT**

5 **TRADE MARKS ACT 1938 (AS AMENDED)**
AND TRADE MARKS ACT 1994

IN THE MATTER OF
10 **Application No. 1486681 by Mr Gordon Geoffrey Nugent**
to register a trade mark in Class 41

and

15 **IN THE MATTER OF Opposition No. 43140 thereto**
by George Collings

IN THE MATTER OF Application No. 1497084
by George Collings to register a trade mark in Class 41

20 **and**

IN THE MATTER OF Opposition No. 43123
by Gordon Geoffrey Nugent

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BACKGROUND

On 13 December 1991, Mr Gordon Geoffrey Nugent of Kirby, Merseyside applied under
Section 17(1) of the Trade Marks Act 1938 to register the trade mark THE
30 **UNDERTAKERS**, in Class 9 in respect of:-

Live band performances; all included in Class 41.

On 11 April 1992 Mr George Collings applied for the same mark, **THE UNDERTAKERS**, for
35 the same specification of services.

Both applicants claim use of the trade mark from a date earlier than the date of their
applications and each filed evidence and made written submissions to the Trade Mark Registry
accordingly. The matter therefore fell to be considered under the provisions of Section 12(3)
40 of the Act which states:-

12.(3) Where separate applications are made by different persons to be registered as
proprietors respectively of marks that are identical or nearly resemble each other, in
respect of-

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(a) the same services,

(b) the same description of services, or

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(c) services and goods or descriptions of services and goods which are
associated with each other,

5 the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or on an appeal (which may be brought either to the Board of Trade or to the Court at the option of the appellant) by the Board or the Court, as the case may be.

10 In the exercise of his discretion under this section of the Act the Registrar took the view that the issues to be determined in respect of these applications should properly be settled in formal inter partes proceedings. Thus, in line with the Registrar's standard practice, the two applications were Advertised before Acceptance for opposition purposes under the provisions of Section 18(1), in the same issue of the Trade Mark Journal, and each applicant
15 subsequently opposed the others application.

On 20 September 1995 Mr Collings filed notice of opposition against application number 1486681 of Mr Nugent. The grounds of opposition are, in summary:

- 20 (a) under Section 11 by reason of Mr Collings use of the trade mark
- (b) under Section 17(1) because Mr Nugent can not claim to be the proprietor of the trade mark.

25 On 14 September, Mr Nugent filed notice of opposition against application No.1497084 by Mr Collings. The grounds of opposition in summary are, again:

- (a) under Section 11 by reason of Mr Nugent's use of the trade mark.
- 30 (b) under Section 17(1) because Mr Collings can not claim to be the proprietor of the trade mark.

Each side filed a counterstatement in response, denying each of the grounds of opposition. Both applicants asked for the exercise of the Registrar's discretion in their favour and sought
35 an award of costs.

Both sides filed evidence in these proceedings and the matter came to be heard on 12 November 1997. At the Hearing Mr Nugent represented himself and Mr Collings was represented by Ms J Maddox, of W P Thompson & Co, his trade mark agents.
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By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of The Trade Marks Act 1994. Nevertheless, these proceedings having begun under the provisions of the Trade Marks Act 1938, they must continue to be dealt with under that Act in accordance with the transitional provisions set out
45 at Schedule 3 of the Trade Marks Act 1994. Accordingly, and unless otherwise indicated, all references in the remainder of this decision are references to the provisions of the old law.

Mr Geoffrey Nugent's Evidence

50 Mr Nugent filed a Statutory Declaration dated 24 May 1996 in which he confirms that he is the applicant in respect of Application No. 1486681 and the opponent in the proceedings against Application No. 1497084. He attaches as Exhibit GN1 a Statutory Declaration made

5 on 18 January 1993, together with its exhibits, which was filed at the Trade Mark Registry in support of his application. This sets out the history of his involvement with the name THE UNDERTAKERS.

10 Mr Nugent states that in 1959 he was a founder member of a band called 'The Vegas Five' which in the middle of 1961 changed its name to THE UNDERTAKERS, under which name the band became very well known in Liverpool and in the North West of England during 1962 and 1963. During that time THE UNDERTAKERS went on tour in Germany and they performed on radio and television programmes broadcast nationally in such programmes as Independent Television, "Thank Your Lucky Stars", and "Ready Steady Go".

15 In 1963 the band signed a recording contract with Pye Records Limited. A copy of that contract together with extension and termination letters is exhibited. Three records were released under the terms of the contract. "Do The Mashed Potato" "What About Us", (which appeared in the "Merseyside Tops" popular music chart) and "Just A Little Bit", (which in 20 1964 reached 34th place in the UK National charts). A tour of the UK, and a further tour of Germany, took place at that time.

25 Mr Nugent states that the band was one of the leading proponents of music described as "Mersey Beat", which he says was extremely popular at the time. He was the lead singer of THE UNDERTAKERS and, in his view, the name of the band became associated in the minds of the public with himself. In September 1964 the band also adopted the name of 'The Takers' and released a record under that name. By way of explanation, Mr Nugent says that the name was adopted only for the purposes of appearing in broadcasts by the British Broadcasting Corporation, which took exception to their real name, apparently on the grounds 30 of taste. For all other broadcasts and appearances they continued to appear as THE UNDERTAKERS.

35 The band was subsequently 'in 1965' invited to tour the United States of America. Although some members went to America, the band itself did not and was disbanded. Their recording contract with Pye Records was terminated.

40 Mr Nugent goes on to explain that he continued to perform on a solo basis or with others under a number of names between 1965 and 1984. In 1984 he was approached on behalf of the organisers of the International Garden Festival at Liverpool who wanted a band to play the type of music which had been played by THE UNDERTAKERS. Apparently this was at a time when there was a renewed interest in the music described by Mr Nugent as 'Mersey Beat'. Mr Nugent says that at that time he still had a local reputation; people remembered THE UNDERTAKERS and he was approached because he was the only original member of the band still working in the area. He subsequently agreed to form a band under the name 45 THE UNDERTAKERS and recruited five others, including Mr George Collings, the applicant for trade mark No. 1497084. Mr Nugent says he was their lead singer and front man and he taught them how to play in the style of the period. In his view, it was his membership of the original band called THE UNDERTAKERS which provided much of the interest in the new band in the minds of the public and promoters of events and shows. He considered that the goodwill in the name THE UNDERTAKERS was therefore associated with him and not with 50 any other members of the band.

5 The partnership with Mr George Collings and other members of the band was dissolved in February 1988, says Mr Nugent, and is now the subject of litigation in the High Court. He subsequently performed under the name of “GEOFF NUGENT’S UNDERTAKERS” but claims proprietorship of the trade mark THE UNDERTAKERS because of continuous use of the trade mark since the 1960’s.

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The litigation in the High Court has been dormant for some time, but Mr Nugent explains that he gave a voluntary undertaking to the Court to use only the name GEOFF NUGENT’S UNDERTAKERS in respect of the band with which he now performs. However, in support of his claim to proprietorship of the trade mark THE UNDERTAKERS, Mr Nugent exhibits copies of royalty statements which show that he continues to receive monies in connection with the original band’s records and re-releases which are made from time to time. He also exhibits copies of posters and publicity material: Some of this material, he states, is produced by George Collings in which the latter makes claims to recordings etc. made by the original group with whom he, George Collings, was not involved.

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Mr George Collings’ Evidence in Reply

Mr Collings filed a Statutory Declaration dated 26 November 1996 in response to the above.

25 Mr Collings states that Mr Nugent left THE UNDERTAKERS band of his own volition, having given the members of the band notice of his intention to do so in October 1987. He goes on to point out that Mr Nugent’s claim to proprietorship of the trade mark THE UNDERTAKERS is somewhat flawed in that the original band ceased to provide live entertainment services in the late 1960’s and between then and 1984 he performed either alone or with a variety of others under a variety of names. Mr Collings states that to his own knowledge Mr Nugent performed under the name Vern Gordon during that time.

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Evidence in Chief of Mr George Collings

35 Mr George Collings, filed a Statutory Declaration dated 15 May 1996, in which he first of all set out the background to his involvement with the band called THE UNDERTAKERS. In the early part of 1984, during the International Garden Festival at Liverpool, Geoffrey Nugent, Mr Derek White and himself, and some other freelance musicians, joined together to form a temporary musical group which performed under the name THE UNDERTAKERS. In January 1985, it was decided to come to a more formal arrangement and thus Mr Nugent, Mr White and Mr Collings invited Mr Mark Clarke, Mr Richard Austin and Mr Christopher Gladding to join the band which provided live musical entertainment services under the name THE UNDERTAKERS. Between then and 1988 the band performed locally in clubs and other venues and during that time Mr Collings claims to have been responsible informally for the running of the band; he would arrange the bookings, distribute the earnings and generally organise the band so that all the members turned up at the “gig” on time.

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Apart from the purchase of some equipment, the costs of which were shared between the members of the band, there were no common assets and the income received from the band’s performances were shared out immediately after each performance. Later, the band appointed Tony King Entertainments as their managing agent but Mr Collings claims that he continued to be the person in the band responsible for administration. In that connection he produces

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5 sample booking slips, diaries, copy contracts etc. dated between 1985 and 1991.

On 31 October 1987 Mr Collings states that Mr Nugent handed in his notice stating that he would leave the band on 31 December 1987. In fact he continued to perform with the band until 24 February 1988 on which day Mr Nugent failed to appear for a performance the band was due to give at a major charity show in the Merseyside area. Despite entreaties from other members of the band he refused to attend and indicated that he no longer wished to sing in the band. Mr Collings goes on to state that Mr Nugent felt that some monies were due to him in view of his contribution to the establishment of the band and after negotiations an agreed sum of money and 75 EP records were provided to Mr Nugent in settlement of any claims that he might have on the goodwill attached to the bands name. The band subsequently recruited a new member; there was no interruption in the services provided by the band under the trade mark THE UNDERTAKERS and it has continued to flourish. Mr Collings provides details of the band's approximate earnings each year from 1985 to 1995. These show that each year the band earns between £11,000 and £30,000, per annum.

Mr Collings produces as an exhibit to his declaration a copy of the Statutory Declaration which he filed in support of the Application No. 1497084 at the examination stage. This explains in Mr Collings view, that the band THE UNDERTAKERS has provided public musical performances consistently under that name since 1984, in all parts of the United Kingdom, and that because of his continued connection with the band then he (Mr Collings) is entitled to the proprietorship of the trade mark THE UNDERTAKERS.

Mr Collings says that shortly after Mr Nugent left the band it came to his attention that the latter had established his own band which performed under the name 'Lodgers Clogg' and then 'Chain of Events'. Later, says Mr Collings Mr Nugent started advertising his band under the name of GEOFF NUGENT'S UNDERTAKERS and then, more often, offered his services to clubs and similar venues under the name THE UNDERTAKERS. Confusion with Mr Collings' band was the inevitable result and the members therefore commenced High Court proceedings against Mr Nugent for passing off.

An Interlocutory Order against Mr Nugent was handed down on 8 May 1989 which stipulated that Mr Nugent could offer his musical entertainment services under the name GEOFF NUGENT'S UNDERTAKERS but that he was not entitled to use the term THE UNDERTAKERS, pending a full trial. These proceedings are still pending and the Interlocutory Order, still in place, is exhibited. Mr Collings goes on to say that from then until the present day Mr Nugent has performed under the name GEOFF NUGENT'S UNDERTAKERS and he produces exhibits to show this.

Mr Collings goes on to state that he ensured the continuation of THE UNDERTAKERS by recruiting new players as and when others, including the other original members, left. The contract with Tony King Entertainments came to an end in 1991 following which he re-assumed responsibility for organising the bookings and for promotion etc. He is now the only remaining member of the band formed in 1984 and claims that it is through his efforts that it still exists and enjoys the reputation and goodwill now attached to it.

In support of Mr Collings evidence in chief, Ms Jennifer Margaret Maddox, a partner of W P Thompson & Co filed a Statutory Declaration dated 15 May 1996.

5 Ms Maddox states that on 18 April 1996 she sent out a letter and questionnaire to twenty four
persons involved in the live entertainment business and situated throughout the United
Kingdom. Copies of the letters and questionnaires sent out and the eighteen questionnaires
which were completed and returned are produced as exhibits. None of the respondents to the
questionnaire have completed Statutory Declarations to confirm what they said in response to
10 these questionnaires. However, the majority of those asked whether there was any one person
they would associate with the band THE UNDERTAKERS (having already been asked
whether they knew of the band which performed under that name) said that they associated
the band with George Collings. None of the respondents associated the band with Geoffrey
Nugent.

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Mr Geoffrey Nugent's Evidence in Reply

In response to Mr Collings' Statutory Declaration, Mr Nugent filed a Statutory Declaration
dated 26 November 1996 in reply. He re-states his claim that it was he who invited the others
20 to join a group in 1984. He was asked by Tony Smith and Michael Hanlen on behalf of the
organisers of the Garden Festival at Liverpool if he would join with a number of bands
performing at the Liverpool Garden Festival to take part in a show called "The Mersey
Sound". Other groups involved were 'Farons Flamingoes' and 'Lee Curtis and the All Stars'.
He, Mr Nugent, approached a number of people to perform under the name of THE
25 UNDERTAKERS including Mr George Collings and Mr Derek White who both agreed to
join. Mr Nugent states that he provided the name of THE UNDERTAKERS and the style of
dress and type of music played.

Mr Nugent says that Mr Collings' claim to have had responsibility for aspects of the
30 administration of the band during the period 1984 to 1986 is incorrect. Mr Nugent kept the
diary and distributed the earnings and arranged attendance times etc. This, he explains, only
changed in 1986 when, after an appearance at Fazakerley British Legion, George Collings
offered to do the bookings and did so in conjunction with the then agent Tony King
Entertainments.

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In Mr Nugent's view he did not leave the band but in view of the other members attempts,
behind his back, to replace him with another singer he sacked them. He accepts that he
received money and EP records at the time but this was not as part of a final settlement.

40 With this summary of the evidence filed in these proceedings in mind I turn to consider the
grounds of opposition which are founded on Sections 17(1) and Section 11. I consider first
the conflicting claims under Section 17(1) which reads:-

45 **17.(1)** Any person claiming to be the proprietor of a trade mark used or proposed to
be used by him who is desirous of registering it must apply in writing to the Registrar
in the prescribed manner for registration either in Part A or in Part B of the register.

This first issue relates to the question of proprietorship of the trade mark. Both Mr Collings
and Mr Nugent claim ownership of the trade mark in suit and both therefore claim to be
50 entitled to register the trade mark THE UNDERTAKERS in their name.

5 From the evidence and the submissions made to me at the Hearing it would appear that a band
called THE UNDERTAKERS was formed in 1963. This band, of which Mr Nugent was a
member, went on to have some success, and therefore reputation, in the United Kingdom
through their recordings and live appearances. However, that band ceased to exist in or
10 around 1965 when some members went to the United States. As far as I can ascertain no one
is claiming that any reputation derived from the period following the breakup of the band in
1965 accrues to anyone though I note that Mr Nugent like, presumably, the other signatories
to the recording contract continues to be paid royalty payments. Therefore, I need not
consider this earlier period because, it seems to me, that any reputation in the trade mark THE
UNDERTAKERS in respect of live musical performances (or indeed in respect of recordings)
15 built up in the years 1961 to 1965 dissipated in the years 1965 to 1984. Certainly no
independent evidence has been placed before the tribunal to suggest otherwise.

In 1984, it seems to be common ground, that Mr Nugent was asked to form a band under the
name of THE UNDERTAKERS for the purposes of a particular event at the International
20 Garden Festival at Liverpool. Mr Collings was subsequently recruited to become a member of
that band. It is therefore in respect of that band which bears the name THE UNDERTAKERS
on which this dispute is centred. Mr Nugent claims that as it was he who was asked to form a
band called THE UNDERTAKERS to undertake performances at the International Garden
Festival, any reputation in the name accrued to him and that this continues to be the case. Mr
25 Collings contests this because he claims that Mr Nugent left the band in 1988, and that there
was a financial settlement. Subsequent events lead to proceedings before the High Court as a
result of which an Order was issued preventing Mr Nugent from using the name THE
UNDERTAKERS, but allowing him to use the name GEOFF NUGENT'S UNDERTAKERS.

30 This matter of proprietorship of the registered marks was considered in the AL BASSAM case
RPC 1995. In that case, at page 522, Morrill L J, having quoted from Lord Diplock in the G
E trade mark case [1973] [RPC 297] said:-

35 “Accordingly it is necessary to start with the common law principals applicable to
questions of the ownership of unregistered marks .

These are not in doubt and may be shortly stated. First the owner of a mark which had
been used in conjunction with the goods was he who first used it. Thus in Nicholson
& Sons Limited application (1931) 48 RPC 227 at page 253 Lawrence L J said:

40 “The cases to which I have referred (and there are others to the like effect)
show that it was firmly established at the time when the Act of 1875 was
passed that a trader acquired a right of property in a distinctive mark merely by
using it upon or in connection with his goods irrespective of the length of such
45 user and of the extent of his trade and that such right of property would be
protected by an injunction restraining any other person from using the mark.

Second the right to the used mark as an indication of the origin of the goods
could not be assigned separately from the goodwill of the business in which it
had been used for that would have been to assign the right to commit a fraud
50 on the public. c.f. Pinto v Badman (1891) 8 RPC 181-194. Third in the case
of an unused mark the person with the best right to use it was the designer or
inventor, c.f. Hudson's Trade Marks (1886) 3 RPC 155 at pages 116-163".

5 Though that case referred to use of a trade mark in relation to goods I consider that the comments apply equally to services.

10 In this case, as indicated earlier, it seems to me, that the reputation in the name of the original band called THE UNDERTAKERS was dissipated in the 19 years following the dissolution of the band in 1965. The recording company has not sought to maintain the reputation of THE UNDERTAKERS other than to re-release their old recordings in various forms from time to time. Nor did the original members of the band seek to do so. Indeed during the period 1965 to 1984 the only role played by the original members was to receive their royalty payments in respect of these recordings.

15 In 1984, however, Mr Nugent was asked to form a band under the name THE UNDERTAKERS because he was a member of the original band, was still engaged in the music business and still resided in Liverpool. Though initially the formation of the band was of a temporary nature, to appear in a show connected with the Garden Festival under the title of 'The Mersey Sound', a more permanent arrangement followed and the band went on to provide live entertainment services in Liverpool and throughout the North West of England.

20 At that point it would appear that Mr Nugent had a legitimate claim to proprietorship of the unregistered trade mark THE UNDERTAKERS. He was a member of the original band and, no other member appears to have had any interest in the name. Also, Mr Nugent was the prime mover in 1984 in recruiting, organising and teaching the other members of the band to perform under the name THE UNDERTAKERS, at that time an unused trade mark. Therefore, in my view, he was the first to use the term THE UNDERTAKERS and thus the proprietor of the unregistered trade mark.

25 In reaching this view I have regard to the fact that Mr Collings has not sought to challenge directly Mr Nugent's version of events but lays his claim to proprietorship on the fact that Mr Nugent left the band and a settlement between the band and Mr Nugent was reached in respect of any claims the latter might have had in respect of the bands' name. Mr Nugent, as indicated, disputes that there was a settlement in that respect.

30 Whatever was the cause, it is a fact that Mr Nugent left the band in the early part of 1988. It is also a fact that he received at that time from the other members of the band monies and some 75 EP records. Subsequently he provided live musical services under names other than THE UNDERTAKERS, with bands called 'Lodgers Clogg' and 'Chain of Events' before reverting to the use of THE UNDERTAKERS or GEOFF NUGENT'S UNDERTAKERS. Mr Nugent is, also prevented currently from using the name THE UNDERTAKERS and has been since 1989 as a result of the High Court Order.

35 At the time of his leaving the band Mr Nugent was compensated or recompensed for something, by the payment of monies and the receipt of records. No agreement or contract has been evidenced which would settle what the payment was for. I must therefore reach a view as best I can on that matter and in doing so have concluded that it must have been in respect of a final settlement between the band and Mr Nugent. In reaching this view I take account of the fact that income received by the band was always shared out immediately after each performance. The money paid to Mr Nugent in 1988 and the EP records he received were not therefore in respect of income earned when he performed with the band. Nor could it have been in respect of equipment or common assets because there were none. I can only

5 conclude therefore that monies was paid over to Mr Nugent for any claim he might have in the name of the band and any reputation accruing to it.

I am reinforced in this view by the fact that Mr Nugent formed another band at that time under a completely different name and subsequently provided live band performers under another
10 name. It was some time afterwards that he sought to use the name THE UNDERTAKERS again and was subsequently prevented from doing so by the Interlocutory Order.

The evidence filed by Mr Collings shows that after Mr Nugent's departure in 1988, Mr Collings and the other members of the band continued to provide live musical performances
15 under the name THE UNDERTAKERS and, though I give very little weight to them because they are not sworn evidence, the responses to Ms Maddox's letter and questionnaire support that fact. This evidence also supports the view that Mr Nugent's association with the band has been extinguished and the name is now associated with Mr Collings.

20 I believe that Mr Nugent upon his departure from the band ceased to have any rights in the trade mark THE UNDERTAKERS. I note that the Interlocutory Order prevents him from using that name for live band services but that the Order does allow him to use the term GEOFF NUGENT'S UNDERTAKERS but make no comment on that. In all of the
25 circumstances, I dismiss Mr Nugent's claim to proprietorship of the trade mark THE UNDERTAKERS.

In my view the proprietorship of the unregistered trade mark and the reputation in the band THE UNDERTAKERS passed to Mr Collings on the departure of Mr Nugent. It was Mr Collings who organised and continued to organise the band, directly or in conjunction with an
30 Agent. He took responsibility for replacing members who left and arranges bookings etc. Thus the goodwill and reputation generated by the band since the departure of Mr Nugent is largely due to Mr Collings and accrues, in my view to him. Thus he could reasonably claim to be the proprietor of the trade mark in suit when he applied to register it on 11 April, 1992.

35 In view of the above I consider that Mr Nugent's opposition to Mr Colling's application No. 1497084 based upon Section 17(1) of the Act fails and Mr Collings opposition to Mr Nugent application No. 1486681, on the same grounds, succeeds.

I go on to consider the respective grounds of opposition based upon Section 11 which states:
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11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be
45 contrary to law or morality, or any scandalous design.

Having found that the trade mark THE UNDERTAKERS is the property of Mr George Collings in respect of the provision of live band performers any use of the same trade mark by Mr Nugent (or anyone else) would be likely to deceive the public or cause confusion.

5 Therefore I must hold that Mr Colling's opposition to Mr Nugent's application on the Section 11 ground succeeds and that Mr Nugent's opposition to Mr Collings' application on that ground fails.

10 My attention was drawn during the Hearing to the "Quiet May" trade mark FSR 1966 which held in an action to rectify the register by the removal of a registration that in the light of the applicant for rectifications evidence of use of the unregistered trade mark "Quiet May", there was a substantial likelihood that use of the same mark by the registered proprietor, in respect of the same goods, at the date of registration would have caused deception and confusion amongst a substantial number of persons. Accordingly, the mark offended against the provisions of Section 11 of the Act and was expunged. Whilst the circumstances in this case are somewhat different I have taken note of the points made in that case in reaching my decision in this case.

20 There remains the request by both parties for the exercise of the Registrar's discretion. However, as I have found for Mr Collings in respect of both Section 17 and Section 11, the latter being mandatory, no exercise of discretion is necessary or possible .

25 The opposition by Mr Collings is therefore successful and his application no. 1497084 will proceed to registration. The application for registration by Mr Nugent no. 1486681 stands refused.

In view of my decision on the substantive matters, I order Mr Nugent to pay to Mr Collings the sum of £500 as a contribution towards his costs.

30 **Dated this 27 day of January 1998**

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M KNIGHT
For the Registrar
The Comptroller General

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