

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2257907
BY MANHATTAN CORPORATION LIMITED TO REGISTER A TRADE MARK
IN CLASS 12**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 52583
BY THE BRITISH BROADCASTING CORPORATION**

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2257907

by Manhattan Corporation Limited to register a Trade Mark in Class 12

AND

IN THE MATTER OF Opposition thereto under No. 52583

by The British Broadcasting Corporation

BACKGROUND

1. On 12 January 2001, Manhattan Corporation Limited applied to register the word **TARDIS** as a trade mark in Class 12. The application was accepted and was published for the following specification of goods: "Vehicles".

2. On 21 May 2001, The British Broadcasting Corporation filed notice of opposition. The opponents are the registered proprietors of registration Nos: 2054001 and 2138520 for the trade marks THE TARDIS/TARDIS (series of 2) registered in Classes 9,25,38 and 41 and TARDIS registered in Class 20 - full details of these registrations can be found in the Annex to this decision. They claim to have made use of the word TARDIS since at least the early 1960s. Stemming from this background, objections are said to arise under Sections 3(6), 5(3) and 5(4)(a) of the Act.

3. On 3 August 2001, the applicants filed a counterstatement which in essence consists of a denial of the various grounds of opposition. In their counterstatement, the applicants explain that they have been established in the motor industry for some twenty years adding that during the last three years they have invested substantially in the design, prototype and manufacture of the Manhattan Tardis motorhome, with the applicants first use of Manhattan Tardis taking place in January 2001.

4. Both parties filed evidence in these proceedings and both seek an award of costs. The matter came to be heard on 21 November 2002. At the Hearing, the applicants were represented by Mr Danny Blundell and Ms Sandra Merrington of the applicant company; the opponents were represented by Mr Paul Walsh of Bristows, Solicitors.

Opponents' evidence

5. This consists of a witness statement dated 15 November 2001 by Nicholas George Foot. Mr Foot explains that he is a barrister and solicitor of the High Court of New Zealand. Since January 1999 he has been employed as Trade Marks Lawyer in the opponents' Commercial, Legal & Intellectual Property Department. Mr Foot confirms that he is authorised to make his witness statement on the opponents' behalf, adding that the information in his statement comes from his own personal knowledge or from company records and documents to which he has full access.

6. I take the following relevant points from Mr Foot's witness statement:

- that the BBC is a well known broadcasting and entertainments organisation, their television and radio programmes are watched and listened to by millions of people on a daily basis;
- that one of the BBC's most prominent brands, used in its famous television programme Dr Who, is TARDIS and that the opponents own a number of registrations containing this word in various classes (exhibit NGF1);
- that TARDIS has been used by the opponents in the United Kingdom since the early 1960s initially in the television programme Dr Who which is an entertainment programme in the field of science fiction featuring time and space travel. Use of the TARDIS in the Dr Who programme is fundamental to the programme as TARDIS is the name of the machine by means of which the character Dr Who travels through space and time to planets throughout the universe including earth. It consists externally, of a police telephone box but internally, it is dimensionally transcendental- that is, it has no definable size and therefore gives the illusion of extraordinary space and of being space-efficient;
- that the Dr Who television programme was first broadcast in the United Kingdom on 23 November 1963 and that apart from a hiatus in 1990 and 1995, new or repeat Dr Who programmes have continued to be broadcast on a regular basis from 1963 up to and beyond the filing date of the application in suit; there have been 26 series and approximately 700 episodes, making Dr Who the longest running television science fiction series in history (exhibit NGF3); that since November 1963 the Dr Who television series has been televised in over 80 countries with a worldwide audience in excess of 110 million people;
- that at its peak, the Dr Who television programme is estimated to have been watched, on average, by in excess of 10 million viewers in the United Kingdom (exhibit NGF4);
- that the Dr Who television programme has regularly featured in listing magazines such as the BBC's Radio Times; a selection of articles and listings between November 1967 and January 2001 are provided in exhibit NGF5;
- that the Dr Who programme and names and images associated with it have regularly featured in the national press (exhibit NGF7);
- that the BBC has its own Dr Who website (exhibit NGF8);
- that the reputation of the TARDIS trade marks has been enhanced by the opponents' merchandising activities relating to Dr Who. It is, says Mr Foot, common for the opponents, in addition to its broadcasting activities, to make

and sell or authorise others to make and sell goods relating to its programmes. The opponents' trading interests are carried out mainly, but not exclusively, through BBC Worldwide which exploits, throughout the world, goods relating to programmes broadcast by the BBC;

- that the BBC has engaged in substantial merchandising in relation to the Dr Who television programme since the mid 1970s. Turnover from Dr Who/TARDIS merchandising (not including books and videos) over the past five years has been in the region of £80,000 per year. Exhibit NGF9 consists of examples of merchandise produced in relation to the Dr Who programme;
- that the Dr Who television programme and the TARDIS trade marks have also been extensively exploited over many years by the BBC and its licensees through sales of sound records, audio cassettes and video recordings relating to Dr Who (exhibit NGF10). Exhibit NGF11 consists of a list of video recordings relating to the Dr Who series together with an indication of the numbers of videos sold during the financial years 1994 and 1995.

In so far as the application in suit and the goods for which registration is sought are concerned, Mr Foot makes the following comments:

- that the parallels with the TARDIS machine are obvious - both the TARDIS machine and the applicants' vans are "converted", both are used for living and travelling in and both are internally space efficient;
- that in view of the BBC's merchandising activities to which the public are accustomed, they will assume that the applicants' vehicles are licensed or endorsed by the BBC;
- that the concept behind the TARDIS is space efficiency. The applicants' use of the word TARDIS for vehicles and especially motorhomes which by their nature are required to be space efficient will be detrimental to the distinctive character and repute of the BBC's TARDIS trade marks, as it will render those marks descriptive for goods which, externally, do not appear to be large but, internally, are space efficient.

Applicants' evidence

7. This consists of a witness statement dated 11 February 2002 by Sandra Merrington. Ms Merrington explains that she is the Director of Manhattan Corporation Limited a company which carries on the business of manufacturing motor-homes and the conversion of commercial vehicles to motor-homes. Ms Merrington states that she has been employed by the company since 1991 and is familiar with the business and goods manufactured by them.

8. The following points are derived from Ms Merrington's witness statement:

- that the Manhattan Tardis is a standard commercial van which has been converted, rear of the driver/passenger cab to a motorhome. The vehicle comprises a sitting/sleeping area integrated with a small kitchen and toilet facilities at the rear end;
- that due diligence was shown in carrying out pre-filing searches. The applicants had, says Ms Merrington, arrived at an acronym which best suited and described the newly designed Fiat Ducato van, namely **(T)ravelling (a)nd (R)ecreational (D)riving (i)n (S)afety**. The next step was, says Ms Merrington, to register the applicants' interest in class 12. The applicants' first search revealed that the word TARDIS had not been registered in class 12, but further searches revealed the BBC's registered trade marks in classes 9, 20, 25,38 and 41. In light of these searches, the applicants took the view that there would be no conflict between motor-homes and the opponents' goods and services in the classes indicated;
- Exhibit SM1 consists of a Manhattan Tardis sales brochure. Ms Merrington states that there is no reference or inferences suggested in the design or wording of the brochure to remotely cause the reader to associate the Manhattan Tardis with the BBC. She goes on to say that a recent purchaser of a Manhattan Tardis was asked if she was swayed to the vehicle because she thought there may be an association with the BBC. Exhibit SM2 consists of a copy of an open letter dated 26 November 2001 from Barbara Hands of Deeside, Clwyd. The letter indicates that she believes that the word tardis has become generic for "it is roomy inside".

Opponents' evidence-in-reply

9. This consists of a second witness statement dated 3 May 2002 by the same Nicholas George Foot mentioned above. The following points emerge from Mr Foot's witness statement in reply:

- that in paragraph 4 of her statement Ms Merrington says that TARDIS is an acronym for "Travelling and Recreational Driving in Safety" whereas the brochure exhibited at SM1 refers on its front page to TARDIS as "Touring and Recreational Driving In Safety". Mr Foot comments that the words "travelling" and "touring" are not interchangeable and adds that it is not clear when the brochure was printed for circulation;
- that in so far as exhibit SM2 is concerned (the letter from a recent purchaser) the letter is strange for several reasons. These reasons are said to be (i) it is addressed to "whom it may concern" rather than to Ms Merrington or a representative of the applicants or the applicants themselves and (ii) it does not refer to an inquiry from Manhattan Corporation. Mr Foot comments that one would expect a reply to an enquiry from Manhattan Corporation to refer to that company as "you" and to their vehicles as "your vehicles". He adds that the letter does not state that the writer associated or did not associate Manhattan

Corporation's TARDIS vehicle with the BBC's TARDIS trade mark and that details of Manhattan Corporation's enquiry to the writer are not provided;

- that the applicants' use of TARDIS creates an immediate association with Dr Who and the opponents and that Manhattan Corporation's use of TARDIS indicates that their vehicles are space-efficient just like the opponents' TARDIS machine. Mr Foot notes that the following text appears in the applicants' brochure:

“Van conversions are very compact and tight once inside, but not so with the Tardis, the extra space it gives is its Unique Selling Point, something that really captures the imagination.....It's in a really compact vehicle where it [a lounge slide-out] really makes a difference, nearly doubling the living space.....the Tardis is not only high on performance and manoeuvrability, but as spacious and well-equipped as many larger coach built motorhomes. The Tardis appeals to veteran motorcaravanners who are astounded and absolute newcomers who are surprised at how much a small vehicle can fit in.”

And:

“..the slide-out concept, and its realisation, is a leap forward in modern motor caravan design. All normal van conversions are now going to feel cramped.”

10. That concludes my review of the evidence filed in these proceedings in so far as I consider it necessary.

DECISION

11. I deal first of all with the ground of opposition based upon Section 5(3) of the Act which states:

“5.-(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

12. There was no dispute between the parties that the trade mark in suit here was identical to

that of the opponents' and that the applicants' goods were not similar to the goods and services covered by the opponents registrations. It is well established that an opponent must first of all, under this head, show that the earlier right upon which they rely has the necessary reputation. In *General Motors Corporation v Yplon SA* [1999] ETMR 950 at paragraph 31 the Court of Justice in dealing with Article 5(2) of the Directive which equates to Section 5(3) of the Act said:

“31. The answer to be given to the question referred must therefore be that Article 5(2) of the Directive is to be interpreted as meaning that, in order to enjoy protection extending to non-similar products or services, a registered trade mark must be known by a significant part of the public concerned by the products or services which it covers. In the Benelux territory, it is sufficient for the registered trade mark to be known by a significant part of the public concerned in a substantial part of that territory, which part may consist of a part of one of the countries composing that territory.”

13. Also, in *Pfizer Ltd v Euro Food-Link (UK) Ltd* (ChD) [1999] 22(4) IPPD 22039, Mr Simon Thorley QC, acting as a Deputy High Court Judge, said at paragraph 31 of his judgement:

“What is necessary is that the trade mark proprietor should prove the required reputation and should then satisfy the Court that the defendants use of the sign is:

- (a) without due cause; and
- (b) takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.”

14. For his part Mr Walsh said that the evidence provided by the opponents established that the TARDIS trade mark had the requisite reputation in the United Kingdom to be entitled to the extended protection for such trade marks afforded by Section 5(3). I am unable to agree.

15. The evidence shows that the TARDIS was the vehicle used by the fictional Dr Who character in the television programme of that name. It is that fact which I believe that the public at large will be aware of. There is nothing in the evidence which suggests that the relevant public would recognise the word TARDIS as a badge of origin for any of the goods or services for which the trade mark is registered.

16. Mr Walsh submitted that the word TARDIS would be known by a large section of the public who would recognise it as something which emanated from the BBC or one of its licensees. Even though the relevant goods and services were provided under the BBC or Dr Who trade marks he asserted that the word TARDIS was such an integral part of the Dr Who programme that it had acquired the relevant reputation and was perceived to be a trade mark of the BBC.

17. In my view, the exceptional protection provided by the provisions of Section 5(3) are there for the benefit of those trade marks where the owners can demonstrate clearly that they

have a reputation with the relevant group of customers or users, in respect of the goods and services for which the trade mark is protected. Such a reputation can not be inferred it must be a matter of fact; see *AUDI-MED* trade mark [1998] RPC 363 and *Oasis Stores Ltd's* trade mark application [1998] RPC 631. In this case there is no evidence that the word TARDIS has ever been used as a trade mark, other than on some documents where the indicator TM has been used. There is no evidence that the public at large would recognise it as such. Therefore the opponents' ground of opposition in relation to Section 5(3) falls at the first hurdle. They have not established that the trade marks upon which this ground of opposition is based have a reputation in respect of any goods or services.

18. In the light of the above I do not need to consider the other aspects of the opponents' case under this ground. But I will state briefly that I do not consider they have any merit.

19. Mr Walsh in his skeleton argument stated:

- “7. The Applicant's mark takes “unfair advantage” of the BBC's TARDIS mark in that it associates the quality of the goods covered, i.e. advantages of space efficiency with the concept of the BBC's TARDIS mark. c.f. *Premier Brands v Typhoon* (Neuberger J) (2000) IPD 23(5) adopting the dictum of *DIMPLE* (1985) GRUR 550.
8. The Applicant's mark causes detriment to the distinctive character or repute of the BBC's TARDIS mark causing dilution/blurring in the form of detracting from the uniqueness of the mark and tending to render the mark generic. c.f. *Premier Brands* (Neuberger J) quoting with approval from *QUICK* (1959) GRUR 182.
9. The Applicant's use is without due cause c.f. *Premier Brands* Neuberger J quoting from *Lucas Bols* (1976) 11C 420. Applicant is under no compulsion to use the mark.”

20. The following paragraphs from the judgment of Neuberger J in the *Premier brands* case is relevant.

“In *DIMPLE* [1985] G.R.U.R. 550, the German Federal Supreme Court, said that:

“The courts have repeatedly held that it constitutes an act of unfair competition to associate the quality of one's goods or services with that of prestigious competitive products for the purpose of exploiting the good reputation of a competitor's goods or services in order to enhance one's promotional efforts.

Those observations are appropriate to a case where the sign is said to “take unfair advantage of” a mark with established substantial goodwill. Observations of the German Federal Supreme Court in another case, *QUICK* [1959] G.R.U.R. 182, are relevant to the other type of case, namely where use of the sign “is detrimental to” a well established mark:

[T]he owner of ... a distinctive mark has a legitimate interest in continuing to maintain the position of exclusivity he acquired through large expenditures of time and money and that everything which could impair the originality and distinctive character of his distinctive mark, as well as the advertising effectiveness derived from its uniqueness, is to be avoided ... Its basic purpose is not to prevent any form of confusion but to protect an acquired asset against impairment.

This sort of detriment has been generically described as “dilution”, and has also been said to occur normally in one of two ways, namely by “blurring” or by “tarnishing”. The concept of “dilution” in this context is not without its critics, for instance Mr Geoffrey Hobbs, Q.C., sitting as the Appointed Person in VISA Trade Mark (unreported, September 28, 1999). However, as I read his observations, what Mr Hobbs was primarily saying was that one should not, as it were, blindly re-write a provision in a statute or a directive, and then to seek to interpret it as re-written. To my mind, that is plainly right. However, it does appear to me that dilution is a useful concept to bear in mind when considering the application of section 10(3) to a particular set of facts. This view is fortified by the fact that Article 5(2) is based on Benelux law (see per the Advocate General in General Motors Corporation v. Yplon SA [1999] All E.R. (EC) 865 at 871C), and the Benelux court appears to have recognised dilution as a basis for a claim for infringement. On the other hand, (as the Advocate General pointed out in the passage to which I have referred) apparently unlike the Benelux Law, “the Directive spells out the type of harm against which protection is provided”.

In connection with the relevance of the concept of dilution, it is also right to refer to section 145 of the Lanham Act in the United States, which specifically defines dilution as:

... the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of-

- (1) competition between the owner of the famous mark and other parties, or
- (2) likelihood of confusion, mistake or deception.

However, while dilution is a useful concept to bear in mind, it does not necessarily follow that every case of infringement under section 10(3) will necessarily involve dilution, nor does it follow that the proprietor of a mark will necessarily succeed in establishing infringement under section 10(3) in every case where he establishes dilution.”

21. It is clear, in my view, that Neuberger J had in mind the situation where the owner of a distinctive trade mark with a reputation was seeking to prevent the parasitic use of the same or similar trade mark by another on different goods. As there is no evidence that the trade mark in this case has a reputation it is not possible to hold that actions by another seeking to register the same trade mark in respect of different goods and services for which the earlier

trade mark is registered is either taking advantage of it or harms it in any way. There has been no evidence of any damage or likely damage. And, given the above it is not possible to hold that the application for registration in this case is without due cause.

22. I next turn to the ground of opposition based upon Section 5(4)(a), which states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

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

23. Mr Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* [1998] RPC 455 set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

(a) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(b) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

24. As already stated there is no evidence that there is any use of the word TARDIS as a trade mark such as would engender a reputation or goodwill, in respect of any goods or services. Therefore, again the opponents fail at the first hurdle. The opposition on the ground based upon Section 5(4)(a) is dismissed.

25. Finally, I come to the ground of opposition based upon Section 3(6) of the Act which states:

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

26. Mr Walsh in his skeleton argument set out the opponents’ case as follows:

“Section 3(6)

Applicant’s behaviour falls short of commercially acceptable standards set out in *Gromax* 1999 RPC 367. Relevant factors are the disregard of BBC rights of which the Applicant was aware, the misappropriation of both the TARDIS mark and its concept, the absence of permission or acknowledgement and the evidence of innocent adoption of the mark which is not credible.”

27. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsey J stated at page 379:

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

28. Given my findings in relation to Section 5(3) and 5(4)(a) it can not be bad faith for any party (including the applicants for registration in this case) to apply to register a trade mark which is identical to that of an opponent where the goods in question are different from the goods and services covered by the earlier registrations and where the earlier trade mark has no reputation. There has been no disregard of the BBC’s rights, the applicant did a search of the register, found the BBC’s TARDIS trade mark and considered (rightly) that the goods and services covered by the registrations were at some distance from the vehicles they were seeking to cover in their application. For the same reason, I do not consider that misappropriation has taken place. It is a very common feature of all trade mark registration systems for identical trade marks to be registered in different ownerships where the registrations cover different goods and services e.g. LOTUS for shoes and LOTUS for vehicles.

29. The allegation of misappropriation by the applicant of the concept of a space efficient vehicle was countered by the applicants with a claim to have devised the six letter string as an acronym for Touring And Recreational Driving In Safety. Like Mr Walsh, I find it surprising that this six letter string when associated with a vehicle whose promotional material suggests space saving and creation in particular, was coined entirely innocently. Nevertheless, I do not consider that that amounts to ‘bad faith’ in relation to the act of registering a trade mark. It is not behaviour which I believe falls short of commercial standards. Thus the ground of opposition based upon Section 3(6) is also dismissed.

30. As the applicants have been successful in this case they are entitled to a contribution towards their costs. Taking into account the costs associated with considering the notice of opposition, preparing the counterstatement, considering and filing evidence and attending the hearing (all actions undertaken by the applicants themselves) I order the opponents to pay to the applicants the sum of £2000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13 day of January 2003

**M Knight
For the Registrar
The Comptroller-General**

Trade Mark No: 2054001

App Date: 25.01.1996

Trade Marks: THE TARDIS, TARDIS (series of 2)

Goods & Services:

Class 9 - Games and apparatus for games for use with or incorporating a television screen or video monitor; coin or token operated electrical or electronic amusement apparatus; computer software; computer games; video games; electronic games; electrically, magnetically and optically recorded data for computers; data recordings; records, discs, tapes, cassettes, cartridges, cards and other carriers bearing or for use in bearing data, images, games, graphics, text, programs or information; memory carriers; CD-Is and CD-ROMs; all for the aforesaid goods relating to entertainment and science fiction; sound, video and data recording and reproducing apparatus; amusement apparatus for use with or incorporating a television screen or video monitor; sound and video recordings; records, discs, tapes, cassettes, cartridges, cards and other carriers bearing or for use in bearing sound and video recordings; cinematographic films and photographic films all prepared for exhibition; instructional and teaching apparatus and instruments; magnets; sunglasses; parts and fittings for all the aforesaid goods.

Class 25 - Clothing, footwear and headgear; articles of outer clothing; articles of underclothing; coats, jackets, suits, skirts, dresses, jumpers, pullovers, waistcoats, blouses, trousers, slacks, shorts, dungarees, shirts, t-shirts, sweatshirts, sweaters, smocks, hats, stockings, neck-ties, scarves, headsquares, gloves, aprons, slippers, shoes; jeans, caps, berets, tights, belts, socks, swimwear and beachwear, pyjamas, nightdresses, bathing and shower caps, bath robes, bath sandals and bath slippers, clothing for babies and for toddlers, bibs, babies napkins of textile.

Class 38 - Broadcasting; communications and telecommunications; transmission of radio and television programmes; data transmission; transmission of messages, sound and images; transmission of information by electronic means; receiving and exchange of information, messages, images and data; electronic mail services; teletext services; news agency services; message sending; communications by and/or between computers and computer terminals; communications for access to a database; provision and display of information from a computer stored databank; electronic display of information, messages, images and data; provision of a computer bulletin board; provision of on-line access to information; provision of access to information by computer; information and advisory services relating to any of the aforesaid services.

Class 41 - Entertainment, education and instruction by or relating to radio and television; production, presentation and rental of television and radio programmes, films, sound and video recordings, CD-Is and CD-ROMs; publication; production and rental of educational and instructional materials; exhibitions; entertainment, education and instruction relating to science fiction and time travel; production and presentation of shows, stage plays and entertainment

events; organisation of competitions; provision of information relating to entertainment; entertainment by electronic means; provision of entertainment for on-line access; entertainment by cable, computer or telephone; entertainment by or relating to multimedia and interactive systems.

Trade Mark No: 2138520

App Date: 10.07.1997

Trade Mark: TARDIS

Goods:

Class 20 - Furniture; office furniture; parts and fittings for all the aforesaid goods; all included in Class 20.