

TRADE MARKS ACT 1994

**IN THE MATTER OF An Application
by Kemco America Limited to register
the trade mark TOP GEAR in Class 9**

AND

**IN THE MATTER OF Opposition thereto
by the British Broadcasting Corporation**

1. On 4 November 1993, Kemco America Inc. applied under Section 17 of the Trade Marks Act 1938 for the registration of the trade mark TOP GEAR in respect of:-

Video game computer programmes; video game chip cartridges; all relating to or depicting vehicles; all included in Class 9.

2. On 5 September 1996, the British Broadcasting Corporation filed Notice of Opposition. The grounds of opposition are, in summary, as follows;-

- I) The BBC has regularly broadcast a television programme under the name TOP GEAR in the field of motoring since 1977. The mark TOP GEAR has therefore become a household name closely associated with the BBC in the minds of the public. Further, it is the practice of entertainment organisations to make and sell or licence others to make and sell goods relating to their entertainments with the result that use of the mark applied for by the applicant would be likely to cause confusion and deception. The application should therefore be refused under Section 11 of the Trade Marks Act 1938.
- ii) The opponent is the proprietor of two United Kingdom trade mark

registrations consisting of the words TOP GEAR for goods in Class 16 and services in Class 41. The goods covered by the application in suit are of the same description as, or are associated with, the goods and services for which the BBC's marks are registered and there is a likelihood of confusion and deception arising from the applicant's proposed use of its mark. The registration of the mark would therefore be contrary to Section 12 of the Trade Marks Act 1938.

- iii) The applicant is not entitled to claim to be the proprietor of the trade mark and the application should therefore be refused under Section 17(1) of the Trade Marks Act 1938.
- iv) Because of the BBC's use of the mark TOP GEAR the mark applied for is not adapted or capable of distinguishing the applicants goods and should therefore be refused under the provisions of Sections 9 and 10 of the Trade Marks Act 1938.
- v) The application should be refused under the discretionary powers conferred on the Registrar by Section 17(2) of the Trade Marks Act 1938.

3. The applicant admits that the opponent has broadcast a television programme under the name TOP GEAR and further admits that it is the practice of entertainment organisations to make and sell or licence others to make and sell goods relating to their entertainments. However, the applicant denies that the mark TOP GEAR has become a household name closely associated with the opponent or that there is any likelihood of confusion and deception arising as a result of the applicant's use of the mark applied for. In this connection, the applicant denies that the goods in respect of which registration is sought are of the same description as the goods and services for which the BBC's trade mark is registered. The applicant claims to have used the mark TOP GEAR since at least as early as December 1991 without giving rise to any known incident of confusion or deception. The other grounds of opposition are also denied.

4. Both sides ask for an award of costs.

5. The matter came to be heard on 7 July 1999 when the applicant was represented by Mr Douglas Campbell of Counsel, instructed by Field Fisher Waterhouse, and the opponent was represented by Mr Richard Hacon of Counsel, instructed by Stephenson Harwood.

6. By the time this matter came to be heard the Trade Marks Act 1938 had been repealed. However, in line with the transitional provisions set out in Schedule 3 to the Trade Marks Act 1994 I must continue to apply the provisions of the old law to these proceedings. Accordingly, all further references in this decision to provisions of the Act are references to the provisions of the Trade Marks Act 1938.

7. Mr Hacon indicated to me that the opponent was not pursuing the ground of opposition based upon Sections 9 and 10 of the Act. I need not, therefore, say anything further about this ground of opposition.

Opponent's Evidence

8. The opponent's evidence-in-chief consists of a Statutory Declaration dated 20 May 1997 by Diana Madeline Adie, who is a barrister employed by the BBC. Ms Adie states that the BBC is one of the world's largest broadcasting and entertainment organisations. She explains that TOP GEAR is the name of a television programme in the field of motoring, which has been regularly produced and broadcast by the BBC since 1977. The programme is predominantly of a magazine type, consisting largely of reviews of latest models of vehicles and accessories, and of other features of interest to motoring and motor sports enthusiasts.

9. It is claimed that, over the years, the TOP GEAR programme has typically been broadcast in weekly series of up to 18 programmes, each of approximately 30 minutes duration, often with programmes being repeated later in the same week. Audience figures compiled by the Broadcasters Audience Research Board (BARB) show that the combined weekly audience for each programme (including any repeat) during the years 1988 to 1990 was frequently in

excess of 3 or 4 million. During 1991 to 1993 the combined weekly audience was frequently in excess of 5 million. Exhibit DMA2 to Ms Adie's declaration consists of a report prepared from BARB figures for two series of the TOP GEAR television programme broadcast during 1993. The report indicates that during weeks 7 to 23 of 1993 there was a combined weekly audience of 5 million viewers, and later the same year during weeks 36 to 52 of 1993 there was a combined average weekly audience of some 6.2 million viewers.

10. Ms Adie says that there have also been special one-off TOP GEAR television programmes which have been shown in addition to the regular weekly programme, consisting of documentaries, programmes related to the Motor Show, and programmes featuring motor sport. In particular, it is said that since 1981 there have been special TOP GEAR programmes covering the RAC Rally, a prestigious annual motor racing event, typically using the style "TOP GEAR RALLY REPORT". These special programmes have included a preview programme the day before the event, evening round-ups after each days competition, and live outside broadcasts from at least one stage of the race.

11. It is further claimed that the regular weekly TOP GEAR programmes have also featured rallying since the 1970's, including items on women rally drivers, rally schools, rally safety, rally cars, rally driving and numerous rally events. In each of the 4 years between 1988 and 1991 the TOP GEAR programme organised a competition to find a new rally driver with the prize being entry into the RAC Rally of that year. Exhibit DMA3 to Ms Adie's declaration consists of a list of programmes which included features on motor rallying. It appears from this list that such features were included in 61 television programmes broadcast between 17 August 1978 and 4 October 1993. There are a large number of more recent programmes which also featured motor rallying. However, these are all after the relevant date in these proceedings.

12. Ms Adie further states that between 1987 and 1991 the name TOP GEAR was also used in relation to the sponsorship of a number of classic car races, such as the "TOP GEAR FORMULA 1 " WINTER SERIES" in the Autumns of 1987 and 1988, and the "TOP GEAR HISTORIC RALLYING CHAMPIONSHIPS" in 1990 and 1991. The name TOP GEAR was

also used in relation to the sponsorship of the British Rallying Championship from March 1992, and for several years during this sponsorship the name TOP GEAR appeared on all publicity and promotional materials connected with the rally, as well as on programs, driver documentations and on the cars themselves and around the courses at this prestigious international event. Exhibit DMA4 consists of copies of promotional material in relation to a number of rallies held during 1992 and 1993 under the auspices of the British Rally Championship. The logo which appears on each of these items of promotional material contains the name TOP GEAR together with the name of what I take to be another sponsor, Mobil, and the name of the event, the RAC British Rally Championship.

13. Ms Adie explains that the television programme has been regularly promoted through listings in the magazine 'Radio Times' which has a circulation of over 1 million. A number of competitions have been run under the TOP GEAR name which are said to have attracted a considerable number of entries and enquiries. In May 1993 TOP GEAR was used in relation to the organisation of an exhibition relating to motoring. Exhibit DMA7 comprises materials relating to the TOP GEAR "Classic and Sports Car Show" held at the National Exhibition Centre in Birmingham.

14. Ms Adie says that it is common for the BBC to make and sell or licence others to make and sell products relating to its television programmes. The BBC has a number of commercial subsidiaries which specifically undertake this activity. These include BBC Worldwide Limited (Worldwide).

15. It is said that the largest proportion of Worldwide's turnover comes from magazine and book publishing and television programme sales, with video and audio recordings also being an area of significant commercial importance accounting for around 18% of Worldwide's turnover in the mid 1990's. It is further claimed that a substantial proportion of Worldwide's turnover comes from sales of other products relating to television programmes, either directly or in the form of royalties from licensees. In 1992/93 the turnover of Worldwide (or BBC Enterprises Limited as it was then known) was in excess of £200 million. Approximately 75% of this turnover related to activities in the UK.

16. Ms Adie further explains that each year the opponent receives enquiries and proposals from third parties seeking licences to produce a wide range of products relating to BBC programmes, and the BBC frequently take steps to restrain marketing of unauthorised products which are considered likely to be assumed by prospective purchasers as having a trade connection with the BBC. Exhibit DMA9 is a list of licences granted by Worldwide or under negotiation during the period 1990 to March 1993. This list includes 54 licences with start dates before the date of the application under opposition, all relating to games and playthings. A number of these relate to the same programme or character. 'Noddy' appears to have been particularly popular. The names of a number of well known TV programmes are also included, such as 'Generation Game' (licence 13/3/92), 'Noel's House Party' (1/1/93), and 'Question of Sport' (24/6/91). The licences in question relate to board games. Illustrations of some of the games are included in exhibit DMA9. At least five of the licences are for computer games based on television programmes such as "Allo Allo" (license 20/2/92), "Doctor Who" (1/2/92), "Match Of The Day" (6/11/92), and "Playdays" (20/3/92), and one computer game (licence dated 1/8/92) based upon a character called "Ed The Duck" from a BBC television programme. A sample of the computer game in question is exhibited at DMA10 to Ms Adie's declaration. Examination of this exhibit reveals that the game in question carries the title 'Ed The Duck' together with graphics corresponding to the character in question and the mark BBC.

17. Ms Adie explains that, prior to the date of the application under opposition, the mark TOP GEAR was used in relation to various spin-off items including a magazine and book, umbrellas, mugs, caps, jackets and a video recording of the 1992 Rally Championships. The video in question went on sale in November 1992 and over 1,400 copies were sold over the following few months. The TOP GEAR magazine in the motoring field was launched in October of 1993 and the first issue of the magazine had a circulation of around 162,000 copies. It is said that there was considerable speculation in the media before the magazine was launched and exhibit DMA13 contains a number of articles to illustrate this point. The only one that I can see which identified the title of the forthcoming magazine as TOP GEAR is dated July 1992 and appears in a publication called "Media Week". Exhibit DMA12 to Ms Adie's declaration consists of material intended to illustrate the use of the mark TOP GEAR in

relation to umbrellas, mugs, clothing, video recordings and the magazine. This exhibit also includes a copy of the cover of the video of the British Rally Championships from 1992. It bears the same 'Mobil -Top Gear - RAC British Rally Championship' logo as described earlier. The video also carries, in small lettering on the side of the video sleeve, the well known BBC logo. The opponent's magazine also has the words TOP GEAR displayed prominently, this time as the title of the magazine and, again in smaller lettering, the well known BBC logo.

18. Exhibit DMA15 to Ms Adie's declaration consists of copies of written enquiries to the BBC about licences to use of the mark TOP GEAR. Most of these relate to the period after the date of application. Four are dated before the date of application. One of these, dated 16 November 1991, is from a company called Sapona Limited who were interested in securing the BBC's consent to use the mark TOP GEAR in relation to a car cleaning kit. The BBC responded on 26 November 1991 pointing out that because the enquirer did not intend to link the product to the television programme in any way, the BBC did not consider a licence to be appropriate. However, the BBC also pointed out that, in their opinion, use of the name TOP GEAR was likely to imply a link in the minds of potential purchasers between Sapona's products and the BBC. On this basis the BBC objected to the proposed use. There is also a copy of an internal BBC memorandum from the Producer of the television programme to another member of staff in the Worldwide subsidiary indicating that an enquiry had been received from a company representing TOMY TOYS who were considering producing a range of toy cars and were interested in using the TOP GEAR title. This does not appear to have come to anything.

19. Ms Adie provides details of the opponent's registrations of the mark TOP GEAR in Classes 16 and 41. Registration No. 1525432 in Class 16 is in respect of:-

Printed matter in the form of fact sheets, programmes, stickers; all relating to motoring and motor vehicles; all included in Class 16.

20. Registration No. 1525433 in Class 41 is in respect of:-

Entertainment, education and instruction provided by television; production and presentation of television programmes and video recordings; entertainment and education in the form of live events, shows and telephone advisory services; organisation of competitions; all relating to motoring and motor vehicles; all included in Class 41.

21. The registrations in question are dated 29 January 1993, which is before the filing date of the application under opposition.

22. Exhibit DMA18 to Ms Adie's declaration consists of a report dated August 1995 signed by a Mr Ian Yexely of Unitrust Security Consultants. Mr Yexely explains that his company was commissioned by the opponent to investigate the applicant's use of the mark TOP GEAR. To this end, he says that his company contacted various computer games departments of large retail stores (such as HMV, Virgin, Hamley's and Dixons) as well as various specialist computer games shops, but they were unable to locate the applicant's product. They eventually found a second hand copy of the games software TOP GEAR 2 which lead them to the distributor who is alleged to said that the game was out of stock and a new distributor had been appointed called Gremlin UK Ltd. Further enquiries to the new distributor are said to have met with the response that the the current version of the software TOP GEAR 3000 was not at that time available in the UK, although apparently it could be ordered.

Applicant's Evidence

23. The applicant's evidence consists of an Affidavit dated 8 December 1997 by Kenichi Nagata, who is the President of Kemco America Inc. Mr Negata states that the original game which became known as TOP GEAR was developed for his company in the UK by Gremlin Graphics of Sheffield. He states that it is a game designed to be played on Nintendo machines. He further states that, as is usual in the games business, the developer of the game offered two possible titles TOP RACER and TOP GEAR. He states that the final choice was made by his

own company and that in 1991 neither he nor, as far as he is aware, anyone else in his company would have been familiar with the television programme TOP GEAR. Mr Negata says he assumes that if the television programme TOP GEAR is as well known in the United Kingdom as Ms Adie suggests, then the developer of the game was likely to have heard of it. He does not believe that Gremlin Graphics would have suggested that his company use a title that would have lead the public to believe his company's games were licenced by the BBC.

24. Mr Negata provides sales figures for his company's goods under the TOP GEAR mark. These are as follows:-

<u>Virgin</u>	<u>UK Sales</u>	<u>US Sales</u>	<u>US Sales Value</u>
TOP GEAR	17,040 Units	250,119	US\$ 8,467,908
TOP GEAR 2	14,064	196,002	US\$ 6,797,575.40
TOP GEAR 3000	14,064 (all Europe)	53,971	US\$ 2,066,119.50
TOP GEAR RALLY	220,000 (all Europe)	390,000	-

25. Mr Negata indicates that an investigation carried out on behalf of the BBC in August 1995 into his company's use of the mark in the UK seems reasonably consistent with his company's records. At the time the research was carried out TOP GEAR 3000 was the current release but the European distributor, Gremlin Interactive Limited, had sold out.

26. Mr Negata further claims that:-

“Throughout the period the TOP GEAR game has been on the market there has been no comment or feedback whatsoever concerning any assumed connection with the BBC. I therefore do not believe that the public was deceived or mislead as Ms Adie suggests would have been the case. There was in fact considerable exposure of the game during the time when the BBC programme was being broadcast so if the public had assumed a connection I would have expected some comment of some sort from within the distribution network. My company was however first made aware of any

problem when the BBC launched these opposition proceedings. No complaints were made at the time of the various releases. The mark TOP GEAR has become synonymous with my company's games and is recognised by the general public as such. As far as I am aware, sales of the TOP GEAR games in the United Kingdom have taken place without giving rise to any known incident of confusion or deception."

27. Mr Negata concludes by suggesting that the goods of interest to the applicant are not of the same description as those for which the BBC's TOP GEAR mark is registered and that the applications for licences referred to in the opponent's evidence are not simply related to the mark TOP GEAR, but also the more famous mark BBC.

Opponent's Evidence-in-reply

28. In response to Mr Negata's evidence the opponent filed a further Statutory Declaration dated 19 June 1998 by Shaun Rebecca Teasdale of BBC Worldwide Limited. Much of Ms Teasdale's evidence consists of legal argument and information about the BBC's future plans with regard to the TOP GEAR trade mark. She states that she owns a Nintendo 64 games machine and regularly purchases and plays Nintendo games, including racing games. She says that she has never seen any Kemco Top Gear game in shops and had not heard of any Kemco product under the name TOP GEAR as of November 1993. However, she does not say when she first acquired a Nintendo 64 machine and, in particular, whether this was before November 1993.

29. That concludes my review of the evidence I now turn to the decision.

Decision

30. I will deal first with the ground of opposition under Section 17(1) of the Act. The opponent claims that the applicant is not entitled to claim to be the proprietor of trade mark because of its earlier use of the same trade mark. In support of this proposition Mr Hacon referred me to the Quiet May case, 1967 (FSR 27), in which the Registrar decided that the

applicant's claim to proprietorship had to be substantiated in the event of an opposition on that ground. A similar conclusion was reached more recently by the Court of Appeal in the Al-Bassam trade mark case, 1995 RPC page 511. I therefore accept the submission as far as it goes. However, unlike the two cases to which I have just referred, there is no evidence before me that the opponent had goodwill in a business supplying or licensing computer games under the name TOP GEAR before the relevant date in these proceedings. In those circumstances I see no reason why the applicant could not make a valid claim to be the proprietor of the trade mark in respect of the goods covered by the application in suit. The question of whether the use of that mark is liable to cause confusion or deception with the opponent's mark is a separate matter which falls to be determined under Sections 11 and 12 of the Act. The opposition under Section 17(1) of the Act fails.

31. Section 12(1) of the Act is as follows:-

12.-(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of-

- (a) the same goods,
- (b) the same description of goods, or
- (c) services or a description of services which are associated with those goods or goods of that description.

32. Section 68(2A) of the Act is as follows:-

68(2A) For the purposes of this Act goods and services are associated with each other if it is likely that those goods might be sold or otherwise traded in and those services might be provided by the same business, and so with descriptions of goods and descriptions of services.

33. Section 68(2B) of the Act is also relevant and is as follows:-

68(2B) References in this Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

34. I will deal first with the objection based upon the opponent's earlier registration No. 1525432 in Class 16. This covers printed matter in the form of fact sheets, programs and stickers relating to motoring and motor vehicles. Mr Hacon frankly acknowledged that this was the weaker of the two registrations from the opponent's point of view. The respective goods are clearly not the same so the first question I must decide is whether they are 'of the same description.' It is common ground that the relevant authority in this respect is the well known Panda case (1946) 63 RPC 59 in which Romer J classified the various matters to be taken into account in deciding whether the goods are of the same description as follows:-

- (a) the nature and composition of the goods;
- (b) the respective uses of the articles;
- (c) the trade channels through which the commodities respectively are bought and sold.

35. It appears to me that the respective goods are different under each of these three headings. Mr Hacon made a tentative attempt to argue that fact sheets and stickers are sometimes supplied with video games and bearing the same trade mark, but I think he accepted that such use of the trade mark would not amount to use of the trade mark in relation to the fact sheet and stickers, but would in fact represent use of the trade mark in relation to the video game. The respective goods are clearly not of the same description.

36. I next consider whether the goods covered by the application are associated with the services for which the opponent's earlier mark No 1525433 is registered. The services in question are 'entertainment, education and instruction provided by television; production and presentation of television programmes and video recordings; entertainment and education in the form of live events, shows and telephone advisory services; organisation of competitions;

all relating to motoring and motor vehicles’.

37. It is common ground that in considering whether it is likely that video games software and cartridges might be sold or otherwise traded in by the same business that provides the services described above, I must consider the normal practice in the trade and not the range of goods and services provided by either of the parties, which may be atypical. Nevertheless, Mr Hacon immediately pointed to the fact that the BBC provided television programme services and they licenced others to produce video games. Mr Campbell, in my view rightly, characterised the BBC as exceptional. Ms Adie describes the BBC as one of the world’s largest broadcasting and entertainment organisations. The BBC is not typical. There is no evidence that it is normal practice for producers of television programmes and video recordings to also trade in computer games software.

38. The applicant’s pleadings include an admission that it is the practice of entertainment organisations to make and sell or licence others to make and sell goods relating to their entertainments. However, I don’t think that this goes as far as an admission that it is common practice for TV and video programme makers to trade in video games. The applicant denies that these goods and services are associated or that their goods are related to the opponent’s TV programme. In the absence of evidence that supports the opponent’s contention, I do not accept that the goods covered by the application in suit are ‘associated’ with the services for which the opponent’s trade mark is registered in Class 41. The opposition under Section 12(1) of the Act therefore fails.

39. It is common ground that the appropriate test under Section 11 of the Act is that set by Evershed J in *Smith-Hayden’s Application* [1946] RPC 97, at 101, as adapted and approved by the House of Lords in *Bali* [1969] RPC 472, at 496. Modified to suit the matter at hand the test may be expressed as follows:-

Having regard to the user by the BBC of the name TOP GEAR is the Registrar satisfied that the mark, if used in a normal and fair manner in connection with video game computer programmes, or video game chip cartridges relating to vehicles, is not

reasonably likely to cause deception and confusion amongst a substantial number of persons?

40. It is also common ground that the matter is to be judged at the date of application (4 November 1993) and that the above test reflects the onus which is on the applicant to satisfy the Registrar that there is no reasonable likelihood of confusion and deception.

41. The test under Section 11 is not the same as that required to substantiate a passing off action. In Hack's application [1941] RPC 91 at 103, Romer J. said:-

“It is not necessary in order to find that a mark offends against section 11 to prove that there is an actual probability of deception leading to passing of or (I add) an infringement action . It is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt, but the court must be satisfied not merely that there is a possibility of confusion; it must be satisfied that there is a real tangible danger of confusion....”

42. That passage was approved by Lord Upjohn in *Bali* (at page 496) and it was common ground before me that it reflects the law under Section 11. Accordingly, I must refuse registration unless I am satisfied that there is no real tangible likelihood that a substantial number of persons would, in November 1993, have had reasonable cause to wonder whether there was a source connection between the applicants' video games and the opponent.

43. Mr Hacon for the opponent pointed to the long use of the mark TOP GEAR by the opponent in relation to a television programme about motor vehicles which included regular features and special programmes on motor racing. He drew my attention to the estimated viewing figures in support of his submission that the opponent had established that its mark was well known in the United Kingdom at the date of the application under opposition. By that date the opponent's TOP GEAR television programme had been running for sixteen

years. This indicates that the programme had been successful. The viewing figures included in Ms Adie's declaration confirm this. By 1993 the average weekly viewing figures for the programme were in excess of 6,000,000, and the figures for the previous year were in excess of 5,000,000. Taking account of all the evidence I believe the opponent is justified in their claim that the television programme TOP GEAR was a household name in 1993.

44. The applicant contends that the opponent's television programme is primarily associated with the review and comparison of new models of motor vehicle. They say there is no direct connection between such programmes and their computer software for video games. In this connection, the applicant proposes that, if necessary, their specification of goods should be limited so as to make it clear that their goods are "relating to or depicting racing vehicles".

45. In my view the opponent is also justified in its claim that the television programme in question has featured motor racing and, in particular, rallying events on a regular basis since the 1970s. It appears that there have also been special TOP GEAR television programmes covering the annual RAC rally since 1981. The connection in the public's mind between motor rallying and the opponent's television programme would have been further increased by the video of the 1992 British Rally Championship which was released in 1992 and which featured the TOP GEAR mark prominently on the cover. I also believe that the opponent's sponsorship of various races and rallies between 1987 and 1991 under the TOP GEAR mark was also likely to have increased the connection in the public's mind between motor racing in general and the opponent's television programme. I do not, therefore, consider that the proposed amendment of the applicant's specification makes any difference.

46. Mr Hacon also relied upon the evidence that the opponent conducts a substantial business through the licensing of spin-off products from their television programmes, including games and computer games. In Mr Hacon's submission, this would have further increased the likelihood of the public expecting some kind of connection in trade with regard to like products sold under the names of the opponent's well known television programmes. Mr Campbell pointed out that there was little detail of the licences granted by the BBC for the production of computer games bearing the titles of their other television programmes. That is

true but, viewed as a whole, it is clear that the opponent had a substantial licensing business by 1993 and that this included games.

47. Mr Hacon also drew my attention to the specific activities of the opponent in extending their TOP GEAR brand. It appears to me that the use of the mark TOP GEAR on clothing and umbrellas etc. was primarily use on promotional items for the television programme. The use of the mark on the rallying video in 1992 and the magazine in 1993 falls into a different category. These are clearly spin-off products capitalising on the goodwill established by the television programme. Mr Hacon cited examples in the evidence of the BBC being asked to licence the TOP GEAR trade mark by third parties prior to the relevant date as a strong indication that 1) the opponent's goodwill under the trade mark TOP GEAR was recognised as having a value with regard to the sale of other goods and 2) those engaged in trade recognised the opponent's proprietary interest in the mark..

48. Mr Campbell pointed out that some of the opponent's promotional material included the well-known trade mark BBC. The absence of the BBC mark from his client's goods was, in his submission, a factor which was likely to avoid any perceived connection with the opponent because the opponent's mark was really BBC Top Gear. I do not accept that submission. Firstly, not all of the promotional material exhibited in the evidence before me does contain the BBC mark. In particular, the logo used to promote the RAC British Rally Championship in 1992 contained the words TOP GEAR but not BBC. This suggests that the opponent was of the view that the TOP GEAR mark was, by itself, a sufficient indication of their connection with the event. Further, although the BBC mark does appear on a number of promotional items and the sleeve of the 1992 video, it normally appears much less prominently than the mark TOP GEAR. I do not find it surprising that the opponent and its licensees or potential licensees would wish to take advantage of the goodwill characterised by the mark BBC as well as that generated by the titles of individual well known programmes broadcast by the BBC. I do not believe that this means that the titles of the television programmes in question are not capable of indicating a connection with the opponent without the support of the BBC mark. In my view, the evidence indicates that the mark TOP GEAR was in fact highly distinctive of the opponent's television programme and spin-off video and magazine by the date of the

application.

49. The opponent's have not provided any evidence that the applicant's use of the marks TOP GEAR and TOP GEAR 2 on computer games has resulted in confusion. This is not entirely surprising given the difficulty they had in finding a copy of the applicant's goods let alone any customers. The onus is on the applicant. Mr Campbell had to accept that it was not clear from Mr Negata's evidence whether, or to what extent, the games entitled TOP GEAR 3 and TOP GEAR RALLY had been sold in the UK (as opposed to "Europe"). Mr Negata's statement that he is unaware of any confusion arising must therefore be regarded as mainly applicable to the earlier versions of the applicant's games software. Mr Hacon characterised this as evidence given "at arms length" from the United States of America. He pointed out that there was no indication in Mr Negata's evidence that the applicant had actively investigated the position through its UK distributor. Mr Campbell had to accept this but questioned the value of such enquiries by suggesting that, even if they had occurred, they may have been fruitless because "people just get on with playing the game." That thought had occurred to me. It suggests that the absence of complaints is not a reliable indicator of whether purchasers thought there was a trade connection between the applicant and the opponent. In any event, I do not regard the applicant's proven modest use in one sector of the computer games market (for use with Nintendo games consoles) as having fully tested the public's reaction to the TOP GEAR mark on computer games relating to motor racing.

50. Mr Campbell pointed out that the words "Top Gear" alluded to the nature of the applicant's goods and, in his submission this would be the primary significance of the words to the public - rather than suggesting any trade connection with the BBC. I accept that the mark TOP GEAR alludes, to some extent, to the character of the applicant's goods. The same could be said about the opponent's services. However, I do not believe that the mark is directly descriptive of either. And as I have already found, the opponent's mark was highly distinctive in fact of the opponent's television programmes and spin-off products by November 1993.

51. The core of the opponent's case is that their reputation under the TOP GEAR mark is

such that the public would have reasonable cause to wonder whether a video game about motor vehicles or motor racing was connected with them. The facts here appear to me to resemble those in Hack's Application referred to above. That case concerned an opposition by the makers of the well known BLACK MAGIC chocolates to an application to register the same mark for laxatives (other than chocolate laxatives). There, as here, the earlier mark enjoyed a substantial reputation with the public and the respective goods, whilst not within the penumbra of protection provided by Section 12, nevertheless had a connection. In that case it was the common practice of using chocolate as a carrier for laxatives. In this case it is the common subject matter of the applicant's games software and the opponent's TV programme. These factors combined with the use of an identical mark may be enough to suggest a trade connection.

52. This opponent has a better case insofar as it can point to a pre-existing licensing business. The applicant's case here may be a bit better because the mark at issue alludes to the nature of the respective goods and services. It is possible that the allusive nature of the mark may be sufficient to prevent the public unequivocally expecting the applicant's goods to be connected with the opponent with resulting deception. However, the applicant has not satisfied me that, at the relevant date, there was no reasonable likelihood of a substantial number of persons being confused about whether the applicant's mark signified a trade connection between its goods and the opponent. At the very least, the public would have reasonable cause to wonder whether the applicant's goods were connected with the opponent. That is enough for the purposes of Section 11 of the Act. Consequently, I find that the opposition under Section 11 is successful. As I have already indicated, I do not consider that the restricted specification put forward by the applicant at the hearing affects this conclusion.

53. In the event that I was against him on the prima facie case, Mr Campbell urged me to take account of the applicant's use between September 1992 and the date of the application as constituting honest concurrent use of the trade mark by the applicant. In this connection he referred me to the decision of Falconer J in the CHELSEA MAN trade mark case [1989] RPC page 111, in which it was held that honest concurrent use sufficient to overcome an objection under Section 12(1) of the Act could also overcome an objection under Section 11.

54. The issue here appears to me to be not so much a matter of whether the application can proceed under Section 12(2) of the Act in the face of a Section 11 objection, but rather whether the applicant's use of the mark prior to the date of application is sufficient for me to conclude that they had established their own entitlement to use the mark by that date with the result that they would not have been "disentitled to protection in a court of justice" in the face of the opponent's earlier and established use of the TOP GEAR trade mark.

55. The applicant originally claimed to have used the mark TOP GEAR in relation to computer games since "at least 1991". Mr Negata's evidence modified this claim. It indicates that the applicant first used the mark in September 1992. Mr Negata says that around 17,000 copies of the original TOP GEAR game were sold in the UK before it was succeeded by 'TOP GEAR 2' in December 1993. Ms Teasdale gives evidence as to the size of the market for Nintendo computer games, but she does not appear to be in a position to give expert evidence on this point. She states that she herself has never come across the applicant's computer game although she is the owner of a Nintendo computer games console and a purchaser of software for it. However, she does not indicate how long she has owned a Nintendo computer games console and I cannot therefore be sure that the evidence she gives is relevant to the position at November 1993. I must therefore rely upon my own experience in order to decide what weight to give to the applicant's evidence of use. It appears to me that the applicant's relevant use is 1) limited in length at just over one year, and 2) on a modest (but not de minimis) scale.

56. The applicant's use pre-dated the launch of the opponent's video of the British Rally Championships under the TOP GEAR mark in November of 1992, and also the launch of the opponent's TOP GEAR magazine in October of 1993. However, I do not believe that these developments would have fundamentally affected the public's perception of the applicant's mark and their view on whether it signified a connection with the opponent. Whilst these "brand extensions" assist the opponent's case to some extent, I do not believe that the opponent's case under Section 11 materially depends upon these developments. It appears to me that by September of 1992 when the applicant's computer game was launched in the UK, the opponent's television programme under the name TOP GEAR was already a household

name. The connection between it and racing and rallying was also established through features on the television programme, special dedicated TV programmes dedicated to rallying or racing and the opponent's sponsorship of various rallies and races from 1987 culminating in the sponsorship of the British Rally Championship in 1992 - which took place before the applicant's launch.

57. Further, these activities need to be viewed against the background of the BBC's extensive licensing activities, including earlier licensing of titles of other well known television programmes in relation to games and computer games. I conclude therefore, that even if I were to re-pose the enquiry in September of 1992, my conclusion would still be that the applicant's use of the mark TOP GEAR would have been likely to cause a substantial number of persons to have wondered whether there was a connection in trade between the applicant's goods and the opponent.

58. There is a further matter to be considered under this heading. No weight can be attached to the applicant's concurrent use unless it is shown to be honest. Mr Negata indicates that the name TOP GEAR was one of two names suggested by a firm called Gremlin Graphics of Sheffield as potential candidates for the name of the applicant's game. He says that he was not at that time familiar with the opponent's television programme. He further indicates that it was his company that chose the name TOP GEAR over the other alternative (TOP RACER). Mr Hacon submitted that this was not good enough to discharge the onus upon the applicant to show that its use of the trade mark TOP GEAR was honest. In particular, he argued that if the English agent's motive in proposing the name TOP GEAR was to suggest some connection or endorsement from the opponent, this was not an honest use and the position could not be cured by Mr Negata, on behalf of the applicant, claiming ignorance of the motives of what was effectively its agent.

59. For his part, Mr Campbell emphasised that it was the applicant which had adopted the mark TOP GEAR and the applicant had clearly indicated that it was ignorant of the opponent's mark at the time it did so. In those circumstances, he submitted that the applicant could not have adopted the mark in bad faith.

60. In a case where honest concurrent use is claimed there is a particular onus on the applicant to show that the concurrent use was honest. I do not believe there is enough material before me to reach a firm conclusion on this point. However, the applicant accepts that its UK developers would probably have known of the opponent's well established television programme at the time they offered up TOP GEAR as one of two potential names for the applicant's game. If the UK agent proposed the name because it thought a suggestion of a connection with the opponent's successful TV programme would benefit UK sales, the applicant's use here cannot be regarded as honest concurrent use. It was open to the applicant to seek to file evidence from Gremlin Graphics as to the reasons why it proposed the name TOP GEAR. The applicant has not done this and, in my view, by not attempting to do so has also failed to remove a doubt which the opponent has quite properly raised. In these circumstances I believe that even if I were of the view that the length and scale of the applicant's concurrent use was sufficient to defeat the Section 11 objection - which as I have made clear above I am not - I would still not be in a position to accept the applicant's evidence as establishing honest concurrent use.

61. As I have found in favour of the opponent under one of the mandatory provisions of the Act it is neither necessary nor appropriate for me to consider the question of the Registrar's general discretion under Section 17(2) of the Act.

62. The opponent having been successful is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £1000.

Dated this 21 Day of July 1999

Allan James

For the Registrar

The Comptroller General