

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2104259
BY THE BRITISH BROADCASTING CORPORATION TO REGISTER A SERIES OF
THREE MARKS IN CLASSES 9, 16, 25 AND 41**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 48452
BY THE METROPOLITAN POLICE AUTHORITY**

TRADE MARKS ACT 1994

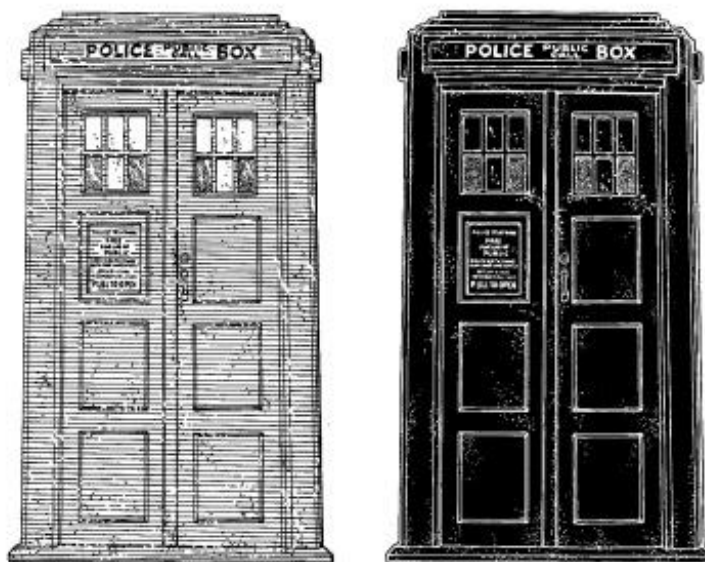
**IN THE MATTER OF Application No. 2104259
by The British Broadcasting Corporation to register
a series of three marks in Classes 9, 16, 25 and 41**

AND

**IN THE MATTER OF Opposition thereto under No. 48452
by The Metropolitan Police Authority**

BACKGROUND

1. On 1 July 1996, The British Broadcasting Corporation applied to register the following as a series of three trade marks in Classes 9, 16, 25 and 41:



2. The application was accepted and was published together with the following clause:

“The applicant claims the colour blue as an element of the second mark in the series”

for the following specifications of goods and services:

Class 9

Sound, video and data recording and reproducing apparatus; amusement apparatus for use with or incorporating a television screen or video monitor; 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; sound, video and data recordings; cinematographic films and photographic films all prepared for exhibition; instructional and teaching apparatus and instruments; records, discs, tapes, cassettes, cartridges, cards and other carriers bearing or for use in bearing sound recordings, video recordings, data, images, games, graphics, text, programs or information; memory carriers, CD-Is and CD-ROMs; magnets; sunglasses; parts and fittings for all the aforesaid goods.

Class 16

Printed matter; printed publications; periodical publications; books; booklets; magazines; catalogues; guides; carrier bags; paper bags; pamphlets; brochures; programs; stationery; book-binding materials; artists' materials (other than colours or varnish); paint brushes; instructional and teaching material (other than apparatus); writing instruments; pens, pencils and crayons; erasers; posters; photographs; photograph albums; diaries; calendars; drawings (graphic); stickers; ordinary playing cards; parts and fittings included in Class 16 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, head squares, 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 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.

3. On 27 April 1998, The Receiver for The Metropolitan Police District filed notice of opposition. They frame their objections in the following terms:

“1. The opponent is the proprietor of the trade mark, device and associated blue imagery known as a police public call box more commonly known as the POLICE TELEPHONE BOX.

2. The opponent has made use of its mark and has a considerable reputation and associated goodwill in the United Kingdom in his trade mark.

3. The applicant sought the consent of the opponent to feature the POLICE TELEPHONE BOX and associated blue imagery in the applicants’ science fiction television series entitled DR WHO. The opponent willingly gave such consent. In acceding to the applicants’ request for consent the opponent did not agree nor did his consent imply any additional rights or permission for other media or reproductions. Accordingly, the registrar is requested to refuse the application in accordance with the provisions of Section 3(6) of the Trade Marks Act 1994.

4. The mark applied for under application number 2104259 is not capable of distinguishing goods and services in respect of which registration is sought. Accordingly, the registrar is requested to refuse the application in accordance with the provisions of Section 3(1)(a) of the Trade Marks Act 1994.

5. In view of the substantial reputation and goodwill acquired by the opponent in his trade mark, use or registration of the mark applied for under application number 2104259 will lead to deception of the public. The opponent has granted commercial exploitation licences for the Police Telephone Box. The registrar is therefore requested to refuse the application in accordance with the provisions of Section 3(3) and 3(4) of the Trade Marks Act 1994.

6. The trade mark applied for under application number 2104259 is confusingly similar to the opponents’ trade mark and its use in relation to the same or similar goods or services would cause confusion. The registrar is therefore requested to refuse the application in accordance with the provisions of Section 5(2) of the Trade Marks Act 1994.”

4. On 10 August 1998, the applicants filed a counterstatement in which the various grounds of opposition are either denied or not admitted.

5. Both parties filed evidence in these proceedings and both seek an award of costs. The matter came to be heard on 20 March 2002. At the Hearing, the applicants were represented by Mr Walsh of Bristows, Solicitors; the opponents were represented by Mr Nair of The Directorate of Intellectual Property Rights, Ministry of Defence.

Preliminary Point

6. In the letter sent to the Trade Marks Registry enclosing his skeleton argument, Mr Nair stated that an error had been noticed in the Statement of Grounds of opposition when preparing the skeleton. The reference to Section 5(2) should have been to Section 5(4). He sought to amend the pleadings accordingly. Mr Walsh on behalf of the applicants objected.

7. Mr Nair said that they had no earlier registrations upon which they could rely and therefore the Section 5(2) ground was not appropriate. As the applicants' Attorney was not prepared to accept an amended pleading he did not seek to press his request. Thus, the opposition is based upon Section 3(1)(a), 3(3) 3(4) and 3(6) of the Act.

OPPONENTS' EVIDENCE

8. This consists of a statutory declaration dated 18 November 1998 by Andrew Kinch. Mr Kinch explains that he is a Higher Executive Officer in the Department of Procurement and Commercial Services of the Metropolitan Police Service based in London. He states that he has been employed by the opponents since 1976 and that he is authorised to make his declaration on behalf of the Receiver for the Metropolitan Police District and the Metropolitan Police Service; he adds that the information in his declaration comes from either his own knowledge or from the opponents' records.

9. The following information emerges from Mr Kinch's declaration:

- the Police Telephone Box was originated by the Metropolitan Police and has been owned by them and used exclusively in London from 1929 when it appeared on London streets;
- in 1953 there were 685 Police Telephone Boxes in the metropolis; use was also made of the Telephone Boxes by provincial police forces;
- the public used the opponents' Police Telephone Box to obtain advice, make emergency calls and to receive assistance. Thus the opponents' Telephone Box served as one of its most used service marks from 1929 onwards;
- that the applicant could not have been unaware of the opponents' earlier ownership of the Police Telephone Box sign and imagery when the "Dr Who" serial was being produced and which featured a Police Telephone Box. When the first episode of Dr Who was broadcast in November 1963 there were hundreds of Police Telephone Boxes in use by the opponents and the public;
- exhibit AK1 consists of a drawing dated 12 July 1995 illustrating the opponents'

Police Telephone Box design. This drawing relates to the most recent installation of the opponents' design located outside the Earls Court Road exit of the Earls Court London Underground tube station. These drawings, says Mr Kinch, illustrate the copyright and design right owned by the opponents which existed prior to the trade mark application;

- that it would appear that the applicant considered it proper to adopt (“without asking it would seem”) the opponents' sign and imagery for its commercial purposes. In the 1960s the opponents had no reason to object or refuse consent to the use of its street furniture in the ‘Dr Who’ series particularly as the opponents did not have any commercial activities and the use by the applicant did not impinge in any way on the opponents' operation. However, says Mr Kinch, the opponents business now require benefits to be derived from its intellectual properties and the trade mark application in suit could serve to exclude the opponents from exploiting its own intellectual property rights. He adds that the opponents believe that at all times the applicant had knowledge that the Police Telephone Box belonged to and was the exclusive sign and imagery of the opponents;
- the opponents had no reason to suspect the applicant of any covert trade mark intentions or plans to extend its use beyond what was originally allowed by the opponents i.e. using the opponents' mark and imagery associated with its Police Telephone Box in the ‘Dr Who’ TV serial. The opponents relied on its licensed user of its mark (ie. the applicant) not only to safeguard the integrity of the Police Telephone Box mark and imagery but also expected them not to take any action to materially diminish the opponents' intellectual property rights. This application is, in Mr Kinch's view, an attempt to obtain a monopoly right to the opponents' mark and imagery;
- the opponents do not believe there to be any clear or visible indicator on the applicants' mark to unambiguously indicate an immediate association with the applicants. The shape of the Police Telephone Box, the wording “Police Public Call Box” and the colour blue all so closely resemble and mimic the shape, format and style of the opponents' Police Telephone Box as to be likely to deceive;
- the opponents have granted a commercial exploitation licence for the use of their drawings for the manufacture and sale of replica Police Telephone Boxes. Exhibit AK4 consists of extracts from a licence granted by the opponents to “The Once Upon A Way Trading Company” illustrating the opponents' commercial exploitation of their copyright in the drawings and design right in the Police Telephone Box. Exhibit AK5 consists of a letter dated 13 November 1998 to Britannia Miniatures which, says Mr Kinch, is a reference to a new licence being granted for miniature replica Telephone Boxes. The application in suit interferes with the opponents' inherent right to licence and exploit their trade mark and related intellectual property rights in the Police Telephone Box.

Mr Kinch concludes his declaration in the following terms:

“The opponents hereby respectfully submits that in view of his earlier rights including copyright and design right in the drawings for the Police Telephone Box and his prior trade mark rights and reputation in the mark and imagery associated with the Police Telephone Box the applicant is not entitled to benefit from the mark applied for.”

APPLICANTS’ EVIDENCE

10. This consists of two statutory declarations. The first dated 19 February 1999 is by Shaun Sherlock. Mr Sherlock explains that he is the Trade Marks Manager in the applicants’ Intellectual Property Department a position he has held since October 1997. He confirms that he is authorised to make his declaration on the applicants’ behalf adding that the information in his declaration comes from either his own personal knowledge or from company records.

11. Having provided some background information on the activities of the applicants for registration, namely that the British Broadcasting Corporation (BBC) is a large and well known broadcasting and entertainment organisation which currently operates four television channels and five radio stations throughout the whole of the United Kingdom, the following information emerges from Mr Sherlock’s declaration:

- that the application is in respect of three marks associated with the BBC’s television programme Doctor Who; a very successful independently known TV programme which has run on and off since 1963;
- the device marks the subject of the application in suit are, says Mr Sherlock, representations of a time and space travel machine known as “the Tardis”, which has featured regularly in the DOCTOR WHO programmes since 1963;
- that images of the Tardis feature in promotional materials for the programme; in this regard he refers to exhibits showing a publicity shot of the Tardis which was distributed “last year” ie. in 1998;
- that since at least the mid 1970s the BBC has engaged in substantial merchandising in relation to the DOCTOR WHO television programme which has enhanced the reputation of names and images associated with the programme, including the Tardis device. Examples of merchandise produced in relation to the DOCTOR WHO programme include postcards, a Tardis miniature set, watches, CD-ROM, a belt buckle, a children’s toy, a calendar and a 1999 edition of the DOCTOR WHO magazine. Mr Sherlock comments that although most of the goods provided are recent examples of DOCTOR WHO products they are nevertheless illustrative of the way in which names and images associated with the DOCTOR WHO programme including the Tardis have been used in merchandising activities;
- that the DOCTOR WHO television programme has been extensively exploited over the years by the BBC and its licensees by the sale of sound records, audio cassettes and video recordings. Exhibit SNS8 consists of copies of the covers of audio and video cassettes together with a compilation video recording entitled “More than 30 years in the Tardis” most or all of which were sold in the United Kingdom prior to

July 1996. Mr Sherlock observes that the Tardis device features prominently on many of the audio and video recordings.

12. Mr Sherlock then turns his attention to the opponents' evidence. The main points arising from his declaration in this regard are as follows:

- that in their notice of opposition, the opponents alleged that the BBC sought the consent of the Metropolitan Police to feature the police telephone box and associated blue imagery in the DOCTOR WHO programme, and that consent was given, but has now been exceeded by the filing of the application in suit. Mr Sherlock notes that in paragraph 5 of Mr Kinch's declaration he appears to accept that this was not the case. Mr Sherlock confirms that a search of the BBC's files has not revealed any consent to feature a device resembling a police telephone box in the DR WHO programme having been sought from the Metropolitan Police or given. He goes on to say that he is not aware of any intellectual property the Metropolitan Police owned or any other reason why the BBC would have needed to seek consent from the Metropolitan Police to feature the Tardis in the DR WHO programme or in any of the BBC's merchandising activities connected with the programme. Nor is he aware of any objections having been raised by the Metropolitan Police to use of the Tardis device by the BBC for over 35 years;
- in so far as the opponents' claim to be the proprietors of the unregistered trade mark, device and the associated blue imagery known as a police public call box, Mr Sherlock notes that no evidence has been provided to demonstrate that any sign or image associated with the police telephone box has ever been used by the Metropolitan Police as a trade or service mark. He concludes that even if there had been any reputation or goodwill in 1963 in any sign or imagery associated with the police telephone box, such goodwill would only have been in relation to the services connected with policing and enforcement of law and order and would not have extended to any goods or services for which the BBC is seeking to register the application in suit;
- that in paragraph 7 Mr Kinch suggests that the BBC has used the Tardis device as the Metropolitan Police's licensed user. This allegation has, says Mr Sherlock, no basis in fact and he does not believe that the BBC has used the Tardis device under licence to the Metropolitan Police or anyone else. He observes that no documentation eg. a licence agreement has been provided to support this assertion;
- in so far as the opponents assert that they own copyright and design right in the drawings of the police telephone box, Mr Sherlock notes that the opponents have not identified any original drawings in which copyright or design right could subsist nor have they identified the date and authorship of any such drawings, or the owner of any rights. Mr Sherlock adds that since the telephone boxes first appeared on the London streets in 1929, he presumes that any original drawings if they did exist would have to have been created before that date. He comments that the existence of such drawings has not been proved nor have the opponents explained why they believe that copyright would still exist in any drawings or would have existed at the date of the application

or in 1963. In so far as the opponents provide copies of drawings attached to Mr Kinch's declaration, Mr Sherlock comments that in respect of the drawings attached to exhibit AK4, these are undated and the status of the drawings is unclear. Mr Sherlock says that he has no reason to believe that they are original drawings or that any copyright has ever resided in them. They are he says in any event detailed industrial drawings for a telephone box and he does not consider the Tardis device can reasonably be seen as a reproduction of these drawings. In relation to the drawings provided as exhibit AK1 to Mr Kinch's declaration dated 12 July 1995, it is says Mr Sherlock, clear that the application is suit cannot infringe any copyright in these drawings given the BBC's use of the images of the Tardis for many years before these drawings were created.

13. The second declaration dated 15 May 2000 is by Nicholas Foot. Mr Foot explains that he is a Trade Marks Lawyer in the applicants' intellectual property department having held this position since 1999. He confirms that he is authorised to make his declaration on the applicants' behalf adding that the information in his declaration comes either from his own personal knowledge or from the records of the BBC and its wholly owned subsidiary BBC Worldwide Limited.

14. Mr Foot, by reference to the declaration of Mr Sherlock mentioned above, explains that in his declaration Mr Sherlock discusses the copyright and design right in the drawings for the police telephone box. Exhibit NGF1 to his declaration consists of a letter dated 29 February 2000 from the United Kingdom Patent Office which relates to a search carried out by the Patent Office in relation to the application in suit. Mr Foot observes that the search revealed one registration in the name of Satellite Industries Inc entitled "Portable rest room" and a second in the name of Burgess Architectural Products Limited and entitled "Telephone booth". From this search Mr Foot concludes that the Patent Office did not find any design registration in the name of the Receiver for the Metropolitan Police which was similar to the trade mark under opposition. That said, I note that the official letter includes the following paragraph:

“PLEASE NOTE

This search has been undertaken in respect of registered designs only and does not cover any unregistered protection that may be afforded designs under the "Design Right" provisions of the "Copyright, Designs and Patents Act 1988" nor any under the Copyright Acts".....

OPPONENTS' EVIDENCE-IN-REPLY

15. This consists of a further statutory declaration dated 5 September 2001 by the same Andrew Kinch mentioned above. I reproduce below verbatim those extracts from Mr Kinch's declaration which I consider to be the most pertinent to these proceedings:

“3.....[The] opponents' objection is directed at what I believe to be the applicants' appropriation and monopolisation by way of trade mark registration of the opponents' earlier Police Box and image. I accept that the Dr Who serial is famous. However the

use of the opponents' Police Box and image may have been of tangible assistance to the applicant in achieving such fame.....”

“4.I believe that the mark applied for is instantly recognisable to the public from its appearance, image, colour and the inscription “POLICE.....BOX” as none other than the opponents' Police Box.”

“5. I refer to paragraph 11 in which Mr Sherlock comments on the opponents' statement regarding consent given to the applicant for the use of his Police Box in the Dr Who TV series. I understand this is the very reason why there has not been any objection to the applicants' continued use of the Police Box in the Dr Who TV series. I also understand that the applicants' action to extend the scope of their rights in the opponents' Police Box and image by way of trade mark registration when it came to the opponents attention triggered the opponent into reviewing the potential erosion of his existing and inherent rights in the mark. I believe that the opponent had not acquiesced rather it was content with the applicants' use of his police box in the TV serial during the preceding period as the opponent believed such use to be consistent with the permission he had given the applicant at the time when the first Dr Who programme was produced.”

In paragraph 6 of his declaration, Mr Kinch provides more detail on the origins of the police box and provides further comments. Exhibits AK1 to AK4 consist of:

AK1 - information on the origins of the police box, its spread within the Metropolis, the services offered and available to the public from the police box during the period 1929 to 1969;

AK2 - various press cuttings illustrating the purpose and use of the police box;

AK3 - a photograph of a member of the public receiving “service” at the police box;

AK4 - an extract from Mr Gilbert MacKenzie Trench's drawings for the police box.

Mr Kinch comments further:

“Police Boxes began life in the 1880s as Police signal boxes. The early boxes were designed by the Metropolitan Police Architect and Surveyor Mr Gilbert MacKenzie Trench and first appeared in 1929. The initial use commenced in 1929 and continued substantially until at least 1969. The opponents' use of his Police Box and image within the Metropolis continued whilst the Dr Who television was being broadcast.....” ..

“.....[F]or the opponents the police box and the image served as an “invitation to offer a service” to the public and as such became the opponents' trade mark. I believe that the police box and image became synonymous with the opponents' activities and well recognised by the public as the opponents' mark.”

“I believe that the opponent until it became aware of the applicants’ mark had relied on its licensed user of its mark (the applicant) not only to safeguard the integrity of the opponents’ mark and imagery but also expected the applicant not to take any action to materially diminish the opponents’ earlier rights and reputation. The pending application therefore appears to be seeking for the applicant monopoly rights in the opponents’ Police Box Device and imagery. In consequence the applicants’ intention appears to be to misappropriate the famous device mark and imagery of the opponent. This not only extinguishes the opponents’ right to own, use and exploit without constraints its device mark and imagery but also limits its freedom to register and benefit from his earlier rights and reputation in the mark. I believe that these actions exemplify bad faith. In addition the opponents’ belief that permission was given to use his Police box and imagery only for the Dr Who series reinforces the opponents’ view that the applicant has acted in bad faith.”

Mr Kinch concludes his declaration in the following terms:

“In view of the above the opponent respectfully submits that the application should be refused as it appears to have been made in bad faith which I understand is contrary to the provisions of Section 3(6) of the Trade Marks Act 1994.”

16. I have provided a comprehensive summary of the evidence filed in view of the unusual nature of this case.

DECISION

17. The first ground of objection is based upon Section 3(1)(a) which states:

“3.-(1) The following shall not be registered -

(a) signs which do not satisfy the requirements of section 1(1),”

Section 1(1) states:

“1.-(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

18. In AD 2000 [1997] RPC 168 Mr Geoffrey Hobbs, acting as the Appointed Person, sated that:

“...The requirements of Section 1(1) are satisfied even in cases where a sign represented graphically is only “capable” to the limited extent of being “not incapable” of distinguishing goods or services of one undertaking from those of another undertaking. Such signs are not excluded from registration by Section

3(1)(a). Section 3(1)(a) has the more limited effect envisaged by Article 3(1)(a) of the Directive of preventing the registration of “signs which cannot constitute a trade mark” at the time when they are put forward for registration.”

19. Furthermore, the European Court of Justice in *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* C-299/99 stated that:

“...it is clear from the wording of Article 3(1)(a) and the structure of the Directive that that provision is intended essentially to exclude from registration signs which are not generally capable of being a trade mark and thus cannot be represented graphically and/or are not capable of distinguishing the goods or services of one undertaking from those of other undertakings.”

20. Having regard to the law and the relevant authorities, I do not consider the trade mark for which registration is being sought is one which fails the low threshold of acceptance under this head. The ground of opposition based upon Section 3(1)(a) is dismissed.

21. The next ground of opposition is Section 3(3) which states:

“3.(3) A trade mark shall not be registered if it is -

- (a) contrary to public policy or to accepted principles of morality, or
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

22. No case or submission has been made that the case is one for consideration under Section 3(3)(a) and therefore I consider the matter on the basis of 3(3)(b).

23. The opponents consider that their reputation is for policing and the applicants’ is for broadcasting. The trade mark in suit, the device of a Police Call Box, is, the opponents claim, linked to the service they provide and therefore there is likely to be deception as to origin of the goods supplied under it.

24. There have been numerous decisions of the Registrar’s Hearing Officers which confirm the Trade Marks Registry’s view that an objection on the basis of Section 3(3)(b) is one which is based upon absolute grounds. Also, Kerly’s *Law of Trade Marks and Trade Names* (Thirteenth Edition) at page 202, paragraph 7-165, which in relation to Section 3(3)(b) states:-

“... it is an absolute not a relative ground of refusal. It is concerned with deceptiveness which is apparent within the mark itself as opposed to deception caused by the similarity of one mark to another.”

25. Thus, it seems to me the objection is not well founded. However for the sake of completeness I have referred to paragraph 9.2 of Chapter 6 of the Trade Marks Registry’s Work Manual which states:

“Objection under Section 3(3)(b) - Deception as to the nature, quality or geographic origin of goods/services

In Collins Dictionary the verb “to deceive” is defined as “to mislead by deliberate misrepresentation or lies”. Objections have in the past been raised to trade marks where there was no realistic possibility of deception - but where the specification was too wide. For example, objection may have been raised to HARTLEY’S STRAWBERRY JAM unless the goods were limited to “strawberry jam”. In reality there seems little possibility of the applicant using that mark on anything other than strawberry jam. If the mark was used deceptively it would be open to revocation under Section 46(1)(d) of the Act.

An application to register such a trade mark for “jams” will no longer be regarded as a “deliberate misrepresentation”. It will be assumed that the applicant will either only use the mark on strawberry jam, or he will vary the mark in use (or else will fall foul of the Trading Standards legislation and also rapidly lose customers).

In future, an objection under Section 3(3)(b) will only be raised if in the examiner’s view there is any real potential for deception of the public. The examiner should consider whether there would be any possible advantage to **any** trader (not specifically the applicant) from using the mark on anything other than goods with the characteristics conveyed by the mark. All applicants must be treated equally so if, for example, we would object to the words GLENROSS for whisky, from (say) a French applicant, we should treat a Scottish applicant the same way, and in either case require the specification to be limited to “Scotch Whisky”. This change will result in a reduction in the number of “deception” objections.”

26. Looking at the trade mark in question here and taking into account the goods for which registration is sought, I do not consider that there is anything inherent within the trade mark which will deceive the public. The device of a police call box is fanciful for all of the goods covered by the application. The objection under Section 3(3)(b) is dismissed.

27. Next there is the ground of opposition based upon Section 3(4), which states:

“3-(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.”

28. There is, in my view no substance to this objection. No other United Kingdom statutory provision or instrument of Community Law has been brought to my attention. That ground too is dismissed.

29. The final ground of opposition is based upon Section 3(6) which states:

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

30. The opponents, through Mr Nair, claim that they have earlier rights in the police telephone box. They developed it and used it. They believe that the public recognise it as a trade mark belonging to the opponent. The applicants, they say, knew this and therefore acted in bad faith in applying to register the trade mark for the goods in question and denying the opponents the ability of benefiting commercially from this right. The applicants case, put by Mr Walsh, was that this application was not a preemptive strike by the applicants. There was no established relationship between the parties. He went on to state:

“Issues which I would like to draw to your attention I suggest are relevant are the questions, did the BBC know that the police box device was even a trade mark, let alone that the Metropolitan Police wished to use it? I think the answer to that is, no, for a number of reasons. Would the reasonable person think that the Metropolitan and other police services, who are charged with law enforcement responsibilities, use this mark in the course of trade? I doubt it. But even if the answer to that were yes, could any reasonable person regard this as a use of some sort of trade mark, rather than in any way different from the normal accoutrements of law enforcement, any more than a panda car that the opponents referred to, or a police helmet or a truncheon, or whatever? Could this device, which the Metropolitan Police say is a trade mark, have any relevance to the public beyond the confines of law enforcement? Basically, the two organisations do not compete. One is an entertainment services provider, one is a law enforcement body. There could be no reasonable expectation on behalf of the BBC of any concern on the part of the Metropolitan Police. If the BBC were in a position of having no way of realising that there would be any concern on the part of the Metropolitan Police, how on earth could their application have been in bad faith in the way that the opponent’s suggest.”

31. The observations of Lindsey J in *Gromax Plasticulture Ltd v Don Low Nonwovens Ltd* [1999] RPC 367 are relevant here.

“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. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

32. It seems to me from the evidence and submissions made on it that the Metropolitan Police Service developed the Police Box early last century and used it then as a base for local policing operations until the 1960s. But the Police Box was used by other Police forces too. Thus, the best that could be said about the public’s perception of what has been termed ‘street furniture’ is that it was an adjunct to the provision of a policing service. In that connection, I am not prepared to accept that the public at large would recognise it as a badge of origin of the Metropolitan Police Service itself given its use by the Police forces at large. Also, I bear in mind that for most of the period since the Police Call Box was taken out of service, the

only sight the public at large would have had of this item of street furniture has been in the TV programme Dr Who, provided by the BBC where it is a 'Tardis', a fictional time travelling machine with the external appearance of a Police Box.

33. It seems to me that the Metropolitan Police Service do not have any rights to the device the subject of this trade mark application such that they can say that the application has been made in bad faith. There was no established relationship between the parties which has been evidenced and which was breached. There is no trespass into an area where the Metropolitan Police Service (or any other Police service) might have an established reputation. Thus, it seems to me that the BBC in seeking to register this trade mark consisting of a device which is associated with a TV programme it produces and for a range of goods which are at a significant distance from any service to which the Police call box was an adjunct is not in any way falling short of acceptable commercial behaviour. This ground of opposition is also dismissed.

34. The opposition fails in its entirety and therefore the application can go forward to registration; the applicants are entitled to costs. There were some submissions by Mr Walsh that I should go off the scale because the bad faith allegation was not supported by evidence and because of the lack of clarity in the pleadings since, additional work was required by the applicants. I give those submissions some weight but taking into account the evidence filed, the preparation for and attendance at the hearing I considered there is no need to exceed the scale itself and I order the opponents to pay to the applicants the sum of £850. This sum 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 14th day of August 2002

**M KNIGHT
For the Registrar
the Comptroller-General**