

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2110335 BY
BASIL DAVIS TO REGISTER A SERIES
OF MARKS IN CLASS 38**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 47083
BY THE BRITISH BROADCASTING CORPORATION**

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2110335 BY
BASIL DAVIS TO REGISTER A SERIES
OF MARKS IN CLASS 38**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 47083
BY THE BRITISH BROADCASTING CORPORATION**

DECISION

On 14 September 1996 Basil Davis applied to register the following series of two marks in Class 38 for "radio broadcasting services, radio programmes".

"MIX FM"
BLACK MIX

MIX FM LTD
BLACK MIX

The application is numbered 2110335.

On 19 June 1997 The British Broadcasting Corporation (BBC) filed notice of opposition to this application. The full facts of the case will be apparent from the evidence summary. Briefly the BBC say that they have used the mark BLACK MIX as the title of a radio programme aimed at the African-Caribbean community and broadcast on one of their local radio stations. The applicant was a member of the production team for the programme but the opponents say that they retained editorial and production control at all times. Arising from this the opponents object under the following heads

- (i) under Section 1(1) and 3(1)(a). Without prejudice to the generality of that claim they say the marks are not capable of distinguishing the applicant's services having regard to the BBC's earlier use
- (ii) under Section 3(1)(b) in that the marks are devoid of distinctive character
- (iii) under Section 3(3)(b) in that the marks are of a nature to deceive the public having regard to use of the mark BLACK MIX by the BBC

(iv) under Section 3(6) in that the application was made in bad faith. There are a number of sub heads but the principal ones appear to be that the applicant knew he could not claim to be the proprietor of the marks and that he had no bona fide intention to use the marks

(v) under Section 5(4)(a) and (b) particularly be reference to the law of passing off

(vi) under Section 60(1) and (2)

It will be apparent from the above that the opponents have not particularised or explained certain objections and others have been expressed in terms which suggest the opponents wish to preserve the generality of their claims. I do not think this is an altogether satisfactory way of proceeding. My above summary of the grounds attempts to identify the main elements of the opposition.

The applicant filed a lengthy counterstatement. Again I will record relevant detail a little later in the decision. Suffice to say at this point that Mr Davis claims that he devised and originated the BLACK MIX programme, persuaded the BBC to broadcast it and acted as producer of the programme. It follows that he denies all the grounds of opposition.

Both sides ask for an award of costs in their favour.

Both sides filed evidence. The matter came to be heard on 25 January 2000 when the applicant was represented by Mr A Poore of Mills & Reeve and the opponents were represented by Mr T Z Gold of Stephenson Harwood.

The Evidence

Statutory declarations have been filed as follows:

Alison Francis Helen Reid - dated 30 December 1997 on behalf of the opponents

Basil Barrant Davis - dated 28 June 1998
(the applicant)

Alasdair David Poore - dated 30 June 1998 on behalf of the applicant

Mr Poore's declaration has been filed partly to correct certain aspects of the referencing in Mr Davis' declaration (this appears to be uncontested) and also to exhibit a statement made by Sonia Cole. This is contained in a letter and does not appear to comply with Section 69 of the Act and Rule 49 of the Trade Marks Rules 1994 as a result of which I feel unable to give it any weight. A number of other open ("To whom it may concern") letters have been exhibited. Again I find these to be of little evidential value.

The main declarations (from Ms Reid and Mr Davis) are lengthy documents and contain material that in my view is not always directly relevant to the issues before me. There is also a certain amount of common ground as to the background to the dispute and the underlying facts. However the parties place their own interpretation on events and, not surprisingly, reach different conclusions as to the consequences in terms of the law.

Ms Reid was Acting Editor of BBC Three Counties Radio and was previously the station's Senior Broadcast Journalist. She says the opponents have used BLACK MIX since January 1995 as the title of a radio programme broadcast within the counties of Bedfordshire, Buckinghamshire, Hertfordshire and surrounding areas by BBC Three Counties Radio. Ms Reid describes the background to the programme in the following terms:

“The format of the programme was developed by the BBC after consultation with various members of the African Caribbean community, including the Applicant. The Applicant had a role as one of several volunteers who were trained by the BBC to work on the programme under the BBC's editorial control, but it is not correct to say that he came to the BBC with a programme format which the BBC adopted. In any event it would not alter my view that the name BLACK MIX is closely associated with the BBC even if the format of the programme had been devised independently by the Applicant, which it was not. It is the BBC which has used BLACK MIX in relation to a radio programme produced under the BBC's editorial control and broadcast by the BBC since January 1995 and I have no doubt that BLACK MIX is associated with the BBC and not with the Applicant in the field of radio broadcasting and was associated with the BBC as of the filing date of application No. 2110335.”

After describing the importance the BBC attaches to programming for minority groups she goes on to say:

“The local African Caribbean community shared the BBC's concern about the need for a programme to cater for their interests and in January 1993 the Luton West Indian Community Association wrote to the Managing Editor of what was at that time BBC RADIO BEDFORDSHIRE requesting a suitable programme on the radio station. The BBC welcomed the opportunity of discussing with the community what they would like to see in a new programme and welcomed the idea of members of the community becoming involved in its production under the BBC's supervision and control. Discussions and several meetings took place between the BBC and interested members of the local West Indian community over the following months, including a large public meeting in Luton Town Hall in the summer of 1993. Several of the people who attended this meeting were invited by the Luton West Indian Community Association, one of whom was the applicant. As a result of these discussions four training groups were set up from volunteers in the local community who wished to become involved in the programme. The aim was that each group would be trained by the BBC in the basic skills needed to produce a pilot programme and each group was appointed a senior BBC Producer to oversee their activities. One of the four groups was co-ordinated by the Applicant. A series of training sessions was conducted by a BBC member of staff Liam McCarthy, in which he taught about sixty people including the Applicant skills such as researching a programme, script writing, interviewing, using a

portable tape recorder, and basic studio skills. The group co-ordinated by the Applicant and one other group eventually produced a pilot programme under the supervision of the senior BBC Producer appointed to them. Exhibit AFHR4 hereto comprises copies of relevant correspondence and extracts from the BBC's files.

5

Once the initial training stage was completed in about March 1994 members of the group co-ordinated by the applicant were invited to help with the BBC's proposed new speech based programme featuring items of particular interest to African Caribbean listeners. The applicant was appointed as the Producer of the new programme. An example of a local radio contract of the type which was standard at the time for freelance Producers working for the BBC is exhibit AFHR5 hereto. The Applicant was sent a contract similar to this one each week with payment for his work which he accepted. He was paid for his duties in producing each programme in accordance with the rate for a reporter's eight hour shift. As with the Producers of all of the BBC's programmes the Applicant had a certain amount of responsibility for the programme he was to produce and had a role in developing the programme in discussions with more senior BBC staff and suggesting ideas for its content from week to week. However the development and eventual production and broadcasting of the programme were at all times under the BBC's close editorial supervision and control. In fact the Applicant was supervised more closely than many other Producers because of his lack of previous experience in producing good quality radio programmes. Although the Applicant had in the past had some involvement with other programmes on BBC THREE COUNTIES RADIO, his previous work had rarely been considered to be of a sufficiently high standard to be broadcast and close supervision was considered a necessity.

10

15

20

25

Substantial supervisory and developmental work was carried out on the programme by BBC members of staff, who in some cases were very senior. For the major part of the period from 1994 up until 1997 the programme was developed and produced under the direct supervision of the Assistant Editor of BBC THREE COUNTIES RADIO, Jeff Winston. During a part of 1994 supervision was temporarily taken over by Mike Gibbons, Managing Editor of BBC THREE COUNTIES RADIO and then Nigel Dyson who took over as Acting Managing Editor in October 1994 together with Jonathan Wray who was News Editor. The supervision included regular editorial meetings, overseeing the programme content, drawing up running orders and providing guidance on studio production. Once the programme went on air these meetings would have occurred weekly. The BBC has had the final responsibility for all editorial decisions including programme format and content. A considerable amount of time and resources has been invested by the BBC in training the Applicant, both before and after the programme went on air, including providing training in presentation skills through Ian Skelly of the BBC Local Radio Training Unit in the Spring of 1994 and later sending the Applicant on several training courses in London. Copies of relevant correspondence and extracts from the BBC's files comprise Exhibit AFHR6 hereto.

30

35

40

5 It is the BBC who has responsibility for appointing the presenters of the BLACK MIX
programme. The main presenter at the outset was Sylvia Adele-Leigh, who was
recruited by Mike Gibbons as a student from the University of Westminster. Mike
Gibbons saw project material and listened to demonstration tapes from Ms Adele-
Leigh and other students during a visit to the University to talk to its students. Part of
10 the reason Sylvia Adele-Leigh was recruited was to provide alternative viewpoints and
ideas to those of the Applicant, since she had closer contact with younger African
Caribbean viewpoints. The BBC has only permitted other presenters to take part in
the programme provided they are of an acceptable standard and the BBC would use its
editorial control to remove any presenters which did not meet with its approval.

15 The programme name was chosen by the programme Editor after discussions with the
production staff. Several names suggested by different people were discussed at
editorial meetings. The suggestion to use BLACK MIX as the programme title may
have come from the Applicant, but the decision to use this name lay solely with the
BBC. I cannot see what rights the Applicant can claim in a name which was suggested
as the title of a BBC programme and which has only ever been used by the BBC.
20 Exhibit AFHR7 hereto comprises a copy of a letter from Nigel Dyson, Acting
Managing Editor of BBC THREE COUNTIES RADIO at the time the BLACK MIX
programme went on air, which relates to the choice of the programme name.”

Mr Davis, the applicant’s, position in relation to the issues at the heart of this dispute is as follows:

25 “In the period up to 1992 I identified the need for a programme with a serious spoken
content, directed to the African Caribbean community in the Bedfordshire region.
Other members of the local African Caribbean community supported this. I was
responsible both individually and on behalf of an organisation that I had set up to
promote relevant media access and involvement within the African Caribbean
30 community, called the Black Citizen’s Arts & Media Society (known as BCAMS), for
trying to convince the management at the BBC Three Counties Radio to let us have
such a programme. I have been President of BCAMS since it was set up. I refer to
exhibit BBD, pages 7 to 11, a copy of the programme for a fund raising event held by
BCAMS in association with the African Caribbean Enterprise (“A.C.E.”) and Luton
35 Borough Council (“LBC”). The organisation started as an informal pressure group in
about 1992, and became more formal with its public launch at the event advertised in
BBD, pages 7 to 11. The forward to the programme explains the purpose and aims of
BCAMS. My main interest as President has been the promotion and setting up of a
community radio station to serve the needs of the African Caribbean community within
40 the Bedfordshire, Buckinghamshire and Hertfordshire area.

Initially, I approached Mike Gibbons at Bedfordshire Radio (which later became
BBCT)¹. As he did not seem interested, I approached Nigel Chapman at the BBC who
put me in touch with Mike Gibbons, the Managing Editor. At first the Opponent was

¹ References to BBCT are references to BBC Three Counties Radio

reluctant to put on the programme. The Opponent did not accept that there was a need for a programme of the sort I wanted to broadcast and I was involved in lobbying the Opponent to raise support and to persuade it to provide the facilities for the programme to be produced. They said that they thought that the requirements of the community were met by existing music programming. I therefore had to make substantial efforts to convince the Opponents that there was need for such a programme. Once the Opponent started to appreciate that the community might have a need for the programme, they asked me to prove to them that the need was genuine.

At that time the Opponents were not broadcasting any spoken word programme for the African Caribbean community. There had been spoken word programme (CALABASH) some time previously. This had not been very successful and had stopped being broadcast in the 1980s.

As part of this effort I enlisted the support of the Luton West Indian Association (“LWICA”) and other groups in the local African Caribbean community to show BBCT that there was a genuine need. One of the first meetings was a meeting I had with the Luton West Indian Association, at which I presented my ideas to them and invited them to participate in a petition to the BBC to have such a programme. The form of the petition is set out in BBD, page 12. When this was obtained it was presented to the BBC by LWICA in the letter exhibited at AFHR4, last document of Frances Reid’s declaration.

It was as a result of my efforts to make the Opponent aware of the needs of the community, over the two year period preceding the first broadcast, that the Opponent eventually relented and allowed us to have the programme. In all approximately 6 meetings were held, some at LBC, some at LWICA and some at the BBC. I chaired all these meetings.

Once the Opponent had accepted the need for the programme I initially worked in the capacity of a volunteer and I received, along with a number of other volunteers, some training from the Opponent to enable me to carry out production duties.

At the time of the first broadcasts, BBCT (Nigel Dyson) had chose the name “BLACK VOICE”, as shown in the letter dated 21.12.1994 (AFHR6). The letter confirms that Nigel Dyson thought this was the most suitable name to reflect the programme content accurately. I note that in his letter he says that “Ultimately programme names are irrelevant - it’s the content that’s important.”. They had previously referred to the programme as Black Speech (AFHR6, 5.12.1994). The first listing of the programme was under the name BLACK VOICE, as shown in AFHR1 (page 3, 14-20th January).

I felt very strongly at that time that BLACK VOICE was not a suitable name, and I had come up with the name BLACK MIX. I first came up with the name “BLACK MIX” before BBC Three Counties Radio put on the programme. I felt that the name reflected the mixed speech and music programme covering a wide range of serious issues of interest to the local African Caribbean community which I wanted them to broadcast. I had discussed this with my colleagues at BCAMS and they had agreed it

was the appropriate name. The reason for my choice was that I believed it reflected much more effectively the programme content which I was planning. Based on this I sought to persuade BBCT that they should use this name rather than the one which they had chose. In fact, at the time BCAMS discussed filing a trade mark application for the name, but did not have sufficient funds to go ahead with this.

The first programme was broadcast on 8th January 1995.

When we started preparing the programmes for broadcast, at first, co-ordinating meetings were held with Jeff Winston at which we would discuss what material would be covered in the programme. However, after the first two programmes were broadcast no further co-ordinating meetings were held and there were no BBC Three Counties Radio staff present either before or during production. Throughout the time up to the date of application for the trade marks, I prepared the scripts of the programmes in detail. I would set the programme content and format, running lists, the script, the choice of music, production of the programme. I was responsible for any volunteers who came onto the programme, and for selecting those who were interviewed. (In the later stages, Sylvia Adele-Leigh made suggestions as to some people who should be interviewed. I would decide whether they were appropriate, and arrange other aspects of the programme around these interviews).

As mentioned one of the themes was education and participation by members of the African Caribbean community, so that they learnt about media work.

Partly from this and from other initiatives, a number of other people volunteered to work on the programme and where they had not had previous radio experience, I was responsible for providing training.

For example, Sandra Gooden had won a student competition whilst she was at Barnfield College completing a Media Studies course. Sandra came to see me and we discussed the possibility of her participating in the programme. It was agreed that initially she would take part in presenting the programme by reading the African news and compiling the "What's On" section. As she had not had any previous radio experience, she together with Howard McCalla, received training from myself, to enable her to carry out that role, and on one occasion Jeff Winston, a BBC Three Counties radio employee, sat in. I also gave her further training when it was decided that she would present the main part of the programme whilst Sylvia Adele-Leigh was temporarily away from the programme on maternity leave. Sandra was fully involved in helping out and presenting the programme, with Howard McCalla, and was therefore in a position to be aware of the level my involvement in organising the programme content and producing the programme. The format of the programme was entirely under my control and direction. As I have said, after the first couple of broadcasts no BBC Three Counties employees were involved at all in the production process or editorial content of the programme."

Mr Davis also deals at some length with his view that the opponents do not have any significant reputation in the name BLACK MIX. Rather he suggests that he has become

associated with the name (he exhibits letters to this effect). He also describes his intention to use the mark applied for in relation to broadcast programme services. (I take this to be in relation to part of the Section 3(6) ground).

5 Both sides also deal with two other matters that appear to be of tangential (if any) relevance to the issues before me. These are the circumstances in which Mr Davis' involvement with the BLACK MIX programmes ended in September 1996, (closely followed by the filing of the trade mark application) and a subsequent letter from the applicant's solicitors to the opponents regarding use of the name BLACK MIX and a request for compensation.

10

I will deal with these and other points addressed in the evidence to the extent necessary in reaching my decision.

With the above evidence in mind I turn to the grounds of opposition.

15

At the Hearing Mr Gold indicated that certain grounds were not being pursued, these being the objections under Sections 1(1), 3(1)(a), 3(3)(b), 5(4)(b) and 60(1) and (2). Those grounds are therefore dismissed. The Section 3(1)(b) ground, if not quite given up, has not been pursued with any vigour. I confirm that I can see no conceivable basis for this ground and it too falls.

20

I propose to deal with the Section 3(6) ground first. The Section reads:

25

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

The opponents' objection falls under two main headings. Firstly, it is said that the applicant cannot claim to be the proprietor of the mark and secondly that he did not have a bona fide intention to use it at the time the application was made. I will deal with the proprietorship point first because it is the issue at the heart of this dispute.

30

I have recorded the main parts of the principal declarants' evidence giving their respective version of events. I should say that Mr Poore, for the applicant, was critical of the fact that Ms Reid does not appear to have been directly involved in events at the relevant times. There has, however, been no formal challenge to her evidence on that account. She is certainly in a senior position in the organisation and confirms that she has access to relevant records and documents, a fact that is borne out by the papers she exhibits. There is in any case common ground (though some differences in emphasis) between the parties in relation to a number of the underlying circumstances particularly as regards the origins of the BLACK MIX programme. The existence of the correspondence and papers relating to events at the time is not disputed though the parties place different interpretations on some of this material.

35

40

Mr Davis' position is that he originally devised and produced the programme for broadcast on BBC Three Counties Radio (for ease of reference I will simply refer to the station as the BBC hereafter). The BBC's view is that it is their programme and that the original approach by the local community groups coincided with their own wish to provide programming for all sections of the community.

45

Ms Reid's evidence contains at AFHR4 copy correspondence from the BBC's files which sheds light on the background. The first approach to the BBC came from the Luton West Indian Community Association (LWICA) in January 1993. The LWICA described itself as the official organisation representing the black community in the area. The letter presents a petition reflecting the local community's desire for a programme aimed primarily at, but not I think limited to, the African Caribbean community. Mr Davis is referred to as a possible producer for the programme.

I have no doubt that the letter is in part a reflection of behind the scenes efforts by Mr Davis to stimulate interest in such a programme. Although the letter puts forward a number of ideas for a programme I infer that this was in the nature of a wish list or recommendation and that the proposals had not been worked up into anything more concrete. It is also reasonable to infer that neither the LWICA or Mr Davis had the resources to take the initiative forward. Their interest at the time was in my view simply to get the BBC to cater for the interests of the African Caribbean community. I do not see anything in the initial approach which might have suggested any proprietorial claims in relation to the title, format or content of whatever programme (if any) emerged.

Thereafter the proposal was progressed by the BBC who brought together various groups to discuss content and training (interviewing, studio, research and script writing skills etc). A number of the groups were invited to produce a pilot programme using the expertise they had acquired. Certainly up to at least March 1994 four groups were still involved with compiling pilot programmes and I assume at that stage any one of them could have been successful.

At some point (the precise date is not clear) Mr Davis emerged as the BBC's choice to produce the programme. The first programme was broadcast in January 1995. The circumstances surrounding the choice of title for the programme require some comment but I cannot see from the evidence that a name or even a working title had been settled on up to this point. Mike Gibbons, the BBC Managing Editor at the time does refer to it as the Black Speech Magazine but whether that is a reference to content or title is not clear.

Mr Davis says he came up with the name BLACK MIX . Ms Reid for the BBC concedes that "the programme title may have come from the applicant but the decision to use this name lay solely with the BBC." I am inclined to accept Mr Davis' claim that he proposed the title BLACK MIX. Certainly there is no outright denial that this is the case.

It appears that the initial choice of title for the programme was BLACK VOICE (per the Radio Times pages at AFHRI). That choice was made by the BBC though it appears from Nigel Dyson's letter of 21 December 1994 (in AFHR6) that other titles had also been under consideration.

Mr Davis comments:

"As I have mentioned above, the programme name chosen by the BBC was "BLACK VOICE". It is somewhat less than accurate to suggest that the decision as to programme title lay solely with the BBC. While I assume that they would veto wholly unsuitable names, the BBC would not have used this name but for the proposal put

forward by me. It was only as a result of my efforts to convince the Opponent that the name BLACK MIX was the most suitable that the programme name was used. Nigel Dyson eventually agreed to use the name BLACK MIX which had been originated by myself and which I had already used during discussions about the programmes.”

5

So far as this part of the evidence is concerned there seems to be a tacit acknowledgement in the above that the final choice rested with the BBC and I think this went beyond merely vetoing potentially unsuitable names. I conclude that the programme title was only settled on at a late stage (December 1994 or January 1995) and that the choice of title rested with the BBC who adopted a suggestion put forward by Mr Davis.

10

I go on to consider whether there was anything in Mr Davis’ working relationship with the BBC which might point to him having a proprietorial interest in the programme or the title. Firstly and most obviously I do not think he made any ownership claims clear at the outset though that on its own is not conclusive. Mr Davis stresses that he exercised control over the format and content as producer of the programme. There is a conflict of evidence as to the degree of overall supervision and editorial control exercised by the BBC. Mr Davis believes he was or became a free agent and claims not to have been aware of any overt editorial control. The BBC say that they had final editorial control and that this continued throughout Mr Davis’ tenure as producer. I do not think it is critical for me to resolve this apparent conflict. The truth is probably that as Mr Davis and his team became more experienced there was a consequential diminution in the need for intervention by the broadcaster. In any case the functions exercised by Mr Davis as producer presumably corresponded to the role that an internal producer (BBC employee) would have been expected to assume. In other words to fulfil the function of a producer he needed to generate content and come up with an end product with minimum need for intervention by the BBC.

15

20

25

What then was Mr Davis’ status? He describes himself as an independent producer. He was not on my reading of the evidence an employee of the BBC but equally he was not acting as an independent production company devising and developing a programme for sale or license to a broadcaster (BLACK MIX was not a piece of "bought-in" programming). Rather he was employed on a freelance basis to produce a programme using BBC resources. The BBC say that Mr Davis “was paid for his duties in producing each programme in accordance with the rate for a reporter’s eight hour shift”. In support of this Ms Reid exhibits at AFHR5 a copy of a local radio contract of the type that was said to be standard at the time for freelance producers. It is said that such a contract was sent to Mr Davis each week. Mr Poore criticised this on the basis that the only example shown actually covers three of the weekly programmes. That may point to careless drafting in Ms Reid’s declaration but it does not mean that I should discount or give less weight to the evidence of the contract itself. Mr Davis says that he has no recollection that he ever signed and returned any such contracts and points to the fact that no signed contract has been produced. Equally he does not say he did not receive such contracts. Nor does he deny receipt of the fees said to have been paid (the fee appears to have been £68 per session plus travel expenses). I find that somewhat disingenuous. Mr Davis does not point to any other form of payments received and he was not, I think, giving his services free. I have not had the benefit of detailed submissions in relation to the law of contract but prima facie it seems to me that an offer was made and accepted, the acceptance of the fees paid by the BBC constituting a consideration and,

30

35

40

45

therefore, confirmation that Mr Davis accepted the contract. On the basis of the evidence I fail to see anything in the nature of Mr Davis' relationship with the BBC that might confer ownership of BLACK MIX (or a mark incorporating that element) on him. The role of freelance producer does not in my view bring with it proprietary rights absent some very clear understanding or contractual arrangement between the producer and the broadcaster/commissioner of the programme.

Nevertheless, it is part of the applicant's case that he was strongly associated with the programme by the local African Caribbean community. I accept that this is a credible claim as he had played a leading role in working with local community groups to persuade the BBC to put on a suitable programme. Even so the evidence in support of the claim is either inadmissible or of doubtful value consisting of open ("To whom it may concern") testimonials or statements from interested parties (pages 1, 2, 17 and 18 of BBD1 and ADP1) or letters seeking positions on the programme (pages 3 and 6). More importantly any association was not in my view an association as to ownership. Presenters (and less frequently perhaps producers) will often be strongly associated with the programmes they present. In fact it is frequently the drawing power of the presenter that is the key to a programme's success. But that does not make the presenter the proprietor of the programme or the title of the programme.

I note that the newspaper articles at AFHR2 of Ms Reid's evidence, though they give some prominence to the presenters of the BLACK MIX programme, still do so in the context of it being BBC Three Counties Radio's Black Mix programme. Mr Poore suggested that I should give less weight to these press articles because they were in the nature of 'placed' material rather than spontaneously generated newspaper coverage. Even if that is true I do not think it significantly detracts from the natural conclusion to be drawn. Mr Davis' own evidence (page 5 of BBD1) contains an article in which he talks to the Weekly Gleaner. Again the article refers to 'BBC radio's Black Mix'. In my view, therefore, Mr Davis' association with the programme does not assist his claim to ownership.

In summary I find that Mr Davis and the LWICA's initial interest was in lobbying for a community programme without any suggestion that ownership rights might be claimed in what emerged; that the decision whether to have a programme or not rested with the BBC (and still does); that the BBC exercised overall control over choice of key personnel and their training; that the contract between the BBC and Mr Davis suggests that the latter's role was a limited one; Mr Davis' association with the programme did not in itself confer proprietary rights; there is no evidence that any claims to ownership of the title, format or content of the programme were asserted during the period leading up to the broadcasting of the programme; and that the BBC has continued to broadcast the programme under the title BLACK MIX since Mr Davis' departure. None of this is to say that I do not have some sympathy with Mr Davis who clearly feels he was a prime mover in persuading the BBC to put the programme on and had a significant role as producer. However, in the final analysis I do not think Mr Davis' claim to proprietorship is well founded and the opposition succeeds on this account.

The second leg of the Section 3(6) attack is that the applicant has no bona fide intention to use the mark applied for. Implicit, I think, in this objection is the suggestion that Mr Davis may have had some ulterior motive. The point arises because the application was filed very shortly

(a matter of days) after Mr Davis parted company with the BBC in circumstances which the parties have preferred not to bring out in the evidence. Thus it is suggested that Mr Davis did not have a bona fide intention to use the mark as required by Section 32(3). Allied to this it is said that Mr Davis' intention could only have been a contingent one. An issue may arise in this respect as to the interpretation to be placed on the requirement of a bona fide intention to use and whether it relates purely to the applicants' own beliefs at the time of application or whether it extends to situations where, notwithstanding the genuineness of the applicants' belief, his intentions can only be considered to be contingent ones. That is not an issue I need to decide here as I do not think either ground has been made out.

In the event Mr Gold accepted, I think, that Mr Davis' action in filing the action could be characterised as honest but misguided. That is also my view of the matter. The basis for Mr Davis' claim is well documented in his evidence. It reflects what I consider to be a genuine and strongly held belief on his part that he was entitled to the mark and could apply for registration. The fact that I have concluded otherwise does not undermine his position in this respect.

I have not recorded in the evidence summary Mr Davis' lengthy explanation of the steps he has taken to develop a community radio station. Suffice to say that he exhibits correspondence relating to funding and training for the project along with a letter from The Radio Authority. It is said that he has sought and obtained a short term restricted licence.

In the light of these activities I am not prepared to say that the objection under Section 3(6) relating to the applicant's intentions to use the mark have been made out.

The remaining ground of opposition is under Section 5(4)(a). This reads:

“(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
- (b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

The necessary elements of an action for passing off in terms of goodwill, misrepresentation and damage, were set out by Geoffrey Hobbs QC in WILD CHILD trade mark 1998 RPC 455. I do not propose to repeat the very full guidance provided but it can be found in that decision commencing at page 460 line 5 to page 461 line 22.

In brief the necessary elements are said to be as follows:

- S** that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

5 S 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

 S that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

10 It follows from my decision under Section 3(6) that I regard any goodwill that is established in BLACK MIX (or those words in association with some reference to the BBC) as belonging to the opponents.

15 I should say at this point that the opponents filed further evidence shortly before the hearing. This was admitted into the proceedings. It consists of a statutory declaration by Nicholas George Foot, a lawyer with the BBC who has the conduct of this matter. His evidence goes to a number of issues. Firstly he confirms that the BBC has continued to broadcast the programme since Mr Davis' departure (Ms Reid had already made the same point) and has no plans to discontinue it. He also refers to enquiries made by unnamed BBC employees directed towards whether the applicant had used the mark BLACK MIX. In the context of the
20 opponents' claim under Section 5(4)(a) he provides audience figures for the period 1 January 1998 to 23 December 1999. Mr Foot says that this evidence is to be read in conjunction with Ms Reid's declaration and in particular paragraph 4 thereof (see below). I indicated at the hearing that, given the material date in these proceedings of 14 September 1996 I did not consider that I could give any weight to this part of Mr Foot's declaration (WILD CHILD
25 Trade Mark, 1998 RPC 455 at page 459 line 50 et seq confirms that I must consider the position at the date of application for registration).

30 The BLACK MIX programme was first broadcast in January 1995. According to Ms Reid (and confirmed by AFHR1) the programme has always occupied a weekend mid-evening slot. At first it was broadcast on a Saturday evening for half an hour but in the Autumn of 1995 the programme moved to Sunday evenings and was extended to two hours. That in itself might suggest that the programme had achieved a measure of success.

35 Ms Reid says (in her paragraph 4 referred to by Mr Foot):

40 "4. The local radio station BBC THREE COUNTIES RADIO forms part of a well established network of BBC local radio stations extending throughout the United Kingdom, which supplements the BBC's five national radio stations and two national television channels. It was estimated in 1994 that the total adult population in the geographical area reached by BBC THREE COUNTIES RADIO broadcasts was approximately 970,000 adults, of which approximately 20,000 were of African Caribbean origin. It is estimated that about 132,000 people listen to BBC THREE COUNTIES RADIO broadcasts each week."

45 Ms Reid goes on to say that she "would have expected listeners to the BBC's BLACK MIX programme to have included a significant proportion of the African Caribbean community in the area reached by the broadcasts...". The basis for this claim is not explained.

Mr Poore made a number of detailed criticisms of the opponents' position in this regard. It seems from Mr Foot's evidence that, as one might expect, information is collected on audience levels. However, the above quoted evidence from Ms Reid falls some way short of providing the sort of information that might assist the opponents. The figures she quotes appear to pre-date the launch of the programme. Overall listening figures are given and the size of the main target audience (the African Caribbean community) has been identified but there is no indication as to how many people (African Caribbean or otherwise) listened to the BLACK MIX programme at any time up to the relevant date.

Both sides have included in their evidence a small number of press cuttings which suggest that some publicity was achieved for the programme. There is also the BBC's reply to a listener's letter (that of J* Lani Levi Gabre -Leul at AFHR9). It might also be said that, for Mr Davis to be able to claim that he was widely associated with the programme and that he promoted the programme, the programme must have achieved some level of recognition amongst the relevant section of the public. However, this is a rather thin basis on which to reach a finding that the opponents had goodwill in BLACK MIX or a sign incorporating that element.

I accept that it is in the nature of broadcasting that programmes can become known very quickly just as the launch of a new newspaper is likely to attract instant attention. But, even allowing for this, the evidence falls some way short of establishing the opponents' position. It seems to me that Mr Foot's evidence was a belated attempt to flesh out the BBC's case. For the reasons given earlier I am not prepared to give any weight to audience figures after the relevant date. In any case those figures point to wide fluctuations in audience levels and significant growth only from the second quarter of 1999 onwards. This suggests that I should only accept that the programme and title had achieved a significant level of recognition if the opponents had supported that claim in evidence. As the opponents have failed to progress their case beyond generalised claims the opposition fails under Section 5(4)(a).

As the opponents have been successful in relation to the proprietorship point they are entitled to a contribution towards their costs. Mr Poore asked me to take into account the breadth of the grounds claimed and the fact that not all of the grounds had been pursued. He also pointed to an interlocutory hearing decided in the applicants' favour. There may be some slight basis for the first of these claims though Mr Davis' 'overview' comments in his declaration suggest that the main issues to be addressed were by that time not in doubt. I do not think the opponents' behaviour in relation to the interlocutory hearing was unreasonable and they appear to have acted with reasonable expedition in their conduct of the proceedings. I order the applicant to pay the opponents the sum of £735.

Dated this 16 day of February 2000

M REYNOLDS
For the Registrar
the Comptroller General