

O/276/12

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2546226
IN THE NAME OF SILVER BULLET CARAVANS LTD
IN RESPECT OF THE FOLLOWING SERIES OF THREE TRADE MARKS:**



IN CLASSES 12 AND 37

AND

**AN APPLICATION FOR DECLARATION OF INVALIDITY THERETO
UNDER NO 83939
BY THOR TECH INC**

BACKGROUND

1) Silver Bullet Caravans Ltd (“the proprietor”) is the proprietor of registered mark 2546226 for the marks shown on the cover of this decision. The registration is in respect of the following goods and services:

Class 12

Caravans and parts and fittings for caravans.

Class 37

Caravan conversion.

2) It was applied for on 27 April 2010 and it completed its registration procedure on 6 August 2010.

3) On 13 December 2010, Thor Tech, Inc (“the applicant”) applied for the above registration to be declared invalid. The applicant claims that the proprietor’s mark offends against Section 3(6) and Section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In respect to the ground based upon Section 3(6), it claims that customers, fans and media have referred to its AIRSTREAM branded trailers (in this decision, the term “trailers” is used interchangeably with “travel trailers”, “caravans” and motor homes” and relate to the same “mobile home” type goods) as SILVER BULLET trailers since the 1950s and that the proprietor was aware of this because it sells second-hand AIRSTREAM trailers. Further it claims that it is inconceivable that the proprietor was not aware of the reputation and goodwill in its mark AIRSTREAM, the reputation and goodwill attached to the highly distinctive and famous shape, design and appearance of its trailers and the strong association of the words SILVER BULLET with the applicant’s AIRSTREAM trailers. It claims that, therefore, the proprietor acted in bad faith in its adoption of the silhouette device of an AIRSTREAM trailer and the words SILVER BULLET.

4) The applicant also claims that by 27 April 2010 (the filing date of the contested registered mark) the applicant had established a goodwill and reputation in the UK “in the name SILVER BULLET” in respect of trailers, caravans and motor homes with the name being used since at least 1953. Once again it also cites the fact that the device element of the proprietor’s mark replicates the shape of the applicant’s AIRSTREAM trailers. Consequently, it claims that the registration offends under Section 5(4)(a) of the Act.

5) The proprietor filed a counterstatement denying that the AIRSTREAM trade mark or the applicant’s aluminium-body trailers, caravans and motor homes have acquired substantial recognition, fame or goodwill or that they are highly distinctive in the UK. It admits to manufacturing and selling its own trailers under the contested mark and denies that the device element of its mark replicates the applicant’s AIRSTREAM trailer.

6) Both parties filed evidence and both also seek an award of costs. The matter came to be heard on 2 May 2012 when the proprietor was represented by Mr Benet Brandreth of Counsel, instructed by Boulton Wade Tennant and the applicant was represented by Ms Denise McFarland of Counsel, instructed by Keltie LLP.

EVIDENCE

Applicant's Evidence

7) This takes the form of four witness statements. The first of these is by Mr Martin Cranshaw, an associate at Samuelson Wylie Associates, appointed by Airstream Europe Limited to manage its public relations activities, for which he has had responsibility since August 2008.

8) At Exhibit MC1 he provides a copy of a press release dated 15 January 2009 entitled "Iconic American Brand Announces European Push". Mr Cranshaw explains that this was sent at the end of January 2009 to national newspapers, magazines and other contacts. He estimates that it reached 150 outlets. The press release talks about "the iconic aluminium "silver bullet" travel trailers" and that they had "been around since 1931". It notes that "it is only now that European buyers can buy trailers designed specifically for our narrow and twisty roads...". It states that the "aircraft inspired aluminium bodies has scarcely changed over the last 78 years". Further information it provides includes detailing three models, one of which is made to the maximum dimensions permitted on UK roads, that dealers have already been appointed in the UK and starting prices in pounds sterling.

9) The second witness statement is by Mr Michael Hold, Sales Director of Airstream Europe Limited. He explains that his company is a licensee of Airstream, Inc and that Airstream Inc and Thor Tech, Inc are wholly-owned subsidiaries of Thor Industries, Inc. with the applicant owning all the marks used by Airstream Europe Limited including Community Trade Mark (CTM) 3027703 for the word mark AIRSTREAM.

10) Mr Hold's statement can be summarised in the following points:

- Airstream Europe Limited and Airstream, Inc (together "Airstream") are the manufacturers of trailers, caravans and motor homes sold under the AIRSTREAM mark.
- This mark has acquired substantial recognition, fame and goodwill on a global scale and was first used in the USA in 1932. The highly distinctive design of the applicant's aluminium bodied trailers, caravans and motor homes has reached iconic status throughout the world, including the UK. In addition, Mr Hold states that the applicant is the owner of the reputation and goodwill in the name SILVER BULLET through widespread global use of the words by the media and other third parties when referring to the applicant's goods.

- Airstream has acquired substantial reputation and goodwill in the design and shape of its trailers as depicted in the device element of the contested application. In support of this claim, Mr Hold provides, at Exhibit MH5, an extract from the book “Wanderlust: Airstream at 75”, that includes the following:

“The “Silver Bullet”, as aficionados began to call the Airstream, turned up in a few movies and in 1959-60 co-starred in a television *Troubleshooters*”

And;

“Although Costello sought ways to improve the engineered product, he did not tinker with its fundamental design. In June 1964 the board of directors passed a motion not to stray from Airstream’s “product image”, which included “overall shape and color denoting product identity, equipment and system usage to provide the „means to the dream’, and the completeness of design and thought to the use of the product”, according to minutes from the meeting. The silver bullet would remain the silver bullet”

- the term SILVER BULLET has no meaning within the industry other than being a reference to the applicant’s AIRSTREAM trailers.
- A trailer called the SILVER BULLET was produced in 1934;
- AIRSTREAM trailers were first offered for sale in the UK in 2005 and the first trailer sold in June 2006;
- Public awareness in the UK was generated in the 1950s when “Airstream caravans” were first organised as a way for AIRSTREAM enthusiasts to see the world with like-minded people. The 1956 “Caravan of Europe” covered the whole of Europe and the “Around the World Caravan” of 1964-65 covered 34,000 miles including the UK. An account of this appeared in the international publication National Geographic Magazine in June 1957 and is provided at Exhibit MH3. The book “Wunderlust: Airstream at 75” records on page 193 that the caravan came to England in 1960;
- Aficionados began calling the AIRSTREAM trailer the SILVER BULLET.
- Airstream trailers have also been featured regularly in Hollywood movies released in the UK and featured in a television series called “Troubleshooters” in 1959/60.
- An AIRSTREAM trailer featured in the movie “The Right Stuff” (1983), a dramatisation of the first voyage to the moon. The trailer was used by the astronauts who spent their first hours back on Earth (in 1969) in quarantine in the trailer;
- AIRSTREAM trailers appeared in other movies, namely “Independence Day” (1996), “Raising Arizona” (1987), “What’s Eating Gilbert Grape” (1993), “Space Cowboys” (2000), “Mars Attacks” (1996), “Airstreamers” (1998), “Charlie’s Angels” (2000), “American Odyssey” (2000), “Leaving Normal” (1992) and “A perfect World” (1993). At Exhibit MH4 are extracts from www.amazon.co.uk illustrating that some of these movies are available to purchase in the UK.

- An AIRSTREAM trailer appeared in further US TV shows in 2004 and 2005;
- A “vast number” of books have been published relating to the AIRSTREAM trailer. Exhibit MH5 is copies of pages from www.amazon.co.uk showing eleven publications for sale;
- AIRSTREAM trailers have received regular attention in UK national and trade publications and a selection of articles are provided at Exhibit MH6. These include an article, published in December 2003, from Caravan Industry and Park Operator which recognises the AIRSTREAM trailer as a “modern day icon” and a page from www.vintagevacations.co.uk, dated 12 January 2009, recounting how the business idea came about when the owner bought a 1965 AIRSTREAM trailer through *EBay* and arranged to have it shipped over from the USA.
- UK prices for the AIRSTREAM trailer range from approximately £35,000 to £55,000 compared to under £20,000 for standard caravans;
- Whilst initially marketed in the USA and Canada only, second hand AIRSTREAM trailers have, for many years, been imported to the UK and there is a many companies (including the proprietor) within the UK in the business of renovation and conversation of vintage AIRSTREAM trailers;
- AIRSTREAM trailers have been marketed in the UK since February 2005, with the first sales being made in June 2006. Since then approximately 90 have been sold. Turnover and marketing spend has been:

Year	Turnover (£)	Marketing Spend (£)
2006	92,000	55,000
2007	1,092,000	19,000
2008	1,272,000	23,000
2009	1,596,000	29,000
2010	2,041,000	36,000
2011 (estimated)	2,250,000	40,000

- Sixteen invoices to UK addresses supporting these sales are provided at Exhibit MH7 and are dated between 30 June 2006 and 9 March 2011;
- Marketing spend has been mainly on attendance at shows and events;
- Advertisements for AIRSTREAM trailers have appeared in a number of UK publications. An example of which is provided at Exhibit MH8 and Mr Hold states that it appeared in *Aga Magazine* in February 2008;
- Merchandising in the form of goods in the shape and style of the AIRSTREAM trailer have been produced. A copy of a licence agreement with a UK company, Swineside Teapottery is provided at Exhibit MH9 and dated in August 1998;
- Historically, the name SILVER BULLET has been adopted by the media and public to refer to aluminium AIRSTREAM trailers and first coined in the USA as early as 1937. Examples of use of the phrase SILVER BULLET by the media in the UK is provided at Exhibit MH10. This consists of 24 articles dated between April 1998 and January 2011. These show the term SILVER BULLET used in one of three ways, either to describe a particular model of AIRSTREAM trailer, more generally to describe AIRSTREAM trailers or in a fanciful descriptive way as evidenced by the *Evening News* article of 4 January 2006: “We saw a few

along the way, these silver bullets in the desert, shining against the spectacular scenery...”;

- Exhibit MH11 provides extracts from 29 UK websites, being examples of the references to SILVER BULLET in relation to AIR STREAM trailers. These include:
 - www.elitechoice.org: refers to the Airstream trailers as “popularly known as the Silver Bullet”, “lovingly called the Silver Bullet”. It is indicated on the page that the articles where these references occur were published in March and April 2009. Adverts visible on these pages appear to relate to UK businesses but the purchase price of Airstream trailers is provided in dollars;
 - www.airstreamholidays.co.uk: promotes a trailer holiday in Cornwall, it refers to “The iconic, retro Airstream “Silver Bullet” trailer” when describing its accommodation. The extract was printed on 25 October 2010;
 - www.touringandtenting.com: Undated. Carries an advert for Airstream Europe (giving an address in Cumbria) that states “this unique range of iconic “silver bullet” travel trailers are perfect for chasing dreams...”;
 - www.uniqueto.co.uk: An article dated 5 May 2010 entitled “Brighton’s Airstream Alfresco” states “You can now hire the most fantastic mobile catering with this iconic silver bullet 1967 Airstream” together with a photograph of an Airstream trailer converted into a catering trailer;
 - www.caravantimes.co.uk: An article promoting Airstream caravans and providing the contact details for Airstream Europe Limited in Cumbria and carries a 2010 copyright notice. A section discussing the construction of the trailers is entitled “The Silver Bullet”. Below a picture of a display of Airstream caravans is the caption “Airstream Caravans bring the iconic „silver bullet’ to the UK” and the text “For over 75 years Airstream have been producing these iconic „silver bullet’ tourers exclusively for the American market. But now, Continental fans of Airstream Caravans can chose from a range models specifically engineered to European standards”;
 - www.vintagecamper.co.uk: a page about Airstream states “The Airstream is easily recognisable for its rather distinctive rounded aluminium body – the iconic “silver bullet”. The only indication of date is the date it was printed, namely 25 October 2010;
 - www.independent.co.uk: an article, dated 4 February 2001 about an American band named Shivaree quotes one of the band members as saying “My mother’s mother lived in a big Airstream silver bullet trailer...”;
 - www.thecoachcoach.org: includes the quote “I was on holiday in the Lake District and took a chance opportunity to visit Airstream Europe in Penrith. They sell Airstream accommodation trailers – the iconic American silver bullet caravans...”. This was printed 25 October 2010;
 - www.foodpedia.co.uk: dated 2 September 2010, states that two chefs “will be personally touring London in a specially adapted Airstream trailer, the legendary silver bullet of American 50’s films...”;

- www.decogirl.co.uk: printed on 25 October 2010 is an article entitled “vintage vacations” offering “unique holidays on the beautiful Isle of Wight in original 1950’s & 60’s American Airstream trailers. Sympathetically restored, these amazing silver bullet trailers are furnished in period style...”
- www.halford.com: an article dated 16 June 2009 and entitled “American marque adapts caravan for European market” . Talking about the Airstream trailer it states “Often nicknamed the “silver bullet”, some camping enthusiasts may know the versions of the vehicle from US road films in the 1950s and 60s”;
- www.safeguarduk.co.uk: an article dated January 2009 announces that Airstream motor homes are coming to the UK and states “The classic US motorhome firm, which has been making the „silver bullet’ design motorhomes for 78 years, is set release a new range”;
- www.caravanselecta.co.uk: An advertisement, printed on 25 October 2010, for an “Airstream Excella 6.2 Diesel Motorhome Classic American icon this is a 31ft silver bullet...”;
- www.campsiteuk.co.uk: an advertisement for Airstream Europe Ltd in Cumbria, printed on 25 October 2010, promoting its trailers thus: “This unique range of iconic silver bullet travel trailers are perfect for chasing dreams, pursuing the moment and enjoying a broad, expansive vision of life”;
- www.aluminium.org: The Aluminium Association announces on its website that “Airstream: Iconic American Trailers Tailored for Europe”. And goes on to state: “St Albans, England, January 29, 2009 – Classic Driver (UK) – There is something unreservedly American about the look of these aluminium „silver bullet’ travel trailers...There are three trailers in the range ...[one] being built to the maximum permissible external dimensions for use in the UK...”;
- www.caravanguard.co.uk: in an article, printed 25 October 2010 and entitled “Beginners Guide to Caravanning – Choosing the right caravan” it states “Looking to turn heads on the campsite? Then look no further than the American Airstream range of silver bullet caravans. Airstream now produce a European spec caravan that has proved popular with celebrities and young professional types”;
- www.stepinsidedesign.com: an article dated May/June 2006 states “Wally Byam, the founder of Airstream, Inc., once said, “Let’s not make any changes – let’s make only improvements.” This philosophy has been one of the main reasons these iconic “Silver Bullet” trailers have become part of the American vernacular...”;
- www.classicdriver.com: an article dated 29 January 2009 and entitled “Airstream: Iconic American Trailers Tailored for Europe” states “There is something unreservedly American about the look of these aluminium „silver bullet’ travel trailers...”. It goes on to give prices in pounds sterling and provides a contact details of Airstream Europe’s .co.uk website address;

- www.europeanmotornews.com: In an article dated 19 July 2010 it states “Hollywood movie star and Airstream owner Andy Garcia was enthusing about his 34 foot “silver bullet” trailer, in reply to which Jeremy [Clarkson – presenter of the BBC’s Top Gear television programme] openly admitted that Airstreams “look very good”.
- At Exhibit MH12, Mr Hold provides a copy of the homepage of Airstream Europe’s website referring to “This unique range of iconic „silver bullet’ travel trailers...”. Mr Hold states that such a reference has been on this page since the website went active in February 2006.
- There is a very strong association between the mark AIRSTREAM, the term SILVER BULLET and the design of the trailer. At Exhibit MH13, Mr Hold provides a photograph of an AIRSTREAM Bambi Travel Trailer that was installed in the Museum of Modern Art in New York in April 2007. Articles have likened its design to the status of the design of the Coca-Cola bottle.
- Exhibit MH15 is copies of pages from the proprietors website, dated 14 September 2010 and showing its mark and also stating “Silver Bullet Caravans Ltd was established to carry out a wide range of conversion work on vintage aluminium American caravans – our work has predominantly involved the Airstream brand” and “As part of our continuing research and development work, our craftsmen have designed a range of own-brand Silver Bullet caravans...” Mr Hold contends that these are AIRSTREAM replicas. The banner menu that appears down the left hand side of the page includes the heading “About Airstream Caravans”. Mr Hold points out that printouts shown at Exhibit MH18, printed 11 April 2011 have this heading removed.
- The proprietor sells second-hand AIRSTREAM trailers as evidenced by a copy from its website shown at Exhibit MH19 and dated 15 November 2010.
- The proprietor’s home page has been amended to include a statement “to the effect that Silver Bullet Ltd has no affiliation or connection whatsoever with any other caravan manufacturer”.

11) In a second witness statement, Mr Hold provides further extracts from Airstream Europe’s website, obtained from www.archive.org illustrating that in 2006 the term SILVER BULLET was being used on the website. These are exhibited at MH20 and the oldest of these, dated 6 May 2006“, states “And Airstreams are everywhere! Not only on roads around the world – but in magazines and on television too. With the rising popularity of trailer and motor home travel and consequent surge of enthusiasm for our own iconic „silver bulletin’, we have more new product development...”

12) I final witness statement is by Nikki Nichol, Head of Publicity and Industry Relations at The Caravan Club, the leading UK organisation for caravan owners. Ms Nichol states that in November 2003, she wrote a press release relating to an announcement that the club had been working with Airstream to bring its trailers to the UK. A copy of this press release is provides at Exhibit NN1 and states “The media have always shown great interest in the „Silver Bullets’ as they [Airstream caravans] are know”. In her statement, Ms Nichol adds “As far as I’m aware, the term „Silver Bullet’ in relation to caravans and

trailers means the aluminium-bodied trailers and caravans of Airstream and has no other significance in relation to caravans and trailers”.

Proprietor’s Evidence

13) This takes the form of a number of witness statements. The first of these is by Richard John Spratley, Director of the proprietor company. Mr Sprately states that he has been aware of the existence of AIRSTREAM travel trailers since the early 1980s but he has not been unaware of the term SILVER BULLET being used to describe them, or other trailers “until Peter Carrick, whom I have known since 2003, formed Silver Bullets Imports in 2007”.

14) A second witness statement is by Peter Graham Carrick, Managing Director of Silver Bullet Caravans Ltd. He explains that the company was formed in December 2009 and before that he was the proprietor of Silver Bullets Imports which was formed in 2007. He states that as part of his investigations when setting up Silver Bullet Imports he became aware that the term “silver bullet” had been used in respect of more than a dozen different brands of aluminium caravans produced in the USA during the 1940s, 50s and 60s. Such brands included Avion, Curtiss-Wright, Streamline, Silver Streak, Yellowstone, Spartan, Boles Aero, Vagabond and Bowlus-Teller.

15) Mr Carrick states that his inspiration for his company logo came from the cover of a book entitled Silver Palaces.

16) Following the formation of Silver Bullets Imports, in early 2008, Mr Carrick states he had a discussion with Mr Hold (regarding axle manufacturers in the UK), but at no stage did Mr Hold indicate any objection to his use of “Silver Bullet” as part of his company name.

17) Mr Carrick explains that he was joined by Mr Spratley and they formed a new company (the proprietor company) in December 2009. Before applying for the contested mark they conducted searches in the UK and the USA and found no caravan companies using the name.

18) He denies that the public have been misled, always making it clear that the proprietor’s SILVER BULLET caravans are hand built in the UK by an independent company and that, to this end, posted a bold disclaimer on its website, stating that the proprietor had no affiliation to Airstream Inc or the applicant. He is unaware of any confusion.

19) In response to Ms Nichol’s witness statement, Mr Carrick provides, at Exhibit PGC2, extracts from the website www.abiandfriends.org dated 12 February 2008, a collaboration between a one-time major UK caravan manufacturer and a caravan club, where it states “At Earls Court in 1981, the ABI Tycoon, a silver bullet-styled tourer...”. He is not aware of any actual confusion despite being well placed to detect any as he handles his company’s sales enquiries.

20) At Exhibit PGC3, to illustrate that not only AIRSTREAM trailers are known as “Silver Bullets”, Mr Carrick provides an extract from the website of David Janssen, star of the 1960’s programme “The Fugitives”. It is headed “lost and found: the Silver Bullet” and recounts how Mr Janssen was presented with a 30 foot motor home in Los Angeles in 1965 and states “it was manufactured by the now-defunct Streamline Trailer Company, a small manufacturer based in El Monte, CA...”. At Exhibit PGC6, a 1964 Avion Travel Trailer is advertised for sale in Canada on the website www.muskoka.kijiji.ca.

21) Exhibits PGC4 and PGC5 are copies of advertisement for 1983 and 1984, respectively, Avion Silver Bullet travel trailers, both with a sales prices in dollars.

22) At Exhibit PGC7, Mr Carrick provides an extract from www.airstream.com where the book entitled “Wanderlust: Airstream at 75” is described as “Our 75th Anniversary Book”. Mr Carrick contends this illustrates that the book was commissioned by Airstream and is not an impartial source of reference.

23) Mr Carrick notes that the applicant has sold about ninety caravans in the UK. He contrasts this with figures from the National Caravan Council that show that total UK sales of caravans between July 2010 and July 2011 was 24,659.

24) Mr Carrick states that he is familiar with editorial styles, practices and policies and claims that much of the “published evidence” from UK newspapers and magazines submitted by the applicant can be traced to self generated PR.

25) Mr Carrick submits a second witness statement where he states that on 25 August 2011 he met a prominent Airstream dealer based in Europe who stated to him that he had never heard of the trade mark SILVER BULLET being used in relation to caravans/trailers until he came across the proprietor’s website.

Applicant’s evidence in reply

26) This is in the form of a further three witness statements. The first of these is by Mark Wahl, Senior Vice President of Operations of Airstream, Inc. Mr Wahl explains that he worked for Avion Coach Corporation (“Avion”), a company that manufactured travel trailers. Avion was acquired by Fleetwood Enterprises, Inc. (“Fleetwood”) in 1976 and Mr Wahl was employed by them between 1976 and 1995. He states that Fleetwood ceased to produce aluminium trailers in the early 1990s and never manufactured trailers for sale outside the USA or Canada. He is unaware of Avion trailers were known by reference to the name “Silver Bullets”, but was aware that personnel at Avion occasionally referred to Airstream trailers as “the Silver Bullet”.

27) The second witness statement is by Anthony Slocock, Technical Director of Airstream Europe Limited. He exhibits an email chain involving himself, a Paul Stapleton and a lady named “Margaret”. “Margaret” was complaining about structural problems with a caravan from the proprietor but was referring to it as an American

Airstream. Her description resulted in her being put in touch, in error, with Mr Slocock who informed her that she would need to contact the proprietor as the caravan was not an AIRSTREAM.

28) Mr Slocock also asserts that the term SILVER BULLET is a reference to AIRSTREAM trailers as evidenced by a new book entitled "My Cool Caravan" that contains a chapter dedicated to Airstream trailers and is entitled "Silver Bullets". The book was published in February 2009 and has sold 40,000 copies. He exhibits a page from this book at AS2 and the chapter begins with the words "„One of those Silver Bullet things' is usually how people identify these American design icons. Most people will recognise Airstreams from their streamline shape and shiny aluminium exterior..."

29) The third witness statement is a further statement by Mr Hold. He states that the device of the silhouette resembles that of an Airstream Caravanner as shown on page 53 of the book Silver Palaces and shown at Exhibit MH21 and reproduced below:



30) Mr Hold comments on all the companies cited by Mr Carrick as building "Silver Bullet" trailers. In short, there is no evidence that they were referred to as "Silver Bullets", all have ceased production of such caravans, some as early as 1949, but none any later than 1997.

31) Mr Hold explains that the reason he did not object to Mr Carrick's use of SILVER BULLET in their telephone conversation is because, at that time, Mr Carrick was only renovating AIRSTREAM TRAILERS. Airstream would have objected strongly if Mr Carrick had indicated he was to use SILVER BULLET in respect to the manufacture of replica AIRSTREAM trailers.

32) Mr Hold states that the book "Wunderlust: Airstream at 75" does represent an impartial view and that, further, it has been published and sold in the UK.

33) At Exhibit MH26, Mr Hold provides a copy of a page from the website www.caravantimes.co.uk, dated 30 June 2011 where it is announced that the proprietor is relocating. Under the heading “Silver Bullet Caravans relocates to Kidderminster” is text that includes the statement “Previously based in the nearby town of Stourbridge, the company makes fifties-style polished aluminium caravans and commercial trailers based around the original Airstream designs” and “Silver Bullet’s retro American styled tourers start at just 16-feet in length, in a design based around the iconic Airstream Bambi caravan.” The same page contains a number of “related links”. The two shown are both links to articles about Airstream trailers with one heralding that “Award-winning Airstream caravan gets revamp” and goes on to state that “The latest version of the Airstream Series 2 International 684 has been unveiled and this tourer has quite a reputation to live up to. Chris Jefferies takes a look at the new Silver Bullet.”

DECISION

The legislation

34) The case has proceeded to final determination on the basis of Section 5(4)(a) of the Act. I shall not detail Section 3(6) here for reasons that will become obvious. These grounds are relevant in invalidation proceedings in view of the provisions of Section 47(2) of the Act. The relevant parts of Section 47 of the Act read as follows:

“**47.** - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

[...]

(2) The registration of a trade mark may be declared invalid on the ground-

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

Section 5(4)(a)

35) It is common ground between the parties that this is the primary ground of opposition. The rights identified under Section 5(4)(a) are:

“5. – [...]

(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.”

36) The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

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

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

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

The Relevant Date

37) First I must determine the date at which the applicant’s claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

38) With this guidance in mind, the material date in the current proceedings is the date the proprietor filed for its mark, namely 27 April 2010. The earlier right must have been acquired prior to that date (Article 4.4(b) of First Council Directive 89/104 on which the UK Act is based). The position at an earlier date may also be relevant. It could establish a senior user status, or that there has been common law acquiescence or that the status quo should not be disturbed as the parties have a concurrent goodwill (*Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42).

Goodwill

39) It is not disputed that the applicant enjoys a longstanding goodwill identified by the mark AIRSTREAM in respect to trailers. However, where the views of the parties diverge is on the question of whether or not the applicant's goodwill is also identified by the sign SILVER BULLET. The proprietor has made statements to the effect that SILVER BULLET is merely used to describe the design and styling of the trailers and that such designs are also produced by others. It further argues that the term has never been used by the applicant in over 60 years of trading. On the other hand, the applicant submits that the sign SILVER BULLET is, and has been, used to identify what it describes as its "iconic AIRSTREAM trailers".

40) It is clear from the evidence before me that the applicant has been trading in the UK since 2006, some three years earlier than the filing date of the proprietor's mark. Mr Hold, at his Exhibit MH20, has provided evidence that the homepage of the website of the applicant's European licensee, Airstream Europe Limited, contained a reference to SILVER BULLET from the outset in 2006 (see paragraph 11 of this decision). This is the only use in evidence by, or on behalf of, the applicant.

41) However, there is nothing that I am aware of that indicates that goodwill can only be associated with a sign if it is used by the holder of that goodwill. However, I am guided by the comments Lord Macnaghten in *Inland Revenue Commissioners v Muller & Co.'s Margarine Ltd* [1901] AC 217, 223, HL:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation, and connection of a business. It is an attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

42) My reading of this is that provided the sign identifies goodwill that attracts custom to the business, then that is sufficient. There is no requirement that the holder of the goodwill also uses the sign that identifies that goodwill. Having concluded this, the use referred to by the applicant may illustrate that the sign SILVER BULLET functions to

identify its goodwill. Of course, this is disputed by the proprietor on the grounds that the term is used widely to refer to other aluminium trailer manufacturers. Consequently, it is necessary to look at this claim in more detail.

43) The proprietor identifies nine other brands (identified in my paragraph 14, above) of trailers that are also identified by the sign SILVER BULLET. Mr Carrick supports this contention with a number of exhibits. The first of these (at Exhibit PGC2) is a reference to a caravan that was first introduced in 1981 being described as “a silver bullet-styled tourer.” This is somewhat ambiguous because it is not clear whether it is a reference to being in the style of an AIRSTREAM tourer or a more generic description. Further it provides no information on the impact of the applicant’s claims, as they relate to the material date. The second (at Exhibit PGC3), relates to an actor being presented with a motor home in Los Angeles in the 1960s. Whilst the extract makes reference to SILVER BULLET, it in respect of what it describes as the “now-defunct Streamline Trailer Company”. This extract appears to relate to an incident that occurred in the USA and not the UK, some 45 years before the material date in these proceedings, and in respect of a trailer produced by a company that is no longer in existence. Consequently, it fails to demonstrate that SILVER BULLET is used to describe aluminium trailers more generally in the UK at the material date.

44) Similarly, Exhibits PGC4 and PGC5 are no more persuasive. These illustrate advertisements for 1983 and 1984, respectively, “Avion Silver Bullet” travel trailers. The advertisements relate to second hand trailers dating from the 1980s. Further, the prices are shown in dollars. It is clear that these advertisements were not targeted at the UK and, therefore, fails to demonstrate how the term SILVER BULLET is perceived in the UK at the material date.

45) At the hearing Mr Brandreth submitted that there is evidence that UK purchasers of trailers buy in USA and ship them across (Exhibit MH6 to Mr Hold’s first witness statement illustrates one example of this). Whilst I have no information regarding the scale of such activity, I accept that it occurs. After all, Mr Carrick’s original business involved refurbishing such imported trailers. Yet it remains a further leap, and one that I am reluctant to make based on the evidence before me, that firstly, SILVER BULLET is used descriptively in the USA, and secondly, the UK consumer is aware of this alleged descriptive use.

46) The applicant counters the proprietors argument by providing historical information about the companies referred to by Mr Carrick, stating that they all ceased production of such caravans variously between 1949 and 1997. I also note that all of these companies appear to be American. These points raise doubts over whether the information provided by Mr Carrick demonstrates the position in the UK at the material date.

47) Taking all of the above into account, I conclude that the proprietor’s evidence fails to demonstrate that, in the UK, the term SILVER BULLET is understood to refer to a generic style of trailer.

48) Having concluded this, I move on to consider the applicant's claim to goodwill. Mr Carrick draws attention to the fact that the applicant has only sold 90 trailers in the UK compared to the whole caravan market where 24,659 units were sold in the year ending July 2011. I note this, but it is well established that goodwill can be created from a small level of trading (see, for example, *Stannard v Reay* [1967] RPC 589). I must consider all the relevant facts when considering if the applicant has the requisite goodwill. At the hearing, Ms McFarlane submitted that the evidence provided by Ms Nichols, representing The Caravan Club, was particularly persuasive as it is "the industry speaking". Ms Nichols refers to a press release drafted by herself in 2003 when she referred to "the media have always shown great interest in the „Silver Bullets' as they [Airstream caravans] are known". Certainly this has some weight. Mr Hold provides numerous references to AIRSTREAM trailers being referred to by reference to the term SILVER BULLET by the general and motoring press. Mr Hold's Exhibit MH11 provides numerous examples of this that predate the filing date of the applicant's mark. A notable example of these is an article on the Halfords website from June 2009 that states that AIRSTREAM trailers are "Often nicknamed the "silver bullet"". However, other examples are less clear cut and whilst they refer to AIRSTREAM TRAILERS as SILVER BULLETS, the use could be as a description. For example, the Aluminium Association's reference to AIRSTREAM trailers where it states "There is something unreservedly American about the look of these aluminium „silver bullet' travel trailers..." Here, the reference to SILVER BULLET could relate specifically to AIRSTREAM or more generally to "aluminium „silver bullet' travel trailers". Nevertheless, the evidence does not demonstrate that, prior to the material date, there were any other traders in the UK selling this type of trailer. This increases the likelihood that the UK consumer will associate the term SILVER BULLET exclusively with the applicant's AIRSTREAM trailers.

49) Taking all of the above into account, I conclude that the applicant has goodwill in the UK and that this goodwill is identified by not only the sign AIRSTREAM but also the sign SILVER BULLET. For the reasons mentioned earlier, the evidence supplied by the proprietor does not disturb this finding. Mr Carrick's evidence does refer to a meeting with a prominent European AIRSTREAM dealer, however, this is hearsay evidence that carries little weight because the precise context of the dealer's alleged comments is unknown.

50) The proprietor did not use the mark prior to 2009 and consequently is clearly not the senior user. I am satisfied that the applicant's goodwill in the UK predated this, with its own website (that referred to the sign SILVER BULLET) being operational in 2006. Further, Ms Nichols' evidence relating to The Caravan Club's press release in 2003 is further evidence that AIRSTREAM trailers were known to consumers in the UK as SILVER BULLETs prior to Mr Carrick's first use.

51) Further, insofar as Mr Carrick may rely on use of the sign SILVER BULLET prior to 2009, I note that his business was originally one of renovating old AIRSTREAM caravans. Therefore, it is reasonable to assume that the use at that time, by his

company, of the sign SILVER BULLET was a reference to AIRSTREAM's trailers. I note that Mr Hold stated this as a reason why AIRSTREAM did not object to such use when in conversation with Mr Carrick.

52) In conclusion, I find that the applicant had the requisite goodwill in the UK at the material date of 27 April 2010, as identified by the sign SILVER BULLET.

Misrepresentation and damage

53) Having reached this conclusion, I must go on to consider if there has been misrepresentation and whether any such misrepresentation is such as to cause damage to the applicant. In this respect, I am mindful of the comments of Morritt L J in the Court of Appeal decision in *Neutrogena Corporation and Anr. V Golden Limited and Anr.* [1996] RPC 473 when he confirmed that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of the opponent's customers or potential customers would be misled into purchasing the applicant's products in the belief that it was the opponent's. Further, Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 HL, stated that the opponent must show that "he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill". It is sufficient if there is a misrepresentation that one business is associated with another (*Sir Robert McAlpine Ltd v Alfred McAlpine* [2004] RPC 36 at paragraph 19). Damage to goodwill may include reducing the exclusivity in a name by which the goodwill is known (*Taittinger SA v Allbev Ltd* [1993] FSR 641).

54) The proprietor's mark consists of the words SILVER BULLET encompassed within a silhouette device of a caravan. This device element does nothing to dispel any possible association with the applicant's goodwill. As McFarland submitted at the hearing, the silhouette is very similar to that of the applicant's trailers such as that shown in paragraph 29 above. This is clearly evident to me, and consequently, if the device plays any role it is one of heightening an association with the applicant's trailers.

55) Ms McFarland submitted that the font used in the proprietor's mark is identical to the applicant's use, whereas Mr Brandreth submitted that it is no more than a normal retro font. To my mind, it is not critical which of these two views is correct. What is important is that the font does not serve to put any distance between the sign identifying the applicant's goodwill and the proprietor's mark. The parties appear to be in agreement the type of trailers of interest to the parties are perceived as retro-styled with them being very popular during the 1950s and 1960s. The use of a retro-styled font, whether the same as used by the applicant or not, will primarily convey a message to the consumer that there is a retro aspect to the goods and services.

56) Taking account of the cost of trailers/caravans and in respect to the conversion of the same, it is clear that the purchasing act will be a considered one. Nevertheless, the use of SILVER BULLET by a party other than the applicant will lead the consumer to believe there is some business link between the two traders. This is because, in the UK

and in respect of caravans/trailers, the sign SILVER BULLET is synonymous with the applicant's goodwill and its trailers. An example of how such misrepresentation may occur is provided by Mr Hold, at his Exhibit MH26 where he provides an extract from www.caravantimes.co.uk. On the same page it refers to "Silver Bullet Caravans relocates to Kidderminster" and provides a link heralding the latest version of an Airstream trailer and states "Chris Jefferies takes a look at the new Silver Bullet." Reference to both the proprietor's business and the applicant's goods as SILVER BULLET on the same page will create confusion that is likely to lead to misrepresentation.

57) Further, an instance of confusion has been submitted by the applicant where a customer of the proprietor had bought one of its own caravans but was referring to it as an "American Airstream". Whilst a single instance such as this is rarely conclusive, it nonetheless illustrates the type of damage that can occur as a result of misrepresentation.

58) In conclusion, I find that use of the proprietor's marks in respect of caravans and conversion of caravans is likely to mislead the applicant's customers and potential customers into believing that the proprietor is associated with the applicant. The proprietor's efforts to avoid this by posting a disclaimer on its website stating that it has no affiliation to the applicant does not remove the likelihood of such misrepresentation for a number of reasons. Firstly, it was added after the material date and therefore cannot assist in these proceedings. Secondly, the proprietor may choose not to keep the disclaimer in the future, or may choose to sell his mark to another party who does not use the disclaimer. In such circumstances the alleged effect of the disclaimer will be lost.

Section 3(6)

59) In light of my findings above, it is not necessary for me to go on to consider the grounds based upon Section 3(6) of the Act.

Conclusions

60) I have found that the ground of invalidation based upon Section 5(4)(a) of the Act has been successful in its entirety.

Costs

61) The invalidation action having been successful, Thor Tech Inc. is entitled to a contribution towards its costs. I take account of the fact that a hearing has taken place and that both parties filed evidence. I award costs on the following basis:

Filing Notice of Invalidation & considering the other side's statement of case in reply	£500
Preparing and filing evidence and considering other side's evidence	£800
Preparation for, and attending hearing	£800
TOTAL	£2100

62) I order Silver Bullet Caravans Ltd to pay Thor Tech Inc. the sum of £2100. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated the 19th of July 2012

**Mark Bryant
For the Registrar
The Comptroller-General**