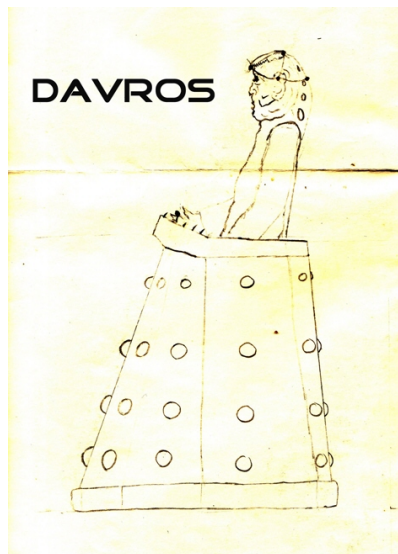


O-334-19

TRADE MARKS ACT 1994

**APPLICATION NO 502268 BY THE BRITISH BROADCASTING CORPORATION
TO REVOKE TRADE MARK REGISTRATION NO 2496785**



OWNED BY STEVEN E. CLARK

Background and pleadings

1. The trade mark shown on the cover page of this decision was applied for on 3 September 2008 by Steven E. Clark. It completed its registration procedure on 16 January 2009, was renewed on 3 September 2018, and stands registered for the following goods and services:

Class 9: Audio, video, still and moving images and data recordings in compressed and uncompressed form; computer software, including software for use in downloading audio, video, still and moving images and data in compressed and uncompressed form from a computer or communication network and organisation of data; downloadable electronic publications; computer, electronic and video games programmes and equipment; mouse mats; electronic instructional and teaching apparatus and instruments; television and radio signal transmitters and receivers; mobile telephone fascias and covers; and parts for all the aforesaid goods.

Class 16: Paper, cardboard and goods made from these materials; printed publications; magazines; books; pamphlets; printed guides; catalogues; programmes; photographs; stationery; artists' materials; paint brushes; instructional and teaching material; plastic material for packaging; printing blocks; posters; cards; postcards; greetings cards; trading cards; invitations; diaries; calendars; photograph albums; prints; paper and plastic bags; gift boxes; notepads; writing instruments and crayons; coasters; gift and luggage tags; ornaments of paper, card and papier mache; stickers; transfers; stamps; personal organisers; address books; note books; pen and pencil holders; desk mats; embroidery, sewing and knitting patterns; postage stamps, gift wrap.

Class 25: Clothing, footwear and headgear; articles of outer clothing; articles of underclothing; coats, jackets, suits, skirts, dresses, jumpers, pullovers, waistcoats, blouses, trousers, slacks, shorts, dungarees, shirts, t-shirts, sweatshirts, sweaters, smocks, hats, stockings, neck-ties, scarves, headsquares, gloves, aprons, slippers, shoes; jeans, caps, berets, tights, belts, socks, swimwear and beachwear, pyjamas,

nightdresses, bathing and shower caps, bath robes, bath sandals and bath slippers, clothing for babies and for toddlers, bibs, babies napkins of textile.

Class 38: Broadcasting; communications and telecommunications; transmission, broadcast and reception of audio, video, still and moving images and data whether in compressed or uncompressed form and whether in real or delayed time; electronic mail services; teletext services; news information and news agency services; rental of radio and television broadcasting facilities; [on-line services including the provision of discussion forums]; provision of information and advisory services relating to any of the aforesaid services.

Class 41: Provision of entertainment, education, recreation, instruction, tuition and training both interactive and non-interactive; production, presentation, distribution, syndication, networking and rental of audio, video, still and moving images and data whether in compressed or uncompressed form and whether downloadable or non downloadable; game services; production and rental of educational and instructional materials; publishing services (including electronic publishing services); exhibition services; organisation, production and presentation of shows, competitions, contests, games, concerts and events; language teaching; provision of language schools and language courses; provision of information and advisory services relating to any of the aforesaid services.

2. The British Broadcasting Corporation (“the BBC”) applied on 27 September 2018 to have the trade mark registration revoked under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”) on the following grounds:

(i) under section 46(1)(a) that there was no genuine use made of it in the first five years following the completion of the registration process, and there are no proper reasons for non-use; i.e. from 17 January 2009 to 16 January 2014, with an effective revocation date of 17 January 2014; and

(ii) under section 46(1)(b) that there was no genuine use made of it between 27 September 2013 and 26 September 2018, and there are no proper reasons for non-use; with an effective revocation date of 27 September 2018.

2. Mr Clark filed a defence and counterstatement, which were accompanied by Mr Clark's evidence. It was apparent to the Tribunal from the contents of the counterstatement that the defence was made on the basis of proper reasons for non-use, no evidence of use having been filed. This was communicated to the parties by the Tribunal when it served the defence, counterstatement and evidence on the BBC, on 6 December 2018.

3. The BBC is professionally represented by Burges Salmon LLP, whilst Mr Clark represents himself. Both parties filed evidence, including an amount of material marked "without prejudice". The BBC sought and was granted a confidentiality order in respect of such evidence (it has been admitted to the proceedings as privilege is considered waived having been relied upon by both sides, but is not open to public inspection). Mr Clarke also filed submissions in response to the BBC's evidence. Neither party has chosen to be heard. Both filed written submissions in lieu of a hearing. I have fully considered all the papers, emails and letters filed by both parties.

Mr Clark's evidence

4. Mr Clark's evidence concerns years of dispute which he states he has had with the BBC. Whilst it is clear from the content and tone that it has been a highly emotional matter for him, these are legal proceedings which must be decided objectively upon the basis of fact, the legislation and the legal authorities which bind me, and not on subjective opinion. I record here that I have fully considered all the evidence before me; however, I may not include all of the evidence in this summary if I do not consider it to be relevant to the issues I have to decide. Nor will I summarise content which may properly be regarded as opinion, rather than fact (although I may refer to opinions/submissions later, in the main body of this decision).

5. Mr Clark considers that he has been in dispute, on and off, with the BBC since 1975. Although not explicitly stated in his evidence, I gather from what is said in emails and a letter he sent to the Tribunal during the proceedings that he entered a comic book competition in 1972, with artwork of a character called Davros. A dispute ensued in the 1990s between the parties. Some ten years later the dispute reignited and Mr Clark states that, on the advice of an IP lawyer at the London University of Art, he applied for the trade mark registration, “[i]n good faith and to protect my IP rights which we were trying to resolve”. It seems that at some point in 2012, Mr Clark (on the advice of his then legal representatives) issued High Court proceedings against the BBC for breach of copyright, presumably in the drawn component of the contested registered trade mark. Mr Clark states that owing to the BBC’s witness by then having dementia (which Mr Clark disputes), the trial did not go ahead. It seems that negotiations between the parties subsequently took place, with an offer from the BBC, which is described by Mr Clark as follows:

“That no gagging [of Mr Clark] would take place, that I keep my memberships with my writing societies but not claim royalties for DAVROS and the cost of the reimbursement for the trademark was to [sic] “to be discussed later”. IN PRINCIPLE I agreed and affirmed that to the judge. I WAS NOT AGREEING A FINAL RESOLUTION OR THE ORDER, WHICH FOLLOWED. (Which I never received).

When the trademark assignment paperwork arrived saying I would assign the trademark for £1 “ONE POUND” I was very very annoyed and expressed so at Kempner’s. There was no order with it nor was I given one, so until recently was completely unaware of what was written, but I did have some Ideas from discussion I had with the BBC legal team, when I rang them to say I WAS NOT SIGNING ANY AGREEMENT OR TRANSFER.”

6. Mr Clarke states:

“THE BBC has known since 2008 that I applied and obtained the trademark. For good reason I could not use/transfer/sell/assigned/licence the trademark while in legal dispute with the BBC and they know and are fully aware of that.”

7. Mr Clark states that the legal dispute has not ended and in September 2018 he wrote to the BBC as six years had passed since his last attempt at resolving matters with them. Mr Clark explains that the trade mark registration was due for renewal. He renewed it at the Intellectual Property Office and states that, a few weeks later, re-opened contact with the BBC by email to end the dispute. The contents of the emails are subject to the confidentiality order. It suffices to note here that they are in the nature of correspondence between parties who are in dispute with each other. For reasons that I will come to, they do not assist in determining the outcome of these proceedings.

8. Mr Clark refers to the revocation action and the pleaded dates, stating:

“They have applied dates to the strike out process, which they know to be entirely wrong. They are fully aware that I could not use or enter into any arrangement for the trademark for the entire periods, whilst I was/am in dispute with them Or at least until this year when they rejected my attempt to resolve this. So effectively the 5-year clock started this year and has now stalled again. Or ended 3 years from May2012 so the 5 year clock has 2 years left, or 6 years from May2012 as it is IP related and clock started in May 2018!!”

The BBC’s evidence

9. I start by noting that these proceedings concern whether the contested trade mark has been put to genuine use in relation to the goods and services for which it is registered, or whether there are proper reasons for non-use. The dispute is not about who has the relative rights to the trade mark. That being the case, although I will not go into the finer detail about the legal dispute, I will summarise those facts which I consider put the issues to be decided in these proceedings into context.

10. The BBC's evidence comes from Alexis Hawkes, a solicitor and Head of Intellectual Property at the BBC. Ms Hawkes refers to the famous UK television series, "Doctor Who"; in particular, the 12th series, planned in 1974 and broadcast in 1975. Two of the episodes introduced a character named Davros as part of six episodes about the "Genesis of the Daleks." Ms Hawkes states that the storyline was an independent literary work written by Terry Nation, in or about early 1974. Mr Nation wrote the Doctor Who scripts for these six episodes. Mr Nation was the first owner of the copyright in the storyline and scripts. He died in March 1997 and the copyright belongs to his Estate.

11. Exhibit AKH02 comprises sample images of the Daleks as they appeared in the Doctor Who episodes between 1963 and 1974. Exhibit AKH01 is Mr Nation's script for Episode 2 (series 12) which states that the character Davros "is contained in a specially constructed self-powered wheelchair. It has similarities to the base of a Dalek." Ms Hawkes states that the original sketch of the Davros character's appearance was independently designed by Peter Day, visual effects designer at the BBC, on the basis of Mr Nation's scripts. She provides, at Exhibit AKH03, a copy of Mr Day's original sketch. The Davros character has appeared in subsequent episodes of Doctor Who, including two which were broadcast on 28 June 2008 and 5 July 2008. She states that all rights in the Davros character are jointly owned by the BBC and Mr Nation's Estate.

12. Ms Hawkes states that Mr Clark brought a High Court claim against the BBC on 11 February 2011, alleging copyright infringement. Mr Clark relied upon a drawing and a handwritten story, which was dated 6 April 1972 in a comment allegedly made by Mr Clark's teacher. The parties were in court on 23 April 2012 for the hearing, immediately prior to which Ms Hawkes states that Mr Clark agreed to settle with the BBC. She states that the contested registration was not part of the litigation brought by Mr Clark, but it formed part of the settlement. Ms Hawkes states that, as part of the settlement, the BBC agreed not to recover its substantial legal costs and Mr Clark agreed not to claim any rights in the Davros character and to assign the contested registration to the BBC. Ms Hawkes exhibits, at Exhibit AKH08, a copy of the Court order issued on 23 April 2012 in Claim No HC 11 C00288 before the High

Court of Justice, Chancery Division, Intellectual Property (before Master Marsh). The Order sets out that Mr Clark had withdrawn the whole claim; that the Court declared, with the consent of the parties, that Mr Clark does not own any rights in the Davros character; that the Court declared, with the consent of the parties, that the BBC owned certain rights in the Davros character; and that Mr Clark undertook to the BBC and to the Court that he would not at any time in the future represent to any third party that he is the owner of any rights in the Davros character as it appears in the BBC's television programme Doctor Who, or otherwise. The Court ordered, amongst other things, that Mr Clark's claim against the BBC be discontinued; that each party bear its own costs; and that Mr Clark assign the contested trade mark registration to the BBC in accordance with the Act within 14 days of the date of the Court Order.

13. Ms Hawkes states that the BBC sent a copy of the Order, a finalised text of the assignment document, and statutory form TM16 (to record the assignment at the Intellectual Property Office) to Mr Clark on 7 June 2012 (the documents are shown in Exhibit AKH09). Mr Clark never assigned the trade mark registration to the BBC. Ms Hawkes states that, rather than take further legal action against Mr Clark who had limited funds, the BBC took the "pragmatic" decision to allow the contested registration to lapse on renewal, as the BBC did not think that Mr Clark would spend money on renewing a trade mark registration which he was under an order to assign.

14. Ms Hawkes states that Mr Clark does not have any rights to the Davros character and denies that the reasons put forward by Mr Clark constitute "proper reasons for non use". She points out that Mr Clark has agreed not to use the mark which is the subject of the contested registration as expressed in the Court Order of 23 April 2012.

Revocation decision

15. Section 46 of the Act states:

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that——

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from——

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

16. Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

17. The wording of sections 46(1)(a) and (b) means that Section 100 applies to the burden being upon Mr Clark to show either use or why there are proper reasons for non-use of the contested mark in relation to the goods and services for which it is registered.

18. The Tribunal gave the parties until 23 May 2019 to file written submissions in lieu of a hearing, if no hearing was requested by 9 May 2019. Neither party requested a hearing. On 23 May 2019, the BBC requested a short extension of a few working days in which to file its submissions. The Tribunal granted until 29 May 2019; the BBC's written submissions in lieu of a hearing were filed the day after the original deadline (on 24 May 2019). Mr Clark did not file anything by the deadline but, on 7 June 2019, sent an email to the BBC and to the Tribunal, complaining that further time had been allowed and that the BBC had defied the rules. I note that the setting of deadlines for the filing of written submissions in lieu of a hearing is for the administrative purpose of bringing proceedings to a conclusion. Such a deadline is not a statutory time limit set by the Trade Marks Rules 2008 (as amended). As a matter of proportionality, the submissions were a day late, which is not a great deal of time and did not delay this decision. Mr Clark is under the misapprehension that he has a right of reply to the submissions. Written submissions in lieu of a hearing are exchanged by the parties simultaneously; they are not evidence and there is no reason, in a normal case, why they would warrant a right of reply.

19. I have read Mr Clark's submissions. I note that he takes issue with the Court Order. That is not a matter into which I can delve: it is an order from a higher court, a court of record. I also note that Mr Clark refers to the BBC's submissions about caselaw/legal authorities. The BBC's written submissions run to eight pages. They set out the legislation, as I have done, and some of the legal authorities concerning proper reasons for non-use. The BBC has also included copies of some decisions from this tribunal and the Board of Appeal at the European Intellectual Property Office ("EUIPO"). The leading caselaw is from the Court of Justice of the European Union ("CJEU"). This is binding on UK national courts and tribunals. Previous decisions from this Tribunal and the EUIPO are not binding on me. Legal proceedings are decided on their facts, with the decision-maker applying the law to

the facts in order to determine an outcome which is consistent with previous law. If caselaw was ignored, decisions would become arbitrary, inconsistent and unfair. I now turn to the leading legal authorities and apply them to the facts of this case in order to decide whether Mr Clark has met the burden placed upon him to demonstrate satisfactorily that he has proper reasons for non-use.

20. In *Armin Häupl v Lidl Stiftung & Co. KG*, Case C-246/05, the CJEU held that proper reasons for non-use means that the obstacles to use must be outside of the control of the proprietor:

“52. In particular, as correctly stated by the Advocate General in [79] of his Opinion, it does not suffice that “bureaucratic obstacles”, such as those pleaded in the main proceedings, are beyond the control the trade mark proprietor, since those obstacles must, moreover, have a direct relationship with the mark, so much so that its use depends on the successful completion of the administrative action concerned.

53. It must be pointed out, however, that the obstacle concerned need not necessarily make the use of the trade mark impossible in order to be regarded as having a sufficiently direct relationship with the trade mark, since that may also be the case where it makes its use unreasonable. If an obstacle is such as to jeopardise seriously the appropriate use of the mark, its proprietor cannot reasonably be required to use it nonetheless. Thus, for example, the proprietor of a trade mark cannot reasonably be required to sell its goods in the sales outlets of its competitors. In such cases, it does not appear reasonable to require the proprietor of a trade mark to change its corporate strategy in order to make the use of that mark nonetheless possible.

54. It follows that only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as “proper reasons for non-use” of that mark. It must be assessed on a case-by-case basis whether a change in the strategy of the undertaking to circumvent

the obstacle under consideration would make the use of that mark unreasonable. It is the task of the national court or tribunal, before which the dispute in the main proceedings is brought and which alone is in a position to establish the relevant facts, to apply that assessment in the context of the present action.

55. Having regard to the foregoing considerations, the answer to the second Proper question referred for a preliminary ruling must be that Art.12(1) of the Directive must be interpreted as meaning that obstacles having a direct relationship with a trade mark which make its use impossible or unreasonable and which are independent of the will of the proprietor of that mark constitute “proper reasons for non-use” of the mark. It is for the national court or tribunal to assess the facts in the main proceedings in the light of that guidance.

21. From Mr Clark’s evidence, there does not appear ever to have been use by him, or with his consent, of the mark in relation to the goods and services for which it is registered. All of Mr Clark’s evidence is focussed towards the dispute he has had with the BBC. In *Naazeen Investments Ltd v Office for Harmonisation of the Internal Market (OHIM)*¹, Case T-250/13, the General Court of the European Union (“GC”) held that on-going litigation was not necessarily a proper reason for non-use. The court stated that:

“70. As regards the revocation proceedings brought on 5 December 2008 by a third party against the mark at issue, the applicant complains that the Board of Appeal took the view that the proprietor of the mark at issue ought to have assessed and calculated the risks, that is to say, of using the mark despite the risk of having to pay damages or of backing down and abstaining from using the mark, and consequently, of cancellation proceedings being brought. According to the applicant, while revocation proceedings were pending against the mark and its validity was called in question, it would have been unreasonable to make additional investments, or to carry out marketing or

¹¹¹ Now the EUIPO.

sales activities and negotiations with interested business partners or potential licensees or sub-licensees.

71 It must be pointed out, first, that the fact that revocation proceedings have been brought against a trade mark does not prevent the proprietor of that mark from using it.

72 Second, it is indeed always possible that, should such revocation proceedings lead to the revocation of the mark, an action for damages might be instituted. However, an order to pay damages is not a direct consequence of the revocation proceedings.

73 Furthermore, OHIM states, rightly, that it is for the proprietor of a trade mark to conduct an adequate assessment of its chances of prevailing in the revocation proceedings and to draw the appropriate conclusions from that assessment as to whether to continue to use its mark.

74 Accordingly, the applicant cannot claim that the Board of Appeal was wrong to take the view that the revocation proceedings brought in 2008 by a third party did not constitute a proper reason for non-use of the mark at issue.”

22. The judgment of the General Court was upheld on further appeal to the CJEU in Case C-252/15 P.

23. Recital 9 to Directive 2008/95/EC explains the purpose of the non-use provisions², implemented in the UK through sections 46(1)(a) and (b) of the Act, which I have set out above:

“In order to reduce the total number of trade marks registered and protected in the Community and, consequently, the number of conflicts which arise between them, it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation for non-use”.

² Articles 10 and 12 of the Directive.

24. Trade mark registrations cannot be sat upon for many years because this is contrary to the policy outlined above. The essential function performed by a trade mark is that it enables consumers to distinguish the goods and services of one undertaking from another. If a mark is not being used, it cannot do this job. It also hinders other traders who are in a position to commercialise goods and services using the same or similar mark, thereby harming commerce and innovation.

25. It seems to me that Mr Clark has sought protection for his idea through registering it as a trade mark. Trade marks do not exist in a vacuum; that is why they are applied for in relation to specific goods and services. Trade marks are not just ideas. The purpose of a trade mark registration is not to protect an idea; the purpose of trade mark registrations is to enable consumers to tell whose goods and services come from whom so that they can repeat their purchase with some degree of certainty as to trade origin (or to avoid a repeat purchase).

26. Mr Clark is mistaken in his belief that the 'clock' stopped because of the dispute between the parties; that much is clear from *Naazeen Investments Ltd v OHIM*, cited above. I note that in *C=Holdings BV v EUIPO*, Case T-672/16, the GC held that the use by a third party of a misleading and fraudulent strategy in order to deprive the trade mark owner of his or her trade mark went beyond normal commercial difficulties. It represented a "considerable interference" with the holder's normal business activities which seriously undermined the holder's ability to use the trade mark. Therefore, it represented a proper reason for non-use. The tone of Mr Clark's evidence and correspondence with the parties and the Tribunal indicates that he feels he has been the victim of a fraudulent strategy. However, there are two main problems with this.

27. The first problem is that at no time has any evidence been provided by Mr Clark as to what are his normal business activities which feature the contested mark in relation to the goods and services for which it is registered. The second problem is that, on 23 April 2012, the High Court of Justice in England and Wales issued a Court Order, ordering Mr Clark to assign (transfer the ownership of) the trade mark registration to the BBC. This date fell during and prior to the relevant periods

pleaded by the BBC in these non-use proceedings. The Order also stated that Mr Clark did not own any rights in the Davros character. It would be perverse to find that a dispute, which resulted in such a court order, is a proper reason for non-use of the registered trade mark; and perverse in the extreme to find that the contents of the Order constituted proper reasons for non-use.

28. Accordingly, I find that the litigation culminating in the court order and Mr Clark's view that a dispute between the parties is on-going do not constitute proper reasons for non-use within the pleaded section 46(1)(a) and (b) periods. The application by the BBC to have the trade mark registration revoked succeeds in full.

Outcome

29. In accordance with section 46(6)(b) of the Act, trade mark registration 2496785 is revoked with effect from 17 January 2014.

Costs

30. The BBC has been successful and is entitled to a contribution to its costs on the basis of the published scale of costs (Tribunal Practice Notice 2/2016):

Preparing the application for revocation	£200
Official filing fee	£200
Considering Mr Clark's evidence and filing evidence	£500
Preparation of written submissions	£300
Total	£1200

31. I order Steven E. Clark to pay British Broadcasting Corporation the sum of £1200 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 13th day of June 2019

Judi Pike

For the Registrar,

the Comptroller-General