

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK
REGISTRATIONS No. 2140143A AND No. 214043B
EACH IN THE NAME OF JOHN DEVERE**

**AND IN THE MATTER OF APPLICATIONS FOR RECTIFICATION
OF THE REGISTER No. 11445 AND No. 11446 BY FAREL BRADBURY**

DECISION

Introduction

1. Mr. John De Vere (“ the Proprietor”) is the registered proprietor of trade marks No. 2140143A in respect of a mark comprising the words “Golf Courts” and device and No. 2140143B in respect of the mark “Golf Courts”, each of which is registered as of 25th July 1997 in respect of the following specification of goods and services:

- Class 16: Golf related printed matter being score cards and booking forms.
- Class 28: Golf equipment and accessories; golf course equipment and accessories.
- Class 35: Business management golf courses.
- Class 37: Golf course construction; golf course club house construction.
- Class 41: Management of golf courses.
- Class 42: Golf course design; golf course club house design.

2. By applications dated the 10th February 2000, Farel Bradbury (“the Applicant”) applied for rectification of the Register.
3. The original Statements of Grounds upon which the applications were based set out, in summary, aspects of the background to the conception of the trade mark “Golf Courts” and to the golf systems which the Applicant claimed to have designed and constructed. These grounds are of some importance and accordingly I set them out below:

“1. The Applicant designed and constructed his original “cross-play golf course” starting in 1988 (European and International Patents Applications, as published, based on UK Application No. 9124457.4 of 18 November, 1991). He originated the term/phrase/title “golf court” to describe his invention of the Hydatum golf course and golf course equipment. The Applicant recorded this as the title to be used in all marketing of his compact golf systems in a memorandum dated 22 January 1993 addressed to a business group then supporting the patents application.

2. The Applicant has consistently, since its inception used the term/phrase/title in business correspondence, advertising, on stationery and in promotional material and has been associated in widespread publicity as the originator.

3. John DeVere (John Sale) was introduced to the Applicant by a mutual acquaintance in 1992 and has taken a keen interest in these golf court systems ever since and has brought various business groups together in an attempt to exploit the concept. However, the Applicant’s own use of the term/phrase/title, “golf court”, plural and singular, has continued in business correspondence, submissions and promotions unabated throughout and to this day.

4. By an Agreement dated 14 March, 1997, to exploit the golf court concept, between the Applicant and John DeVere (John Sale) with his associates Golf Courts Incorporated, the Intellectual Property Rights were defined as “*All and any intellectual property including design (registered or unregistered), copyright (written and electronic), patents, trade marks extant, latent or proceeding from future developments, design activities or business arrangements.*”

5. The foregoing Agreement was in force at the date of John DeVere's application for the Trade Mark "Golf Courts" (and the logo used by his business), 25 July 1997.

6. The foregoing Agreement was legally terminated by the Applicant on 12 March 1998 after due notice of breach of the terms by John DeVere and his associates. The provisions for termination, in Clause 3.3 of this agreement stipulate:

On the termination of this agreement the Licensee shall forthwith cease and determine all use or representation of the Intellectual Property and all marketing of the licensed Product throughout the Licensed Territory and return and/or surrender to the Grantor (Farel Bradbury) all title to the Intellectual Property then extant.

7. Notwithstanding this Agreement, and John DeVere's own attempts to exploit the concept, the Applicant claims that all use of the name and mark up to the date of application and since, derives from, is associated with, and accrues to his invention and his own use of the term/phrase/title of which he is the legitimate owner and proprietor.

7.(sic) The Trade Mark was registered on 11 September, 1998 in the name of John DeVere.

8. I respectfully request that the Register of Trade Marks is rectified to show this applicant as the owner of the Mark."

4. It is apparent from the grounds set out above that the Applicant did not specify any section of the Trade Marks Act 1994 ("the Act") upon which he relied. By letter dated 21st February 2000, the Trade Marks Registry asked the Applicant to amend his Statements of Grounds to specify the sections of the Act under which the applications were made. With that letter were enclosed copies of extracts of the Act with markings on sections 60 and 64.

5. Following the request from the Registry, the Applicant filed further Statements of Grounds, dated 22 February 2000, and these specified the following additional grounds to those specified in the earlier statements:

“7. The Trade Mark was registered on 11 September, 1998 in the name of John DeVere having been applied for while a legally engrossed agreement acknowledging the present Applicant as the proprietor of the mark was in force.

8. Accordingly I state that, under the provisions of Section 60(3)(b) of the Trade Marks Act 1994, John DeVere was acting as my Agent.

9. I therefore ask that Registration No. 2140143A [and B] is rectified to show that I am the owner of the Mark.”

6. Section 60 provides, so far as material, as follows:

“60(1) The following provisions apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Convention country.

..

(3) If the application (not being so opposed) is granted, the proprietor may-

- (a) apply for a declaration of the invalidity of the registration, or
- (b) apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.”

7. As will become apparent, in specifying section 60(3)(b), the Applicant believed that the UK was a relevant Convention country and he read section 60 as appearing exactly to describe the circumstances in which he found himself. He was not aware that section 55(2) of the Act provides that the UK is not to be treated as a Convention country.

8. The Proprietor filed Counterstatements and, as noted by the Hearing Officer, those accepted parts of the Applicant’s Statements of Grounds, expressly denied other parts and neither accepted nor denied others. The Applicant was

put to strict proof on some of his claims. It is fair to note that at paragraph 17 of the Counterstatements the Proprietor stated the following:

“It is denied that the Applicant is the proprietor of the Trade Mark in a Convention country. The Applicant is put to proof that he is the proprietor of the Trade Mark in a Convention country. As the Applicant is not the proprietor in a Convention country, the provisions of Section 60(3)(b) of the Trade Marks Act 1994 (“the Act”) do not apply. Without prejudice to the generality of the foregoing, it is further denied that the Proprietor was at any time acting as an agent of the Applicant.”

9. The proceedings then entered into their formal statutory evidence rounds. That evidence is summarised in the decisions of the Hearing Officer and, as recorded in the decision of the Hearing Officer, the Applicant filed a painstaking account of the history and chronology of the Applicant’s dealings in the UK relating to the marks in suit and many associated business ventures and he exhibited a volume of letters, agreements and other documents supporting the events, facts and claims in his affidavits.

10. The Proprietor also filed evidence giving his version of the origins of the trade mark “Golf Courts”, the events leading him to make the trade mark applications in suit and of his business dealings with the Applicant. He observed that the Applicant produced no evidence that he had any “trade mark registrations of the GOLF COURT mark” in any Convention country, and that he had been advised by his trade mark agent that the section of the Act relied upon by the Applicant should not apply.

The Decisions of the Hearing Officer

11. Both parties sought the decision of the Registrar without recourse to a hearing. Accordingly, G. J. Rose' Meyer, the Hearing Officer for the Registrar, determined the matter based upon the evidence as filed and the pleaded grounds.
12. The Hearing Officer noted, in paragraph 10 of the decisions, that there are two basic requirements of an application under section 60(3) to be substituted as the proprietor of a mark on the Register. They are:
 - (a) the proprietor of the registered trade mark has to be an agent or representative of the applicant when the registration took place, and
 - (b) the applicant has to be the proprietor of the trade mark in a Convention country.
13. The Hearing Officer then drew attention in paragraph 11 of the decisions to the requirement that the Applicant had to be the proprietor of the trade mark in a Convention country, meaning a country other than the United Kingdom. The Hearing Officer found that the issue was addressed in the evidence in chief of the Applicant in a way that suggested that he had a misunderstanding of the requirements of the section. In particular, it appeared that the Applicant was unaware of section 55(1)(b) of the Act.
14. The Hearing Officer duly considered the applications for rectification and decided them on a short point. The Hearing Officer concluded, in paragraph 14 of the decisions:

“The applicant’s evidence falls well short of proving anything resembling proprietorship in any Convention country. In the light of this finding, I need not consider whether the proprietor of the registered trade mark was an agent or representative of the applicant when the registration took place, nor indeed to consider any further surrounding issues to determine whether the applicant should be substituted as the proprietor on the Register. No other ground other than rectification under section 60(3) has been pleaded and I find on that sole ground the application fails.”

The Appeals

15. In September 2001 the Applicant gave Notice of Appeal to an Appointed Person under section 76 of the Act. In his Grounds of Appeal, the Applicant stated:

“The Registrar in his Decision is correct in surmising that I have not been made aware of Section 55 of the Act. This detail did not arise during my original discussions with the Law Section of the Trade Marks Registry. In the “notes for guidance” they then forwarded with compliments, the following is the only detail on rectification: “rectification of the register (Section 64 of the Trade Marks Act 1994) permits the Registrar to: enter any change in the name and address of the proprietor or any licensee where a request is made by that person. – remove from the register any matter appearing to have ceased to have effect.

I made my original TMR 26 application without specifying any Section of the Act. In their letter dated 21st February, 2000, the Trade Mark Registry asked me to amend my statement to specify the Section of the Trade Marks Act 1994 under which the rectification should proceed. With that letter were enclosed (copies of) pages 28 - 30 of the Act with markings on Section 60 and 64. No other information on the Act was provided at that time, and knowing that the UK was a Convention country, the reading of Section 60(3) appeared exactly to describe the circumstances in which I found myself.”

16. Accordingly, it appears that the Hearing Officer was entirely right that the Applicant had proceeded under a misapprehension as to the definition of a

Convention country and that he proceeded in the belief that the UK was such a Convention country. He was not aware of section 55(1)(b) of the Act.

17. In the light of the decisions of the Hearing Officer, the Applicant sought in his Statements of Grounds on appeal to raise further matters. First, the Applicant sought to adduce further evidence of his use of the marks in issue in countries outside the UK. Secondly, he sought to raise alternative grounds of objection to the registration and, in particular, to raise objections under sections 5(4) and 47(2) of the Act, on the basis of his alleged earlier use of the trade marks in the UK, and under section 47(4) of the Act, on the basis that the marks in issue were applied for in bad faith by the Proprietor.

18. The appeals duly came on for hearing before me. The Applicant and the Proprietor appeared in person. In addition I had the benefit of the attendance of Mrs Corbett, as a representative of the Registrar.

19. After careful consideration, and at the request of the Applicant, I have come to the conclusion that I should set aside the decisions of the Hearing Officer and remit these cases for re-hearing by the Registrar. The Proprietor understandably resisted this request on the grounds that the matter had been decided, and that such a course would involve further expense and delay. These objections have great force, but in these cases I have come to the conclusion that justice requires that this exceptional course be adopted for all of the following reasons.

20. First, I have reviewed the materials filed by the Applicant and the Proprietor. While it would be wholly wrong for me to come to or express any final view on the matter, I have reached the clear conclusion that the materials filed do raise serious issues as to whether or not the applications were properly made by the Proprietor.
21. Secondly, I agree with the Hearing Officer that the matter proceeded before the Registrar with the Applicant operating under a clear misapprehension as to the scope of section 60(3) of the Act. As the Hearing Officer concluded and the Applicant has confirmed, he believed the UK was a Convention country and pursued the matter to a hearing on that basis.
22. Thirdly, the Applicant did not specify any particular section of the Act in his original Statements of Grounds. Those statements did, however, summarise his claim to have conceived and used the trade mark “Golf Courts” in the UK prior to the applications for the registrations in issue being filed by the Proprietor. They also summarised his claims as to the nature of the relationship he had with the Proprietor.
23. Fourthly, when invited by the Registry to specify the sections of the Act upon which he relied, it is apparent that the Applicant did rely upon the material supplied to him by the Registry and the fact that the copies of the Act supplied had markings on sections 60 and 64. He was not supplied with section 55 which makes it clear that the UK is not to be treated as a Convention country for these purposes.

24. Fifthly, the Applicant then duly prepared evidence in support of the applications, including extensive evidence dealing with the conception of the trade mark “Golf Courts”, his use of the trade mark in the UK and his relationship with the Proprietor.
25. Sixthly, the parties chose to seek the decision of the Registrar without recourse to a hearing. Accordingly, no opportunity presented itself, either before or during the actual decision making process, for the misapprehensions of the Applicant to be dealt with.
26. Seventhly, the Applicant has acted throughout in person. This has also been a factor in his continuing misapprehension as to the scope of section 60 of the Act.
27. Eighthly, there is, in my view, a clear public interest in not permitting marks to remain on the Register which are invalid or for marks to remain on the Register in the wrong hands. I express no view as to the likely outcome of these proceedings, save to reiterate that, in my view, on the materials before me, serious issues have been raised which, I believe, ought to be determined if at all possible.
28. Ninthly, I do not believe it would be appropriate for me, on appeal, to seek to resolve all these matters without the benefit of the decision of the Registrar. It is apparent that if this matter is to proceed to a full and proper hearing the

original grounds of the applications require amendment, and consideration must be given to the admission of the further evidence sought to be adduced by the Applicant. Further, the Proprietor told me that he would wish to respond to these new matters.

29. Finally, Mrs Corbett, the representative of the Registrar, indicated that the Registrar would have no objection to the matter being remitted.

30. In all these circumstances I have come to the conclusion that this is a case where the interests of justice require that I set aside the decisions of the Hearing Officer and remit these cases for re-hearing by the Registrar and I so order. I also believe it would be convenient for a preliminary hearing to take place at which the Applicant and Proprietor should attend. This will provide an opportunity for the issues to be clarified, and directions given for the amendment of pleadings and the filing of further evidence. It is clearly desirable that the matter be resolved as quickly as possible.

31. I was not asked to make any order for the costs of the appeal and do not think it would be appropriate so to do.

DAVID KITCHIN QC

28th January 2002