

TRADE MARKS ACT 1994

IN THE MATTER OF Trade Mark No. 2199497 in the name of Aldgate Warehouse Limited

and

IN THE MATTER OF an application for a Declaration of Invalidity under No 12377 by Daniel Melamed

Background

1. The trade mark OLIVER BOND has been registered since 3 March 2000 in respect of

Clothing; headgear; but not including footwear, socks or hosiery

in Class 25 and was registered in the name of Aldgate Warehouse Limited.

2. By an application dated 1st March 2001, Daniel Melamed (the ‘applicant’) applied for a declaration of invalidity in respect of this registration under the provisions of Section 47 of the Trade Marks Act 1994. He said that the trade mark was registered in breach of sections 3(6), 5(1) and 5(4) of the Act. He also invoked section 64(1) of the Act, in respect of rectification of the register, on the basis that an error had been made by accepting the mark for registration in view of the applicant’s earlier trade mark. Finally, the applicant requested his costs in these proceedings.

3. A copy of this application was issued to the proprietor at his recorded address for service on 11th June 2001.

4. The registered proprietor did not file a counterstatement within the six weeks specified by Rule 33(2) of the Trade Marks Rules 2000. However, under cover of a letter dated 23rd July 2002, Markforce (the attorneys for the registered proprietor) sent a letter to the registry requesting that the registration “be removed from the register”. The appropriate form for the surrender of a trade mark registration is Form TM22, and accordingly the registry wrote to the registered proprietor on 31st July 2001 asking Markforce to supply a completed Form TM22.

5. The Form TM22 was completed on 2nd August 2001 and returned to the registry, whereupon it was actioned on 15th August 2001, with the registry notifying the registered proprietor accordingly on 16th August 2001.

6. Correspondence followed between the registry and the applicant in which the applicant confirmed that he wished the application for a declaration of invalidity to proceed to a decision, notwithstanding that the mark had been surrendered. The applicant said that lapsed or surrendered marks could nevertheless give rise to causes of action, brought after lapse or surrender but relating to a period whilst the mark was registered. Thus it was necessary to have the mark declared invalid as this would have the effect, under section 47(6), that the registration would be deemed *never* to have been made. The registry agreed to proceed to a

decision, but before that, the issue of evidence needed to support the application was raised, in particular, since one of the grounds related to bad faith under section 3(6).

7. Under cover of a letter dated 7th December 2001, the registry wrote to the applicant (copied to the registered proprietor and their agents) informing him that he may choose to file evidence should he wish, although the registry saw no need for evidence to support certain grounds, identifying section 5(1) as a case in point. I should note that it is well established that questions under section 5(1) and 5(2) of the Act involve an evaluation of facts for the ‘tribunal’, and are not therefore questions for which the provision of evidence is usually necessary. The letter also drew attention to the *Firetrace case [2002] RPC 15*. At paragraph 17 of that decision, the Registrar’s hearing officer states:

“It is not sufficient to simply allege that a registration offends either section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports the prima facie case.”

The reason that the hearing officer arrived at this view is the statutory presumption contained in section 72 of the Act which states:

“In all legal proceedings the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

8. The applicant filed no evidence in response to the official letter of 7th December 2001 but had filed a number of exhibits annexed to his statement of case which indicates, perhaps, that the statement was also intended to serve as evidence in the form of a witness statement. Nothing turns on the technical point of whether the statement of case can also be treated as evidence. I should now relate the facts set out in the statement of case in order to assess whether the applicant has met the prima facie case spoken of in the *Firetrace case*.

9. The applicant is the registered proprietor of a mark, 2194069, and also a director of a company called Anglofix Limited. He states that through this firm for many years he has imported clothing including knitwear and shirts. In going about this he has dealt with the Korean Company Daewoo and its subsidiaries, including those based in the UK, since at least 1995. The applicant selects trade marks to be applied to goods to his specification and these are incorporated into artwork and sent to him for approval. Once approved the goods are ordered and supplied with the chosen mark. In 1998 the applicant submitted a list of trade marks to Daewoo UK Ltd for a new range of shirts for introduction into the UK, manufactured in Korea by Daewoo. Two trade marks were finally selected, Oliver Bond and Franco Rizzo, and sample cards were then produced by a company called Dae-A Package Co Ltd. The cards comprise exhibit 3 annexed to the statement of case. Also exhibited are copies of faxes from the applicant to Daewoo Textile with comments on packaging and amendments (exhibit 4), copies of the outer bags (exhibit 5) and further faxes relating to an

order for Oliver Bond shirts.

10. The applicant, having registered his own trade mark, became aware in September 2000 that shirts bearing the Oliver Bond trade mark were being offered for sale by Welcome Break and Roadchef motorway outlets. The applicant has never supplied these outlets. On investigation with the registry he discovered the existence of this registration and believes that the proprietors were supplied with, acquired or imported goods under the Oliver Bond mark, and having done so, sought registration of a mark which they 'neither thought up, commissioned, conceived nor applied themselves to the goods'. He adds that in his view it would be inconceivable that the registered proprietors would have been unaware of the established use of the mark by the applicants.

11. The applicant's mark is, as I have said, 2194069. The details are as follows:

OLIVER BOND

Oliver Bond

Oliver Bond

and which is registered in respect of Class 25 for the following goods:

Articles of clothing and headgear; but not including footwear, socks or hosiery.

The date of registration is given as 8th April 1999.

It is therefore an earlier registered trade mark for the purposes of the Act.

Decision

12. In this case the applicant makes a broad based attack on the registration under sections 3(6), 5(1), 5(4) and 64(1). I mentioned in paragraph 7 above that section 5(1) involves the registrar in an assessment of fact which does not necessarily require evidence in support. It makes sense to start with that section.

13. Section 5(1) reads:

"5.- (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

14. The applicant's mark is for a series of three marks, all of which incorporate the same words as the registered proprietor uses in his mark. The first of the series is in capital letters as is that of the registered proprietor; it is an identical mark within the terms of section 5(1). I go on to consider the nature of the goods that each registration covers. Both registrations are registered in respect of goods in Class 25; the applicants being for "Articles of clothing

and headwear; but not including footwear, socks or hosiery” and the registered proprietor’s mark being for “Clothing; headgear; but not including footwear, socks or hosiery”. Such goods are, in my opinion, identical to the goods of the applicant. The applicant’s registration, being an earlier registration for the purposes of the Act, I find that the applicant succeeds under section 5(1).

15. In view of this finding, I need go no further in relation to the other grounds pleaded. The only comment I would make is that, in my view, reliance upon section 64, covering rectification of the register, in the context of an application for a declaration of invalidity under section 47, is inappropriate, and I would have had to decline to consider that ground.

16. In accordance with section 47(6) the registration, in its entirety, is declared invalid and I direct that it be removed from the register and deemed never to have been made.

17. Although the applicants have requested costs I do not wish to deal with this in my decision in the absence of more detailed submission from both parties. Should the applicants require costs no doubt a written request will be made together with submissions. I would be happy to deal with the issue at that point, having given the registered proprietor an opportunity to comment.

Dated this 1ST Day of August 2002

Edward S Smith
For the Registrar
the Comptroller General