

O-029-07

TRADE MARKS ACT 1994

**IN THE MATTER OF Registration No. 2389657A
in the name of Silver Lining Group Limited**

and

**IN THE MATTER OF an application for
rectification under No. 82643
thereto by Debbie Minton**

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BACKGROUND

1. The trade mark POPCORN was applied for on 16 April 2005 in the name of Silver Lining Limited under number 2389657. During the course of its examination, it was divided into two parts, suffixed A and B. Subsequently, application 2389657A, which is the subject of this rectification action, proceeded to registration on 20 January 2006 in respect of the following goods and services:

Class 6: Small items of metal hardware; key rings.

Class 11: Apparatus for lighting; lamps; lampshades.

Class 18: Bags; backpacks; handbags; purses.

Class 20: Cushions; pillows; goods made of plastics.

Class 26: Pins; needles; buttons; badges.

Class 27: Wallpaper; wallpaper borders; carpets; mats; rugs.

2. On 6 July 2006, an application to rectify the register was made on Form TM26(R) by Debbie Minton, stating that she was the rightful owner of the trade mark.

3. In the statement of case accompanying the application to rectify the register, the applicant's professional representatives, Forrester Ketley & Co, said that the proprietor, Silver Lining Group Limited, had entered into an agreement with the applicant, Ms Minton, when the company was formed on 3 August 2004. The agreement was that, in the event that Ms Minton ceased to be employed by Silver Lining Limited, the trade mark would be transferred into her sole name, as its creator and beneficial owner. It is further stated that by virtue of its liquidation, the company ceased to employ Ms Minton on the day when it went into receivership. Ms Minton had approached the liquidator but, at the date of the application for rectification, the liquidator had refused to assign the mark to her name. I should just mention that the application for the trade mark was made in the name of Silver Lining Limited, but it was published in the Trade Marks Journal and subsequently registered in the name of Silver Lining Group Limited. I do not have any documents before me to explain that change of name but, in any case, nothing appears to turn on it.

4. As the application for rectification was made by a person other than the registered proprietor (at the date the application was made, which is the relevant date), it was necessary to serve the application on the registered proprietor in accordance with rule 34(2) of the Trade Marks Rules 2000 (as amended). This was done on 3 October 2006 to the address for service as recorded on the register. It was stated in the accompanying letter that the registered proprietor would be allowed six weeks to 14 November 2006 in which to file a Form TM8 and counterstatement. If none were filed, then any opposition to the application for rectification may be deemed withdrawn. The registered proprietor failed to respond and therefore the application for rectification has not been contested. Even though it is uncontested, I must still be satisfied that the register does stand in error before I can allow any rectification.

EVIDENCE

5. By way of evidence to support this claim, Ms Minton has supplied a witness statement, accompanied by seven exhibits. Much of it is extraneous for the purposes of this decision. The points in the statement and the exhibits which I consider to be relevant are:

- (i) Ms Minton asserts that she created the name POPCORN for her daughter, Danielle, as a teddy-bear character in 1978;
- (ii) Ms Minton purchased an off-the-shelf company named A.P.B. (Sales) Limited on 3 August 2004 and changed its name to Silver Lining Group Limited. The new company would exploit the POPCORN brand which she had created. On the same day, she licensed the POPCORN name and design to Silver Lining Group Limited and to another, older company which she had founded called Designer Stitches UK Limited.
- (iii) Exhibit DM6 is a copy of an agreement dated 3 August 2004 acknowledging that Ms Minton to be the creator and owner of the POPCORN name and design, owning all intellectual property rights therein. Paragraph 2 of the exhibit says “Debbie Minton will allow Silver Lining Group Ltd and Designer Stitches UK Ltd to use and exploit Popcorn for as long as she is employed by Silver Lining Group Ltd and/or Designer Stitches UK Ltd. If she becomes unemployed by either Company, all Trademarks and Design Registrations will be transferred into her sole name”. The agreement was signed and witnessed by Debbie Minton and Graham John Howard, the Company Secretary of Silver Lining Group Limited and Designer Stitches UK Limited, with Leslie James Smallman, an accountant, as an independent witness to the agreement.
- (iv) Exhibit DM7 is a copy of the minutes from a meeting of the Silver Lining Group Limited Board held on 7 August 2004. The people present at that meeting were the applicant Ms Debbie Minton, Graham Howard and Les Smallman, a consulting accountant. The meeting was held at the address which the applicant has given as her address on Form TM26(R). The minutes state that she is the creator of POPCORN; that she will allow the Company to apply for the same as a trade mark registration and that a licensing agreement

has been signed and witnessed between Debbie Minton as owner of the mark and Silver Lining Limited and Designer Stitches UK Ltd to exploit the mark.

6. The final piece of evidence is a witness statement from David John Lucking of Chamberlain House, Paradise Place, Birmingham. I have surmised from the names printed at the bottom of a letter on file from the applicant's representatives, Forrester Ketley & Co, that Mr Lucking is Ms Minton's trade mark attorney. He has certified that a print-out from the Companies House website is a true copy. The printout gives details of the company details for Silver Lining Group Limited, with a status of "liquidation".

7. That concludes my review of the evidence.

DECISION

8. Section 64 of the Trade Marks Act 1994 deals with the rectification of the register. It reads:

"64.- (1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register:

Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.

- (2) An application for rectification 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.
- (3) Except where the registrar or the court directs otherwise, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.
- (4) The registrar may, on request made in the prescribed manner by the proprietor of a registered trade mark, or a licensee, enter any change in his name or address as recorded in the register.
- (5) The registrar may remove from the register matter appearing to him to have ceased to have effect."

9. It appears from the witness statements and exhibits that Ms Minton has sufficient interest to make the application for rectification. There also appear to be no proceedings concerning the trade mark ongoing in the court.

10. Ms Minton, by making this application to rectify the register, is effectively bypassing the assignment procedure. She claims that the registration is hers by way of the agreement of 3 August 2004. It is not clear whether she has applied to assign the registration; only that the statement of case says that the liquidator would not assign the registration to her. The sole basis upon which I can find in her favour is the copy of that agreement, signed by Ms Minton, Graham John Howard and Leslie James Smallman, an accountant. The remainder of the evidence has little or no bearing on who owns the registration.

11. The copy of the agreement is exactly that: a copy, not an original. It does not bear any formal legal stamp of authenticity. That of itself is not conclusive, but I have not been provided with any other documents which might corroborate the agreement. It seems to me that the matter of a trade mark registration's transferral is a serious one; it is the transfer of property. I cannot agree to such a transfer on the basis of the evidence provided. The register does not stand in error.

12. The application to rectify the register therefore fails.

Dated this 24th day of January 2007.

**JC Pike
For the Registrar
The Comptroller-General**