

O-171-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO 2108705  
OF THE TRADE MARK:**



**IN THE NAME OF CHECKER LEATHER LIMITED**

**IN CLASS 18**

**AND**

**THE APPLICATION FOR RECTIFICATION OF THE REGISTER UNDER  
NO 82210 BY SRIBHAN JACOB COMPANY LIMITED**

## **Trade Marks Act 1994**

**IN THE MATTER OF Registration No 2108705  
by Checker Leather Limited  
of the trade mark:**



**in Class 18  
and the application for Rectification of the Register thereto  
under no 82210  
by Sribhan Jacob Company Limited**

### **BACKGROUND**

1. The above trade mark was registered on 19 September 1997 as no 2108705, hereafter referred to as the registration, in respect of the following goods:

Bags, backpacks, cases, travel bags, sports bags, briefcases, handbags, satchels, purses, wallets and key holders.

The above goods are in class 18 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2. The registration stands in the name of Checker Leather Limited, hereafter referred to as Checker, of The Station, Crosshouse Road, Kilmaurs, Ayrshire, KA3 2TU, United Kingdom. It was assigned to Checker by Van Gestel Limited of Charter House, Garstang Road, Fulwood, Preston PR2 4NB, hereafter referred to as Van Gestel, and this assignment was recorded at the UK Trade Marks Registry on 14 June 2002. Van Gestel was formerly known as Vannoort Limited.

3. On 12 July 2005, Sribhan Jacob Company Limited, hereafter referred to as Sribhan, of 78 Bumrungruang Road, Wat Rachobolith, Phranakorn, Bangkok 10200, Thailand, applied for rectification of the register asking that its name be substituted as the proprietor of the above registration according to Section 60(3)(b) of the Trade Marks Act 1994, hereafter referred to as the Act.

4. Sribhan stated the following in its statement of grounds:

(a) Sribhan is the registered proprietor of the above mark in Thailand under registration number KOR 50849 and rectification is being sought under Section 60(3)(b) because Thailand is a convention country as defined under Section 55(1)(b) of the Act

(b) The distributor in the UK of Sribhan's leather goods was Vannoort Limited, hereafter Vannoort. Vannoort had applied for and obtained the above UK

registration without the knowledge or consent of Sribhan. Sribhan was not aware of this registration until its existence was brought to its attention by Checker, the current registered proprietor, in a (faxed) letter dated 7 July 2003.

(c) Vannoort Limited assigned the above registration to the current registered proprietor, Checker, on 14 June 2002.

5. On 8 September 2005, Checker filed a counterstatement confirming that they were the registered proprietor, denying the claims of Sribhan and putting the applicant to strict proof in relation to all these claims. Checker also requested that the rectification be dismissed and that they be awarded costs.

6. On 27 January 2006, Sribhan filed an amended Statement of Grounds to clarify some of the historical and company details regarding its UK distributor, Vannoort, and its relationship to the registered proprietor Checker. This will be outlined in more detail below.

7. Both sides filed evidence.

8. In a letter from the Trade Marks Registry dated 18 July 2006, both sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing. Checker, the registered proprietor, filed a written submission on 29 August 2006 and the applicant for rectification Sribhan filed a written submission on 30 August 2006. Consequently, this decision is made from the evidence before me and these written submissions.

## **EVIDENCE**

### **Evidence of Applicant**

#### **First Witness Statement of Mrs Jarmaree Blaney Davidson**

9. Mrs Davidson is the Export Director of Sribhan, a position she has held for 18 years. She states in paragraph 3 of her statement that Sribhan has manufactured “high quality leather goods since the 1950s, chiefly bags and cases, under the mark JACOB”. This mark was registered in Thailand on 3 October 1956 as registration number KOR 50849 in respect of bags in international class 18. A copy of this Thai registration and an English translation of it are provided as exhibit JBD1. The Thai registered mark is reproduced below:



I note that the translation of the Thai registration lists the goods in class 18 as “purses” whereas Mrs Davidson refers to ‘bags’ in her statement (see paragraph 3).

10. In paragraph 4, Mrs Davidson explained efforts made by Sribhan to distribute and sell their goods in the UK. An agency agreement was entered into between Sribhan and Bettonhouse Limited, which traded as Roben Marketing Consultancy, on 12 May 1980. A copy of this distribution agreement is exhibited at JBD2 and I note the following:

- (a) the Agent, Bettonhouse Ltd, trading as Roben Marketing Consultancy, will be appointed the sole agent to sell the goods of the principal, Sribhan Jacob Co., in the UK (England, Scotland, North & South Ireland) from 12 May 1980 (see introductory paragraph and paragraph 1);
- (b) The goods of the principal were JACOB branded leather goods manufactured by Cheun Fah Limited Partnership (of 66/1 Asdang Road, Bangkok Thailand);
- (c) The Agent will guarantee to buy from the Principal goods worth not less than \$150,000 per annum (see paragraph 2). The cost of the goods from Sribhan will be quoted as F.O.B. ('free on board') Bangkok, i.e., the cost of the goods plus all costs of loading onto a ship or plane in Bangkok;
- (d) The principal (Sribhan) prohibits the sale or supply of Agency goods in the geographical area covered by this agreement by anyone other than the Agent;
- (e) The agreement was for one year and was to be automatically renewed unless one party notified the other party in writing and provided 120 days notice (see paragraph 7). Also any change or modifications to the agreement had to be agreed in writing by both Principal and Agent.

11. This agency agreement also appears to address the issue of whether Agency goods can be sold or supplied to other companies or persons in the Agency Area. The relevant paragraph of the agreement (paragraph 5) is reproduced directly below

“5. Any of the AGENCY GOODS are prohibited to be supplied or sold to any parties and/or persons within the AGENCY AREAS or to any companies which, with the PRINCIPAL’S knowledge, are distributing AGENCY GOODS in the AGENCY AREAS or otherwise than the AGENT directly by the PRINCIPAL”

12. On 19 January 1981, Roben Beller Marketing applied for registration of the trade mark JACOB (word only) under application no. 1147235 for the following goods in class 18:

Articles made of leather and imitation leather; skins, hides, trunks and travelling bags; whips, harness and saddlery.

Details of this application are provided in exhibit JBD3. Mrs Davidson states that she and her company were unaware of this application when it was made and only became aware of it as part of the current proceedings. I note that this application was withdrawn on 12 May 1989. I note also that the address of Roben Beller Marketing, the applicant for the withdrawn registration, and Roben Marketing Consultancy, the

trading name of Bettonhouse Limited and the agent referred to in the above mentioned agency agreement, is the same, i.e., 163 Holland Park Avenue, London, W11 4UR.

13. Mrs Davidson states that Mr Erdem and Mr Beller were directors of Roben Marketing Consultancy. She provides as exhibit JBD4 a picture showing two gentlemen sitting at a display stand featuring different types of cases, briefcases, handbags and purses. Mrs Davidson states that Sribhan provided all the display materials shown in the photograph and she also identifies the two gentlemen shown in it as Mr Erdem and Mr Beller. The display stand prominently features the word JACOB (see JBD4, top left hand corner and top right hand corner – name of display stand) and a stylised version of the word JACOB which is identical to registration 2108705 (see JBD4, on central pillar in foreground and on rear panel of display). The date when this picture was taken is not clear, Mrs Davidson identifies it as “during the Beller and Erdem years” and also states that these two gentleman split up in “the early 1980’s” when Mr Erdem departed with unpaid debts leaving Mr Beller in charge.

14. According to Mrs Davidson (see paragraph 8), after the break-up of Roben Marketing Consultancy, Mr Beller entered into business with Mr Cyril Shack who traded as City Cash & Carry Limited with an address at 16 Andrew’s Road, Hackney, London E8 4QL. No further details about the relationship between Mr Beller and Mr Shack are provided. Mrs Davidson states that “a verbal agreement was entered into to sell our JACOB goods” with City Cash & Carry.

15. Correspondence between Sribhan and Cyril Shack of City Cash & Carry, dated 8 March 1989, is provided as exhibit JBD5. This copy of a faxed letter shows the JACOB mark in identical stylised form as that in registration 2108705. The letterhead indicates that it is from Cheun Fah Limited Partnership, manufacturer and exporter of “Jacob” leather goods, which manufacture the goods on behalf of Sribhan. The sender of the letter is identified as Sribhan Jacob. I note the following from the letter:

- (a) the goods, attaché cases, would be ready for despatch in March 1989;
- (b) the sender Sribhan is unable to accept a further cancellation of goods worth US\$10,174 having already suffered a loss from a previous cancellation; and
- (c) the sender Sribhan is requesting the new telephone number of Bailey Brook Limited from Mr Cyril Shack.

16. Mrs Davidson states in paragraph 10 that “it became clear that Mr Cyril Shack lacked sufficient expertise in the leather goods retail sector and he sold that part of his business to a Mr Robert Finch of Vannoort Limited”. No date or any further details regarding this sale is given.

17. Mrs Davidson states that “Mr Finch became our United kingdom distributor until we mysteriously lost contact with him in 2002”. However, I note that no further evidence is provided regarding the date or details of when Mr Finch began acting as UK distributor for Sribhan. Also no information is provided regarding any effort that Sribhan made to find out why they had lost contact with Vannoort Limited and Mr Finch in 2002.

18. Exhibit JBD6 provides copies of invoices and freight handling documents for goods shipped by Cheun Fah Limited Partnership, who manufacture the leather goods

for Sribhan, and by Sribhan themselves, to the UK. A range of leather goods including purses, wallets, attaché cases, key cases, were sold to City Cash & Carry Limited, mentioned in paragraph 13 above, in 1989, and to Vannoort Limited in 1997, 1998, 2000 and 2001. I have summarised these transactions in Table 1.

Table 1: Shipments of leather goods from Thailand to UK

	Source	Destination	Invoice Date	Cost (\$)
1	Cheun Fah Limited Partnership	City Cash & Carry Limited	22 March 1989	22,668.10
2			27 March 1989	9,498.10
	<b>TOTAL</b>			<b>\$32,166.20</b>
3	Cheun Fah Limited Partnership	Vannoort Limited	14 March 1997	21,218.75
			10 June 1997	8,877.93
4			26 August 1997	15,314.85
5			13 November 1997	9,668.48
6			23 March 1998	7,402.50
7			21 May 1998	6,215.00
8			15 July 1998	4,325.00
9			29 August 1998	6,218.50
10			3 November 1998	10,705.00
11			Sribhan Jacob Co. Ltd	Vannoort Limited
12	12 February 2000	3,837.50		
13	4 July 2000	14,900.00		
14	27 October 2000	5,418.75		
15	3 May 2001	3,185.00		
	<b>TOTAL</b>			<b>\$122,324.76</b>

19. Each of the invoices from Cheun Fah Limited Partnership to City Cash & Carry Limited or to Vannoort Limited has the following phrase in their letter heading:

““JACOB” LEATHER GOODS MANUFACTURER & EXPORTER”

The invoice dated 3 May 2001 from Sribhan Jacob Co. Ltd to Vannoort Ltd clearly shows the trade mark as registered under Thailand Trademark Kor 50849 on the top of the page, i.e.,



20. Mrs Davidson includes as exhibit JBD7 a copy of a letter dated 9 July 1997 and signed by Mr R. W. Finch, Managing Director of Vannoort. She states that this letter makes it “abundantly clear” that Vannoort Limited was a distributor of Sribhan products. This letter displays the stylised JACOB trade mark (of the current registration) in the lower left hand corner. The text of this letter is reproduced in its entirety below:

“TO WHOM IT MAY CONCERN

9 July 1997

Our company has been marketing the products of JACOB-Thailand (Cheun-Fah) for a considerable number of years.

The JACOB name has now been established on the British market for quite some time and to my knowledge is one of the few well known Thai products in the international market place.

It is in recognition of the importance of this well established Thai brand that we ourselves refer to ourselves as **Vannoort-Jacob**. This assists us in marketing the Thai product of that name in the British market.

I do believe that Cheun Fah are probably the most deserving company to achieve a Prime Minister’s Award for Achievements in exhibiting products with a Thai brand name.

(Signed)  
*R W Finch*  
*Managing Director”*

21. Mrs Davidson indicates that no further invoices for leather goods were received from Vannoort Limited and no further communication took place with Mr Finch from 3 May 2001. On 5 July 2003, Mr Finch sent an email from his home email address asking for the email address of Sribhan (see copy provided as exhibit JBD9). On 7 July 2003, Sribhan received by FAX a letter from Checker Leather Limited, the current registered proprietor of trade mark no. 2108705, which asks Sribhan to stop selling JACOB branded goods in the UK. The faxed letter is exhibited at JBD8 and states that:

- (a) Checker had bought the assets of Vannoort Limited recently and they were now the registered proprietor of the JACOB trade mark in UK;
- (b) Only Checker had “*the right to sell product in class 18 (Leather goods) branded JACOB within the UK*”. Taurus will also be advised of this;
- (c) Checker has not had time to consider “product from your (Sribhan) company” as reorganisation has occurred following the take-over of Vannoort”
- (d) “Since it is not possible for you (Sribhan) to sell JACOB branded product into the UK it is imperative that we review this situation urgently”.

22. Mrs Davidson includes as Exhibit JBD9 her reply to Mr Finch following his enquiry for the email address and following receipt of the letter from Checker Leather Limited. She confirms that date of this email is 8 July 2003 (as the actual date on the email itself is derived from the calendar used in Thailand which is different to that used in the UK). This letter acknowledges receipt of the email from Mr Finch’s home address and expresses the disappointment and bafflement of Mrs Davidson and

Sribhan with how the situation is unfolding regarding the lack of contact for more than one year between themselves & Mr Finch; the sale of Mr Finch's business to Checker Leather Ltd; and the registration of the JACOB mark in the UK.

## **Evidence of Opponent**

### **Witness Statement of Mr Peter Pattison**

23. Mr Peter Pattison is the managing director of Checker Leather Limited and has held this position for 25 years. His company acquired UK registered trademark no. 2108705 and the goodwill therein from Van Gestel Limited in 2002. A copy of the entry for this trade mark on the UK trade mark register is provided as exhibit PP1. A copy of the assignment document agreed by Checker Leather Limited and Van Gestel Limited on 20<sup>th</sup> May 2002 is provided as exhibit PP2 and a copy of the assignment certificate issued by the Trade Marks Registry issued on 24 June 2002 is provided as Exhibit PP3.

24. Mr Pattison states that at the time of purchase he believed Van Gestel Limited to be the rightful owner of the registered trade mark. He has known Mr Robin W Finch of Van Gestel Limited for 22 years and was aware of the use of the JACOB trademark by his previous company, Vannoort Limited, in relation to leather good for 20 years. Following the purchase and assignment referred to above, Mr Pattison now considers that Checker Limited is the true and rightful owner of UK registered trade mark no. 2108705

25. Mr Pattison explains that Checker Leather Limited provides quality leather products under the trade name JACOB which they commission from manufacturers in several countries. Such goods are branded with the trade mark JACOB at the request of Checker by the manufacturer and then exported to the UK where Checker distributes these goods to various "high end retailers". Checker has not sourced any leather products from Sribhan, either bearing the JACOB name or otherwise, because "they are not competitively priced". Checker has never had a distributor agreement with Sribhan in the UK. Exhibit PP5 includes a copy of a page entitled "Jacob product range" showing the registered trade mark in the bottom right hand corner but without any additional pages showing product items. It also includes copies of advertisements for leather goods bearing the registered trade mark from the magazine Fashion Extras dated April 2004, October 2004, January 2005 and March 2005. These show small leather goods (e.g., a wallet or a purse), a handbag (twice) and a woman's vanity case.

26. Checker became aware of the use of the trade mark JACOB on goods being sold by Taurus Leather Limited of Montague House, 436 Leeds Road, Robin Hood, Wakefield, WF3 3BG, hereafter referred to as Taurus. They instructed their trade mark attorneys, Murgitroyd & Company, to contact Taurus and request that they stop applying the JACOB trade mark to leather goods covered by this registration as Checker was now the registered proprietor of this trade mark. Mr Martin Galdas, a director of Taurus, informed Checker that they had been approached by Sribhan to sell goods under the mark JACOB in the UK. Following the request to stop selling these goods from Checker, "Mr Martin Galdas agreed to withdraw their acceptance of the offer to sell goods of Sribhan under the Mark JACOB in the UK". A Statutory

Declaration from Mr Galdas, exhibited as PP4, indicates that Taurus will not sell, import, advertise or display the goods of Sribhan Jacob Co. Ltd of Thailand or any packaging for such products that bear the trade mark "JACOB" and fall within the scope of its registration. Taurus has deleted any reference to products bearing this trade mark from their catalogues and other printed matter. Referring to these actions, Mr Pattison states that:

"This clearly shows the action of a registered proprietor attempting to ensure the protection of their rights in a registered Trade Mark. We have invested a considerable amount of time and money in the Trade Mark JACOB and have ensured that the brand is now known for its high quality and style."

27. Mr Pattison makes some comments in response to Mrs Davidson's First Witness Statement regarding Sribhan's claim to be rightful owners of the registered trademark and the relationship between Mr Finch of Van Gestel Limited and Sribhan which do not assist me in reaching my decision.

28. Mr Pattison then goes on to state that Checker:

"have never entered a distributor agreement with a foreign manufacturer, and indeed am aware that such agreements are not in any way commonplace in the course of trade. It is therefore not possible to imply an agreement, based on circumstances. In my experience, there is simply a 'supplier/buyer' relationship between manufacturers and companies such as Checker Leather Limited, who purchase goods, have then branded with their chosen brand and import them for sale in the UK and elsewhere".

29. Mr Pattison comments that the action of Sribhan in approaching Taurus to distribute their goods in the UK under the JACOB band indicates that Sribhan were aware, firstly, that Mr Finch of Van Gestel, formerly of Vannoort, no longer wished to purchase their goods and, secondly, that they sought to trade on the reputation in the registered trademark established in the UK by Checker.

### **Witness Statement of Robin W Finch**

30. Mr Finch was the managing director of the Van Gestel Limited of Charter House, Garstang Road, Fulwood, Preston, PR2 4NB, hereafter referred to as Van Gestel, which was dissolved on 23 December 2003. Van Gestel was formerly known as Vannoort Limited. This change of name was recorded at Companies House on 13 December 2001 (see exhibit RF1). In 1990 Vannoort Limited acquired the stock and goodwill of Bailey Brook Limited which traded as City Cash and Carry. Mr Finch indicates that he was not involved in the events leading up to the acquisition of Bailey Brook Limited

31. UK trade mark registration number 1204192 in the name of Jacob Limited was obtained by Vannoort Limited as part of this acquisition. Exhibit RF2 shows the details of this registration. Mr Finch stated that this registration "had been assigned to Bailey Brook Limited". However, this assignment – from Jacob Limited to Bailey Brook Limited – and the subsequent assignment from Bailey Brook to Vannoort Limited were not recorded at the Trade Marks Registry. Trade mark registration no.

1204192 was not placed in the care of a Trade Mark Agent and this led to Mr Finch inadvertently allowing the registration to lapse because of failure to act on the renewal warning. Mr Finch states that “My intention was to keep the registration in force, since the Mark was in widespread use throughout this period”. As soon as Mr Finch discovered that the registration had lapsed, he filed a fresh application to register the trade mark JACOB, which application became the current registration number 2108705. He states that this application was “to protect my company’s rights in the Mark, and the goodwill that it acquired from Bailey Brook Limited”.

32. Mr Finch then goes on to explain how Bailey Brook Limited and subsequently Vannoort Limited obtained the leather goods that they sold. At the time that Mr Finch acquired the assets of Bailey Brook Limited, trading as City Cash and Carry, goods bearing the mark JACOB were being sourced by Bailey Brook from three different manufacturers one of whom was Sribhan. Mr Finch then goes on to state that

“To my knowledge, the Mark JACOB was owned by Bailey Brook Limited, who purchased unbranded goods, to which they instructed the respective manufacturers to apply the Mark JACOB, and the goods were then imported by Bailey Brook Limited into the UK for sale. As the relationship between Sribhan and Bailey Brook Limited was clearly not an agency agreement, but rather a purchase of goods and clearly not an exclusive agency agreement, I had and still have no reason to believe that Sribhan ever had any rights in the Mark JACOB.”

33. Mr Finch’s responsibility for Vannoort Limited was to source products to be sold under the registered mark in the UK and he states that the cost of goods from Sribhan became too expensive and he no longer purchased goods from Sribhan. As there was no agency agreement, explicit or implied, between Vannoort Limited and Sribhan, Mr Finch says that this was his prerogative. I note that Mr Finch does not indicate a date or time when he ceased to use Sribhan as a source of leather goods. I note also that Mr Finch does not provide any information regarding why he considered the cost of Sribhan goods to be too expensive. From Exhibit JBD6, it is clear that Sribhan and Vannoort had been in a commercial relationship for at least 4 years (1997-2001) and that Vannoort had purchased over \$120,000 worth of goods from Sribhan/Cheun Fah.

34. Mr Finch provides, as Exhibit RF3, a copy of a catalogue from 1998 listing the range of goods sold by Vannoort under the JACOB brand and he states that none of the products advertised therein were sourced from Sribhan. I note that all of the goods listed on the page entitled MARCO leather business cases display a tag with the trade mark JACOB printed on it attached to their handles or zips, see for example, item MARCO 91051 or MARCO 91053 or MARCO 91050. This is also the case with the two of the CONSUL business cases shown on the page entitled “Delegate & Consul offer...”, see for example, item CONSUL 2690 and five of the six bags shown on the page entitled “Hand Luggage. Grips is a collection ...”. I note also on the end of this latter page that the name of the company is listed as “Vannoort-Jacob Limited”.

35. Mr Finch denies that any agency or distributor agreement existed between Vannoort and Sribhan. He purchased goods from Sribhan on a non-exclusive basis only. Mr Finch then states that in the normal course of trade in sourcing and

supplying leather goods, it is common practice for a company to be in contact with manufacturers at least once a month. Mr Finch's lack of contact with Sribhan made it clear that he no longer wished to purchase Sribhan products. He also states that if there was an agency or distributor agreement, it would have been important for Sribhan to retain contact with Vannoort in order to continue to sell their products in the UK. He asserts that "Clearly the actions of Sribhan show that they did not believe that there was any agency or distributor agreement to enforce as they were not concerned that they had received no contact from me for nearly 2 years".

36. In response to the letter signed by Mr Finch and exhibited by Mrs Davidson as JBD7, Mr Finch offers the following explanation:

"At the time of writing the letter referred to ....., I worked as a consultant for the UN and on occasions for the Thai Leather Goods Association. As I held these positions, I was asked by Mrs Blaney Davidson if I would write a letter in support of Sribhan's application for a trade prize from the Thai government. I had previously enjoyed a very good working relationship with Sribhan, and my decision to purchase goods elsewhere was solely for economic reasons, therefore I agreed to sign such a letter, which was in fact prepared by Mrs Blaney Davidson herself"

37. The assets of Van Gestel, formerly Vannoort, were sold to Checker in 2002 including the registered trade mark which was assigned to Checker on 14 June 2002. Mr Finch states (in paragraph 4 of his witness statement) his belief that the application for registration number 1204192 by Jacob Limited was made in good faith and that he acquired a valid registration for this Mark when Vannoort acquired Bailey Brook Limited. Mr Finch's subsequent action in applying for the registered trade mark following the lapse of no. 1204192 was to "re-protect the rights that my company has already acquired in this Mark". Following the acquisition of Van Gestel, the successor company of Vannoort, Checker, in Mr Finch's view, is the valid owner of the registered trade mark.

#### **Witness statement of Jennifer Norris**

38. Ms Norris is a trade mark attorney working at Murgitroyd & Company, who are acting for Checker in this case. In her witness statement she makes some comments regarding the case to support the rectification action, its timing and costs which do not assist me in reaching my decision.

39. Ms Norris comments that Thai Trade mark registration number KOR 50849, submitted as exhibit JBD1 by Sribhan, shows that Sribhan is in fact a joint proprietor of this mark and that this mark "in any event, is for a different Mark from that which is the subject of UK Trade mark registration Number 2108705 JACOB and should therefore be discounted in the present proceedings".

40. Ms Norris argues that the application for rectification of the registered trade mark by Sribhan should not be allowed. In response to the statement by Sribhan in paragraph 4 of their statement of case that because Thailand is a member of the World Trade Organisation, "it is therefore a convention country in accordance with Section 55(1)(b) of the Trade Mark Act 1994", Ms Norris contends, on the contrary, that, as

Thailand is not a member of the Paris Convention, it is not “a convention country” as defined in Section 55 of the Act and thus is not entitled to bring an action for rectification before the UK trade marks registry. The amendments to section 55 of the Act under section (aa) to include the definition of the WTO does not increase the scope of subsection (b) to include a country that is a member of the World Trade Organisation as a “convention country”.

### **Evidence in Reply - Applicant**

#### **Second Witness Statement of Mrs Jarmaree Blaney Davidson**

41. The second witness statement by Mrs Davidson is concerned principally with the comments from Mr Finch in his witness statement regarding the letter signed by him and exhibited as JBD7. Much of this statement by Mrs Davidson comprises submission rather than evidence and I will treat it accordingly.

42. Mrs Davidson states that the letter in JBD7 shows “my employer’s mark at its foot” and she points out that Sribhan were using the registered trade mark on its business papers and invoices, as shown in exhibits JBD5 and JBD6, many years prior to the acquisition by Mr Finch of the Vannoort business from Bailey Brook Limited (trading as City Cash & Carry) which sold Sribhan’s JACOB branded goods, as outlined by Mrs Davidson in her first witness statement (and exhibits JBD5 and JBD6).

43. Mrs Davidson denies the statement of Mr Finch in paragraph 10 of his witness statement that she prepared the letter exhibited as JBD7 for him to sign.

44. Mrs Davidson comments that Mr Finch does not provide any details of other manufacturers from whom he purchased unbranded goods to which the JACOB mark was then applied.

### **ANALYSIS**

45. Based on the written submissions that I have received from both sides, the first question that falls to me to decide is does the applicant Sribhan, a company in Thailand, have the right under UK law to seek rectification under Section 60 of the Act? If the answer to the first question is affirmative and Sribhan does have this right, then the second question to be decided is do the facts of the case support Sribhan’s request for rectification under Section 60(3)(b) or not.

### **THE FIRST QUESTION**

46. To answer this first question it is first necessary to consider the inter-relationship between the Paris Convention and the TRIPs Agreement and how the UK Trade Marks Act 1994 has given effect to the UK’s responsibilities as a signatory of both. I will then consider what this means for a company from Thailand attempting to assert its trade mark rights in the UK

## **The Paris Convention & the TRIPs Agreement**

47. The Paris Convention for the Protection of Industrial Property of March 20th 1883, as revised or amended, hereafter the Paris Convention, is an international treaty which applies to inventions, industrial designs, indications of origins, trade marks and unfair competition. It establishes basic principles for laws on industrial property in individual countries and also establishes principles for reciprocal protection between countries and for priority rights in respect of patents, trade marks and industrial designs. This convention is administered by the World Intellectual Property Organisation (WIPO), part of the United Nations, and currently has 114 signatories. The UK is a signatory of the Paris Convention, but Thailand is not. Of relevance to this case is Article 6*septies* of the Paris Convention which provides that convention countries will put in place measures to allow the owner of a registration in one convention country to act to prevent registration of this mark by his agent or representative in another convention country (See Annex to this decision for the full text of this article).

48. The Trade Related Aspects of Intellectual Property Rights (TRIPs) Agreement lays down minimum standards of protection for intellectual property to ensure that effective protection and enforcement of IPRs does not create barriers to legitimate trade between countries. It is administered by the World Trade Organisation (WTO) and has been in place since conclusion of the Uruguay Round of the General Agreements on Tariffs and Trade (GATT) in 1993. Thailand and the UK are both members of the WTO and are signatories of the TRIPs Agreement since 1995.

49. Both the Paris Convention and the TRIPs Agreement are international treaties and, as such, they do not have direct effect in those countries that have signed them, they must be implemented into national legislation by each signatory state. Thus, when examining how these treaties apply to a particular case in the UK, it is necessary to consider how they have been implemented into national legislation.

50. In 1994, sections 55-60 of the Act, entitled ‘The Paris Convention: Supplementary Provisions’ introduced into UK trade mark law for the first time, provisions based on provisions of the Paris Convention (these changes are summarised in the Annex to this decision).

### **Implementation of TRIPs into UK law**

51. When, in 1995, the UK became a member of WTO and a signatory of the TRIPs Agreement, the Act had to be amended to bring UK law on trademarks into compliance with TRIPs. All WTO members agreed under Article 2 of TRIPs to apply articles 1-12 and 19 of the Paris Convention. This includes Article 6*septies* referred to above. Under Article 3 of TRIPs, the UK also agreed to treat all applicants for IP rights from WTO member states equally with applicants for such rights from the UK (for full text of Articles 2 and 3 of the TRIPs agreement, see Annex to this decision).

52. The European Community became a member of the WTO and a signatory of the TRIPs Agreement in 1995 at the same time as the UK. This allowed community efforts to promote trade and the single market to be aligned with international efforts to do the same. It also took account of the fact that the European Community have

agreed a number of community legislative measures in the area of intellectual property, including, for example in the area of trade marks, Council Regulation (EC) 40/1994 on the Community Trade Mark and the First Council Directive 89/104/EEC to approximate the laws of the Member States on Trade Marks. As a result the member states of the European Community cannot act alone or in a manner inconsistent with their Community obligations when entering into any international agreements that also concern areas covered by these community legislative measures. Thus the UK has an obligation to implement its responsibilities under TRIPs through its membership of the European Community as well as through its direct membership of the WTO.

53. In the United Kingdom the power to enter into treaties is a function of the executive, i.e. the Government, under prerogative powers rather than of the legislature, i.e. Parliament, but under the doctrine of parliamentary sovereignty a treaty cannot alter national law unless it is given effect by an Act of Parliament. The acceptance into United Kingdom law of rights and obligations created by European Community treaties therefore takes place, not directly, but under the European Communities Act 1972<sup>1</sup>. In this case the necessary changes to the Act were made using Section 2(2) of the European Communities Act 1972. This Act allows the UK to alter primary legislation to meet its rights and obligations as a member of the European Community using a statutory instrument, in this case, Statutory Instrument (SI) 1999/1899, the Patents and Trade Marks (World Trade Organisation) Regulations 1999. This SI came into force on 29 July 1999 and made amendments to Sections 6, 55, 56, 57, 58 and 59 of the Act.

54. Thus the UK considered that the best way to implement its responsibilities and obligations under TRIPs was to use the mechanism that the UK has for implementing its responsibilities and obligations as a member state of the European Community. This has clear implications for how any questions regarding UK implementation of these responsibilities and obligations under TRIPs should be answered.

55. In the present case concerning rectification, I am concerned with Section 60 which was not amended by SI 1999/1899 and I take particular note of this fact. I am also concerned with Section 55 which was amended by SI 1999/1899.

#### **Sections 55 and 60 of the UK Trade Marks Act 1994**

56. As mentioned above, Section 60 of the Act implements Article 6*septies* of the Paris Convention. It provides that the owner of a registration in a convention country can act to prevent registration of this mark by his agent or representative in the UK.

57. Section 60 states:

“(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.

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<sup>1</sup> For text of the European Communities Act 1972 see the website of the Office of Public Sector Information (OPSI) at <http://www.opsi.gov.uk/acts/acts1972/19720068.htm>

- (2) If the proprietor opposes the application, registration shall be refused.
- (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.
- (4) The proprietor may (notwithstanding the rights conferred by this Act in relation to a registered trade mark) by injunction restrain any use of the trade mark in the United Kingdom which is not authorised by him.
- (5) Subsections (2), (3) and (4) do not apply if, or to the extent that, the agent or representative justifies his action.
- (6) An application under subsection (3)(a) or (b) must be made within three years of the proprietor becoming aware of the registration; and no injunction shall be granted under subsection (4) in respect of a use in which the proprietor has acquiesced for a continuous period of three years or more.

58. For the meaning of the term ‘convention country’ in Section 60(1) we must turn to section 55 of the Act which defines this term as: -

- (1) In this Act-
- (a) “the Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20th 1883, as revised or amended from time to time,
  - (aa) “the WTO agreement” means the Agreement establishing the World Trade Organisation signed at Marrakech on 15th April 1994, and
  - (b) a “Convention country” means a country, other than the United Kingdom, which is a party to that Convention.

59. Thus, a proprietor of a trade mark in any country that is party to the Paris Convention, other than the UK, is entitled under Section 60 to oppose an application by their agent or representative to register that mark in the UK. If the mark has been granted in the UK, the proprietor can seek to have the registration declared invalid, or he can apply for rectification, i.e., to have his name substituted as the registered proprietor of the mark in the UK.

60. The application for rectification by Sribhan in the present case is made under the single ground of Section 60(3)(b) as the registration in question has already been granted.

### **The Relationship between Section 60 and Section 55 of the Act**

61. In their written submissions both sides have drawn attention to how to interpret Section 60 in light of Section 55 and the definition of a ‘Convention country’ following the amendment made to Section 55 by SI 1999/1899.

62. In its statement of grounds Sribhan states that although not a Paris Convention country, Thailand as a member of WTO, is entitled to be treated the same as a Paris convention country following the amendment of Section 55 by SI 1999/1899 which added sub-section (aa) to this section of the Act (see above). This would appear to be a logical conclusion given the clear purpose of Article 3 of TRIPs. However, as I have pointed out below it is how this change has actually been implemented into UK law that is the decisive factor.

63. In its counterstatement, Checker argues to the contrary stating that section 60 applies only to Paris Convention countries and that as Thailand is not a signatory of the Paris convention, it is not entitled to seek rectification under this section of the Act.

64. The purpose of SI 1999/1899 as stated in the Explanatory Note which accompanies it but is not part of the instrument, is stated as follows:

“These Regulations modify the Patents Act 1977, the Patents Rules 1995 (SI. 1995/2093) and the Trade Marks Act 1994 in pursuance of the United Kingdom's obligations under the Agreement establishing the World Trade Organisation signed at Marrakech on 15th April 1994 and the Agreement on Trade-Related Aspects of Intellectual Property Rights which is an integral part of the WTO Agreement.

.....

Amendments are also made to the Patents Act 1977 and to the Trade Marks Act 1994 to permit any country which becomes a member of the World Trade Organisation to be treated automatically as a Convention country (regulations 7(1) and 13).”

This is a clear statement of what the SI set out to achieve. I have to determine whether or not in fact the changes made actually achieve this purpose in practice.

65. In its consideration of Section 60, Kerly's Law of Trade Marks and Trade Names, 14<sup>th</sup> edition, chapter 14, paragraph 14-222, interprets the impact of the changes made by SI 1999/1899 in the following way:

“An agent or representative of any person who is proprietor of a mark in any convention or member country may restrain any use of the mark in the United Kingdom which is not authorised by him [see section 60(4)] and unless the agent or representative justifies his action [see section 60(5)]”  
(emphasis added by me).

And it goes on to elaborate the meaning of ‘member country’ in footnote 12 to this paragraph:

“Convention or member country is defined by the 1994 Act, s. 55, as any country, other than the UK which is a party to the Paris Convention and any revision or amendment to it and any member of TRIPs. It appears that it is not a requirement that the mark is registered in the convention or member

country of origin although it seems that it must be in use and properly so by the person claiming to be the proprietor if he or she is to be so regarded. Although s.60 is not specifically referred to in SI 1999/1899, *s. 60 refers to “Convention country” as defined in section 55(1)(b) and that has been amended by SI 1999/1899 to refer to the WTO agreement as well as the Paris Convention.*”

(emphasis added by me).

66. Section 55 provides the correct definition of the terms ‘the Paris Convention’, ‘the WTO agreement’ and a ‘Convention Country’ which are then used to define the scope of the following Sections 56-59. A consideration of the changes made to Sections 56-59 by SI 1999/1899 shows that appropriate phrase, i.e., ‘and the WTO agreement’ or ‘or the WTO agreement’, was inserted into those sections to make it clear that the scope of these Sections would apply to WTO member countries as well as to Paris Convention countries. For example in Section 59(5), it is made clear that any reference to Article 6ter of the Paris Convention shall also include a reference to Article 6ter as applied by the WTO agreement. Thus, I conclude that when those responsible for making the necessary changes to the Act deemed it necessary to extend or confirm that the relevant section applied to WTO member countries as well as Paris convention countries, explicit reference was made to this fact.

67. No amendment to refer to the WTO agreement was made to Section 60 and I have to conclude that this is deliberate. If section 60 was not altered in any way, then I must conclude that this was a deliberate decision taken after due consideration. As a hearing officer fulfilling a judicial function, I have to take account of what the statute as written means, I cannot take account of what it should or is meant to mean.

68. A consideration of Section 55 also does not appear to very helpful in this regard, as the amendment to this section merely inserted a new Section 55(aa) which defines the term ‘the WTO agreement’. It did not make any change to indicate that, for the purposes of Section 55(b), a ‘Convention Country’ can also be considered to mean a WTO agreement country or that the reference to ‘convention’ also includes a reference to the WTO agreement.

69. I must base my decision as a hearing officer on what it is actually written in the legislation. On a first examination, this would lead me to conclude that to read Section 55(b) as including WTO member countries in the definition of ‘convention country’ is stretching this definition too far and that it is not appropriate to do. Thus I would not be able to agree with the interpretation placed on Section 55 and Section 60 by the contributors to Kerly’s Law of Trade Marks and Trade Names quoted above. Section 55(aa) only provides a definition of what the term “the WTO agreement” means in the context of the following Sections of the Act which use this term, i.e., Sections 55(2), 56(1), 56(2), 57(2), 57(3), 58(2) and 59(5). This term is not used in Section 60 which refers only to “convention country”, the definition of which is provided in Section 55. Thus, as written, Section 60 would appear to apply only to countries that are signatories of the Paris Convention.

70. Support for this view comes from the comments of Justice Andrew Phang Boon Leong of the Singapore High Court in the recent *Nation Fittings (M) Sdn Bhd v. Oystertec Plc* case reported at [2006] F.S.R., 40. This was a trade mark case where it

was necessary to decide if transitional provisions for the new 1998 Trade Marks Act in Singapore could operate in such a manner to allow registered trade marks to be converted from two dimensional marks under the old Act to three dimensional shape marks under the New Act without the need for a specific application under the New Act by the registered proprietor. Leong J considers the role of the court in interpreting statutory provisions, and he states at paragraph 27:

“I pause at this juncture to note that a literal reading of the (indeed, any) statutory text could lead to a dry, brittle literalness that does no justice to the enterprise of the law in general and the text concerned in particular. On the contrary, the favoured approach nowadays (and rightly so, in my view) is a purposive approach that is exemplified not only by the case law but also by s.9A(1) of the Interpretation Act itself (Cap 1, 1999 Rev Ed). Indeed, a purposive approach towards the statutory text does not ignore the literal meaning of the text by any means but, rather, complements it by ensuring that the purpose and intent of the statutory text itself is achieved and that any strained and, a fortiori, absurd result is avoided. I should reiterate that the court's interpretation should be consistent with, and should not either add to or take away from, or stretch unreasonably, the literal language of the statutory provision concerned. In other words, the literal statutory language constitutes the broad framework within which the purpose and intent of the provision concerned is achieved. It is imperative, to underscore the point just made, that this framework is not distorted as the ends do not justify the means. Where, for example, it is crystal clear that the statutory language utilised does not capture the true intention and meaning of the provision concerned, any reform cannot come from "legal gymnastics" on the part of the court but, rather, must come from the Legislature itself.”

Thus the statute, in effect, provides the framework within which one can have some scope to interpret the words but this must not be in a manner to take away or add or stretch unreasonably their literal meaning. However, I do not think that this is the final word. I note that if the statutory language used does not capture the true intention and meaning, then the issue can only be resolved by the legislative arm rather than the court. For this reason, I would like to look in more detail at how the UK Parliament effected the change to Section 55 and its subsequent impact on Sections 56-60 of the Act.

### **Effect of Implementation method using the European Communities Act 1972**

71. As already mentioned, the introduction to SI 1999/1899 clearly states that the changes are meant to ensure that trade mark owners from WTO member states are treated in the same way as trade mark owners from states that have ratified the Paris convention. Yet, as I have also indicated, at first examination, the amendment made to Section 55 does not appear to have this effect in relation to Section 60. The necessary amendments to the Act were made using an SI under Section 2(2) of the European Communities Act 1972. This clearly signals that those in UK Government responsible for implementation considered that these changes are to meet UK responsibilities as a member of the European Community [This is confirmed by the fact that the WTO Agreement, and as a result the TRIPS Agreement which flows from it, was declared a Community Treaty under UK law (as defined in section 1(2) of the European Communities Act 1972 by S.I. 1995/265, see Note [7] of SI 1999/1899)].

72. When a question arises regarding how to interpret TRIPs in relation to an area such as trade marks where the Community has legislated, the judicial authorities in the members' states are required to interpret national legislation implementing Community legislation in the same way as Community legislation. This was neatly summarised in the recent EINSTEIN decision (see BL O-068-07), where Mr Geoffrey Hobbs QC sitting as the Appointed Person, stated the following:

30. The TRIPs Agreement was concluded by the Community and the Member States acting jointly. In the field of trade marks (to which TRIPs is applicable and in respect of which the Community has already legislated) the judicial authorities of the Member States are required to apply Community legislation and national legislation implementing Community legislation so far as possible in the light of the wording and purpose of the Agreement in that field: see, in particular Case C-245/02 *Anheuser-Busch Inc v. Budějovický Budvar NP* [2004] ECR I-10989, paragraphs 41 to 44 and 55.

This indicates that I need to interpret sections 55 and 60 of the Act in a manner consistent with how Community legislation in relation to TRIPs is interpreted.

73. Turning to the ECJ case referred to by the Appointed Person, Case C-245/02 *Anheuser-Busch Inc v. Budějovický Budvar NP*, reported as [2005] ETMR 27, and also taking note of the case law cited in this case, the ECJ makes it clear that national authorities, such as the Trade Marks Registry in the UK, who are responsible for interpreting national law in an area where European Community legislation already exists, such as trade marks, should do so in a manner consistent with Community law. The ECJ states:

“42 Since the Community is a party to the TRIPs Agreement, it is indeed under an obligation to interpret its trade mark legislation, as far as possible, in the light of the wording and purpose of that agreement (see, with respect to a situation falling within the scope of both a provision of the TRIPs Agreement and Directive 89/104, Case C-49/02 *Heidelberger Bauchemie* [2004] E.C.R. I-0000, [20]).”

and continues:

“55 [...], it follows from the Court's case law that, when called upon to apply national rules with a view to ordering measures for the protection of rights in a field to which the TRIPs Agreement applies and in which the Community has already legislated, as is the case with the field of trade marks, the national courts are required under Community law to do so, as far as possible, in the light of the wording and purpose of the relevant provisions of the TRIPs Agreement (see, to that effect, *inter alia*, *Parfums Christian Dior SA v Tuk Consultancy BV*; *Asco Gerüste GmbH, Rob van Dijk v Wilhelm Layher GmbH & Co KG, Layher BV*, Joined Cases C-300/98 and C-392/98, [2001] E.T.M.R. 26, [42] to [47]).

56 Moreover, according to that case law, the competent authorities called on to apply and interpret the relevant national law must likewise do so, as far as

possible, in the light of the wording and the purpose of Directive 89/104 so as to achieve the result it has in view and thereby comply with the third paragraph of Art.249 EC (see, *inter alia*, Case C-218/01 Henkel [2004] E.C.R. I-0000, [60] and the case law cited there).

and continues at:

**66** According to the preamble, the purpose of the TRIPs Agreement is to "reduce distortions and impediments to international trade" by "taking into account the need to promote effective and adequate protection of intellectual property rights" while at the same time ensuring that "measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade".

[.....]

**70** It follows from those factors that the interpretation of the relevant provisions of the national trade mark law so far as possible in the light of the wording and purpose of the relevant provisions of Community law, [..], is not prejudiced by an interpretation in keeping with the wording and purpose of the relevant provisions of the TRIPs Agreement (see [57] of this judgment).

[.....]

**72** Such an interpretation is, moreover, supported by the general purpose of the TRIPs Agreement, referred to in [66] of this judgment, which is to ensure that a balance is maintained between the aim of reducing distortions and impediments to international trade and that of promoting effective and adequate protection of intellectual property rights so as to ensure that the measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade (see, to that effect, [38] of *Schieving-Nijstad v Robert Groeneveld*, Case C-89/99, [2001] ETMR 59). [.....]

With the above comments clearly in mind, I conclude that I must interpret Section 55 and section 60 of the Act as amended by SI 1999/1899 which implement UK responsibilities under TRIPS into national law in a manner consistent with Community legislation.

74. The House of Lords in its judgement in *Regina v Henn and Darby [1981] AC 850*, noted, in relation to how community legislation is interpreted by their European Court counterparts, that this is often more based on the purpose that the legislation is seeking to achieve, a so-called teleological or purposive approach:

“The European court in contrast to English courts, applies teleological rather than historical methods to the interpretation of the Treaties and other Community legislation. It seeks to give effect to what it conceives to be the spirit rather than the letter of the Treaties; sometimes, indeed, to an English judge, it may seem to the exclusion of the letter”.

75. As mentioned above, under the TRIPs Agreement, all signatories, which

includes the European Community, and of interest in this case the UK and Thailand, have agreed to implement certain articles of the Paris Convention, including Article 6<sup>septies</sup>, and to treat WTO members and Paris Convention countries equally. Thus, the provisions implementing the TRIPs agreement into UK law must be interpreted in a manner consistent with Community legislation.

76. It is clear that when implementing an international agreement such as TRIPs into UK law, Parliament intends to fulfil rather than break this agreement (whether made by the UK direct or by the UK as part of the European Community. If there is doubt as to meaning of an Act intended to give effect to such an international agreement then it should be resolved in favour of the international agreement. The House of Lords made this clear in their judgment in *Quazi v Quazi* [1980] AC 744. This case concerned the Recognition of Divorces and Legal Separations Act 1971 (as amended), enacted into UK law to give effect to an international agreement, the Hague Convention of 1 June 1970 on the Recognition of Divorces and Legal Separation, so that divorces and separations obtained from proceedings in other national jurisdictions could be recognised under UK law. The case turned on how to interpret the words 'other proceedings' in the phrase "by means of judicial or other proceedings in any country". Did 'other proceedings' mean (a) any type of other proceedings used in other countries to achieve a divorce or separation or (b) did it mean only other types of judicial proceedings i.e. quasi judicial only. The common law favoured (b) it was argued, while the convention favoured (a) and the House of Lords agreed with the latter - the Convention was used as the basis to determine what was meant by the Act. Lord Diplock stated the general principle that:

“ ... Where Parliament passes an Act amending the domestic law of the United Kingdom in order to enable this country to ratify an international treaty and thereby assume towards other states that are parties to the treaty an obligation in international law to observe its terms, it is a legitimate aid to the construction of any provisions of the Act that are ambiguous or vague to have recourse to the terms of the treaty in order to see what was the obligation in international law that Parliament intended that this country should be enabled to assume. The ambiguity or obscurity is to be resolved in favour of that meaning that is consistent with the provisions of the treaty: see *Salomon v Customs and Excise Comrs* [1966] 3 All ER 871, [1967] 2 QB 116 and *Post Office v Estuary Radio* [1967] 3 All ER 663, [1968] 2 QB 740.”

and Lord Scarman added that:

“The Act, as its long title declares was ‘to amend the law relating to recognition of divorces and legal separations’. One of the purposes for which it was enacted was, as its preamble recites, the ‘ratification by the United Kingdom’ of the Hague Convention dated 1st June 1970 on the Recognition of Divorces and Legal Separations (it was ratified by the United Kingdom on 21<sup>st</sup> May 1974 and entered into force on 24<sup>th</sup> August 1975). The true metemorphosis for determining the meaning of the code of recognition introduced into the 1971 Act is therefore, not the common law but the Hague Convention (in both its authentic texts, French and English)”

77. Whilst the explanatory note to SI 1999/1899 mentioned above is expressed to

form no part of the statutory instrument, it may be taken into account for throwing light on its meaning and is of clear relevance to the construction of its provisions. This note clearly states that the amendments made to the Trade marks Act 1994 are to permit "any country which becomes a member of the WTO to be treated automatically as a Convention country".

78. A UK Act of Parliament has to read as a whole in order that an enactment within it is treated not as standing alone but falling to be interpreted in its context as part of the Act. Taking this construction as a whole approach enables the interpreter to perceive that a proposition in one part of the Act is, by implication modified by another provision elsewhere in the Act.

79. With all of the above points in mind, I now turn again to Sections 60 and 55. Section 55 provides the meaning of the term 'Convention country' that defines the scope of Section 60. Considering Section 55 as written, use of paragraph (aa) rather than use of paragraph (c) to identify the definition of the WTO agreement inserted by SI 1999/1899 is, in my view, significant. In this way, the definition of the 'WTO agreement' is inserted before paragraph (b) and is intended to provide further information in relation to paragraph (b), i.e. that the definition of 'convention country' includes countries that implement the Paris Convention to the degree required by the WTO agreement (i.e. Article 1-12 and 19 of Paris Convention implemented through Article 2 of TRIPs) as well as countries that have signed the Paris Convention itself. By contrast, if the definition of WTO Agreement had been inserted as paragraph (c), then it would be a stand alone definition and would point to the definition of 'convention country' in paragraph (b) being a more literal one, i.e. Paris Convention as defined in paragraph (a).

80. If I now turn to Section 56 and consider the effect of the changes made by SI 1999/1899 to this section of the Act, I find a similar need for interpretation. Section 56(1) provides that

“References in this Act to a trade mark which is entitled to protection under the Paris Convention **or the WTO Agreement** as a well known mark are to a mark which is well known in the United Kingdom as being a mark of a person who –

- (a) is a national of a **Convention country**, or
- (b) is domiciled in ..... a **Convention country**. [.....]”  
*(emphasis added by me)*

SI 1999/1899 inserted the phrase “or the WTO Agreement” only once in this section yet the word convention appears three times, once specifically when the 'Paris Convention' is referred to and twice when 'a convention country' is referred to. To make sense, the meaning of 'convention country' in this section has to be construed in the same way as it was in relation to Section 55. Section 56 only makes sense if 'a convention country' applies to countries that implement the Paris Convention to the degree required by the WTO agreement (i.e. Article 1-12 and 19 of Paris Convention implemented through Article 2 of TRIPs) as well as countries that have signed the Paris Convention itself. This is clear from the first line of the provision. Similar reasoning also applies to the meaning of 'a convention country' in Section 57 (see parts (1) and (6) of section 57) and 'convention countries' in Section 58 (see part (1)).

81. The need for this interpretation is, I think, also clear with regard to these sections because it is the reference to 'the Paris Convention' in each of these sections that is amended by SI 1999/1899 to also refer to the 'WTO Agreement'. This amendment makes it clear that these Sections of the Act are to apply to countries that have implemented the provisions of the Paris Convention either directly or indirectly by through the WTO Agreement.

82. Section 60 differs somewhat from Sections 56, 57 and 58 in that there is no reference to the Paris Convention in this section that required amendment by the SI and so it was left untouched. Thus the need to interpret the meaning of 'convention country' in section 60 in the way we have done to include WTO member countries was not so apparent. Given the intention of the SI as mentioned above, the intention of the UK Parliament to implement TRIPs and the need to implement national provisions in an area where the community has legislated in a manner consistent with community law, I conclude that section 60, in light of section 55, must apply equally to countries that have implemented the Paris Convention directly or have implemented Articles 1-12 and 19 of the Paris Convention through the WTO and TRIPs Agreements. As I have indicated above, Section 60 corresponds to Article 6*septies* of the Paris Convention and so falls within the scope of the latter.

### **Conclusion**

83. Taking all of the above into account, I consider that Section 60, in light of Section 55, of the Act applies to:

- (a) countries that are signatories of the Paris Convention, and
- (b) countries, like Thailand, who while being members of the WTO and are signatories of the TRIPs agreement are not signatories of the Paris Convention, but are implementing articles 1-12 and 19 of Paris Convention through their membership of WTO and TRIPs.

84. Thus while I have come to the same conclusion in this matter as Kerly's did (see above), I have found it necessary, because of the wording used in section 55, to go back to the beginning as it were and examine this matter in much greater detail. Why the changes made to these sections of the Act were not more explicit or clear on this issue, I cannot answer. However, I have to bear in mind that looking back in hindsight is always easier than trying to anticipate what problems or difficulties may arise in the future in regard to a particular legislative change.

85. In this particular case, I conclude that Sribhan is entitled to seek rectification under Section 60(3)(b) of the Act.

### **THE SECOND QUESTION**

#### **Rectification under Section 60(3)(b)**

86. Sribhan is seeking rectification of the UK Trade Marks Register in relation to UK trade mark registration number 2108705. It is seeking to be named as the registered proprietor of this registration under Section 60(3)(b) instead of the current registered proprietor Checker.

87. Sribhan is a manufacturer of fine leather goods based in Thailand and is proprietor of Thai trade mark registration Kor 50849 in Thailand. Checker is the registered proprietor of UK trade mark registration 2108705. Both registrations are reproduced in Table 2 below. Sribhan claims that Checker is a successor in title to its agent or representative Vannoort in the UK and so it should be listed as the rightful proprietor of UK registered trade mark 2108705.

### Relevant Date

88. According to Section 60(6) of the Act, an application for rectification under section 60(3)(b) must be made within three years of the proprietor of the mark becoming aware of the registration in the UK.

89. According to paragraph 12 of the first witness statement of Mrs Davidson, Sribhan become aware of Trade Mark Registration 2108705 when they received the letter dated 7 July 2003 from Checker stating that they were the registered proprietor of this trade mark and that only Checker had the right to sell leather goods in class 18 under the JACOB brand in the UK. The rectification action was launched by Sribhan at the UK Trade Marks Registry on 12 July 2005 [by filing of a form TM26(R)]. This falls within the three year time limit for action set by Section 60(6) of the Act.

Table 2: Trade Mark Registrations held by Sribhan and Checker

Registration	Thai Kor 50849	UK 2108705
Trade Mark		
Goods (Class 18)	Bags / Purses	Bags, backpacks, cases, travel bags, sports bags, briefcases, handbags, satchels, purses, wallets and key holders.
Registered Proprietor	Sribhan Jacob C. Ltd Cheun Fah Ltd Jacob International Co. Ltd P.T. Trading Co. Ltd.	Checker Leather Limited

### UK Agent or Representative

90. In order for Sribhan to succeed in their application under Section 60(3)(b) of the Act, I have to be satisfied that the current registered proprietor is an agent or representative of Sribhan or is the successor in title of such an agent or representative.

91. It is clear from the evidence of Mr Pattison that Checker and Sribhan have never had a commercial relationship let alone one where Checker has been an agent or representative of Sribhan (see paragraph 8 of witness statement). The only interaction between Checker and Sribhan has been correspondence in relation to use of the registered trade mark in the UK and Checker's successful attempt to get Taurus to stop selling Sribhan produced goods using the same trade mark. Thus at no time was Checker an agent or representative of Sribhan.

92. To answer the question of whether Checker is successor in title to an agent or representative of Sribhan, it is necessary for me to examine the relationship between the various companies that Sribhan traded with in the UK and to consider in particular their use of the trade mark JACOB. In order to avoid any confusion in this task, I have summarised the different names and trading names of the companies in the UK that Sribhan has traded with (see Table A in Annex to this decision) as well as the various forms of the trade mark JACOB that these companies have used in references to goods in class 18.

93. From Mrs Davidson's first witness statement and associated exhibits, it is clear that Sribhan have sold leather goods to a number of companies in the UK since 1980. Sribhan entered into a sole agency agreement with Bettonhouse Limited, trading as Roben Marketing Consultancy, to sell its leather goods in the UK and Ireland. This is clear from the agency agreement provided in Exhibit JBD2 by Mrs Davidson. Thus, I am satisfied that Bettonhouse Limited was the sole agent or representative for Sribhan in the UK at this time

94. The sole agency agreement makes it clear that the leather goods being sold by Sribhan were manufactured by Cheun Fah (see introductory paragraph of exhibit JBD2). Mrs Davidson confirms in her first witness statement that Cheun Fah and Sribhan Jacob are part of the same commercial operation stating that "my employer is also known as Cheun Fah" (see paragraph 11). They are both listed as registered proprietors of Thai trade mark registration Kor 50849 in Exhibit JBD1. Thus I consider that invoices addressed from either Sribhan or Cheun Fah relate to JACOB leather goods which are manufactured and sold by the same commercial operation.

95. Exhibit JBD4 shows that the Roben Marketing Consultancy was using the same form of trade mark on leather goods such as attaché cases, bags and wallets as UK registration 2108705. The mark can be clearly seen on the back panel and pillar of the exhibition stand in the photograph as dark text on a white background and in the sign in the bottom right hand corner as white text on a dark background. The exhibition stand is clearly labelled with "JACOB" on the top line of the stand title and with "ROBEN MARKETING CONSULTANCY" underneath. The exact date of this exhibition could not be fixed by Mrs Davidson who states that it occurred in the UK, in Birmingham, in the "Beller & Erdem Years" which were the "early 1980s" (see paragraph 7, first witness statement). She also states that Sribhan supplied all the goods displayed in this photograph. I note that Checker has not contested this evidence. I am satisfied that on balance this photograph relates to an event in the UK that took place in the early 1980s, i.e., after 12 May 1980, when Bettonhouse Limited trading as Roben Marketing Consultancy entered into the agency agreement with Sribhan referred to in Exhibit JBD2. This is sufficient, in my opinion, to show use of the trade mark in the form applied for in UK registration 2108705 prior to the date of

registration. Also this is use by a company in the UK who were acting as an agent or representative of Sribhan.

96. In paragraph 5 of her first witness statement Mrs Davidson states that Roben Beller Marketing applied for registration of UK trade mark 1147235 for the word mark JACOB for various leather and imitation leather goods in class 18 on 19 January 1981. This application was later abandoned. Roben Beller Marketing Ltd has the same address as Roben Marketing Consultancy, the trading name for Bettonhouse Limited who signed the Agency Agreement with Sribhan in May 1980 (163 Holland Park Avenue London W11 4UR). Mrs Davidson goes on to explain that “Roben Marketing Consultancy was run by two gentlemen named Mr Beller and Mr Erdem who were directors. They split up in the early 1980’s and Mr Erdem disappeared with unpaid debts leaving Mr Beller in charge” (see paragraph 6, first witness statement of Mrs Davidson). Mr Beller then, in Mrs Davidson’s words, ‘entered business with a Mr Cyril Shack who traded as City Cash & Carry Limited of 16 Andrew’s Road, Hackney, London E8 4QL and a verbal agreement was entered into to sell our JACOB goods”. City Cash & Carry Limited, the name more commonly used in the evidence from Sribhan, is the trading name of Bailey Brook Limited, the name more commonly used by Checker and Vannoort. As Exhibit JBD5 shows, Sribhan and Cheun Fah were using the trade mark JACOB in the stylised form of the current registration on 8 March 1989 and they were also aware that City Cash & Carry was a trading name of Bailey Brook Limited. Two of the invoices exhibited in JBD6, dated 22 and 27 March 1989 confirm that City Cash & Carry/Bailey Brook Ltd purchased leather goods worth approximately US dollars \$30,000 from Cheun Fah/Sribhan. However, as the text of JBD5 implies, City Cash & Carry Ltd was having some difficulties in selling these leather goods (see note (2) of Exhibit JBD5) and Mr Cyril Shack, in the words of Mrs Davidson, “lacked sufficient expertise in the leather goods retail sector, and he sold that part of the business to Mr Robert Finch of Vannoort Limited” (see paragraph 10 of her first witness statement). This occurred in 1990.

97. Mr Finch (see paragraphs 1-4 of his witness statement) confirms Mrs Davidson’s statement (see paragraph 10 of her first witness statement) that Vannoort Limited acquired all the assets of City Cash & Carry/Bailey Brook Ltd in 1990. Mr Finch was the managing director of Vannoort Limited which changed its name on 13 December 2001 to Van Gestel Limited. Mr Finch was also a Managing Director of Van Gestel Limited until it was dissolved on 23 December 2003. Prior to this the goodwill and assets of Van Gestel Limited were sold by Mr Finch to Checker Leather Limited, the company of which Mr Pattison is Managing Director.

98. Included in the assets that Mr Finch purchased from City Cash & Carry/Bailey Brook Limited was trade mark registration 1204192 for the word mark JACOB for various goods in class 18 made from leather or imitation leather (see below). I take judicial notice of the fact that the applicant for this trade mark was Marcel Beller of 1 Hive Close, Bushey Heath, Hertfordshire, UK and that this registration was applied for on 28 September 1983. Mr Beller assigned this mark to Jacob House Limited on 9 May 1989, who in turn assigned the mark to Jacob Limited on 11 May 1989. Both of these transactions were recorded at the Trade Marks Registry. Mr Finch states in paragraph 5 of his witness statement that this mark was then assigned from Jacob Limited to Bailey Brook Limited and then from Bailey Brook Limited to Vannoort Limited. However, neither of these transactions were recorded at the Trade Marks

registry. I am satisfied that the applicant for this trade mark registration was the same Mr Beller who was a director of Roben Marketing Consultancy and of Roben-Beller Marketing, the applicant for registration 1147235.

99. Mr Finch then goes on to explain that because registration number 1204192 was not placed in the care of a Trade Mark Agent, it was inadvertently allowed to lapse (see paragraph 5 of his witness statement). Mr Finch filed a fresh application which became current trade mark registration 2108705, “in order to protect my company’s rights in the Mark and the goodwill that it had acquired from Bailey Brook Limited”. Table 3 below shows a comparison of the various JACOB marks used by UK companies who dealt with Sribhan. As this table shows, the application for 2108705 was not for the same mark and was for a broader range of goods than the earlier registration 1204192. The class 18 goods applied for in this registration were not limited to goods made from leather or imitation leather as were the goods applied for in registration 1204192. The form of the mark was not the simple word JACOB but rather the stylised form shown in Table 3 below.

100. It is clear from Exhibit JBD6, that Cheun Fah sold a significant amount of leather goods to Vannoort as summarised in Table 1 above in the period 1997 to 2001. Thus Vannoort had a clear commercial relationship with Cheun Fah the manufacturer and exporter of JACOB leather goods. I find it hard to believe, despite what Mr Finch says that, he or his company was not aware that JACOB was a trade name, brand name or trade mark being used by one of its suppliers.

Table 3: A comparison of the various JACOB marks used by UK companies who dealt with Sribhan.

Applicant	Roben Beller Marketing Ltd	Marcel Beller	Vannoort Limited
Trade mark	JACOB	JACOB	
UK Registration number	1147235 (withdrawn)	1204192	2108705
Class 18 Goods	Articles made of leather and imitation leather; skins, hides, trunks and travelling bags; whips, harness and saddlery	Attache cases, bags included in Class 18, briefcases, articles of luggage, purses, suitcases, trunks and pocket wallets, all made of leather or of imitation leather	Bags, backpacks, cases, travel bags, sports bags, briefcases, handbags, satchels, purses, wallets and key holders.
Filing Date	19 January 1981	28 September 1983	29 August 1996

101. It is clear from all the invoices that Sribhan and Cheun Fah sent to Vannoort in this period that both of these companies supply leather goods identified by the word JACOB. The word JACOB appears on all the correspondence between Cheun Fah or Sribhan and Vannoort either as the word alone or in same form as Thai trade mark registration Kor 50849. From this I conclude that, on balance, Vannoort could not have avoided being aware of the fact that Sribhan & Cheun Fah sold leather goods identified by the trade mark JACOB.

102. Thus, taking account of all the above, I am satisfied that Mr Beller who was a director of Roben Marketing Consultancy, a company who were acting as agents for Sribhan in the UK, applied to register the word mark JACOB in the UK for goods in class 18. This first application, filed in 1981, in the name of Roben Beller Marketing Consultancy did not complete registration. It appears to have been abandoned and then withdrawn when Roben Marketing Consultancy collapsed with the departure of Mr Erdem. Mr Beller then made a second application to register the word mark JACOB in the UK for goods in class 18 in 1983. This competed registration in the UK under registration number 1204192. This trade mark then passed in succession from Marcel Beller to Jacob House Limited to Jacob Limited to Bailey Brook to Vannoort Limited. The first two assignments were recorded, the last two were not on the Trade Mark Register. This registration expired in 1991 because the renewal fee was not paid and Vannoort Limited then applied in 2001 for current registration 2108705 for goods in class 18 using a stylised form of the word JACOB. I am not persuaded that Vannoort would have been unaware of the relationship between Sribhan and Bailey Brook trading as City Cash & Carry. Vannoort would have had access to the details of Bailey Brooks trading activities when it took the company over and it continued to buy goods from Sribhan. Thus it would have been aware of and/or exposed to the same information as Bailey Brook, i.e., that Sribhan and Cheun Fah are part of the same commercial group, that they manufacture and export leather goods under the brand name JACOB and that Sribhan and Cheun Fah had used a stylised form of the word Jacob to identify their goods.

103. The stylised form used in registration no. 2108705 is the same as that shown in Exhibit JBD4 above. It differs only from that shown in Exhibit JBD5 (see heading of letter which shows stylised mark in dark text on white background) in that it is white text on a dark background. In the context of a comparison of marks for the purposes of opposition or revocation, this is not enough to distinguish these two marks, as it does not alter the distinctive elements of the mark, in this case the word JACOB in a cursive script. Thus, for all intents, the mark as registered is identical to a mark that was being used by Sribhan in its correspondence with City Cash & Carry, the trading name of Bailey Brook Ltd.

104. I do not find any evidence that Vannoort made significant efforts to build up the trade in goods covered by the current registration that would allow them to obtain registration for the trade mark JACOB in their own right. I find no evidence to support the claim by Mr Finch that goods supplied to Vannoort were branded as JACOB goods at his or his company's instruction. Although Mr Finch states that his company's goods were purchased from many companies and then branded by all these companies with the JACOB mark owned by Vannoort Limited at their request, he produces no evidence to support this statement or his general observation that this type of practice is common in the trade. Although Checker in their written

submission mentioned the names of a number of other Thai leather goods producers that Checker or Vannoort could have used, no evidence is provided to show that they were used or that they provided leather goods with the JACOB trade mark applied to them at the request of Vannoort or Checker. Thus I find that, on balance, Checker or their predecessor in title, Vannoort, would not be able to show sufficient justification under section 60(5) to deny the request for rectification under section 60(3)(b).

105. Altering the form of the trade mark from the simple word mark JACOB in registration no. 1204192 to the stylised version used in registration no. 2108705 is not in my opinion sufficient to alter the distinctive element of the trade mark – the word JACOB. Indeed, the stylised form of the word Jacob appears to be much closer in form to that used in Sribhan’s original Thai registration as shown in Table 2 above. The goods covered by registration no. 2108705 include all the goods covered by expired registration no. 1204192 which in turn covers all the goods covered by Thai registration KOR50849. i.e., purses and bags. I am satisfied that all the goods listed in the invoices in Exhibit JBD6 that were sent to Bailey Brook/City Cash & Carry and Vannoort Limited were all goods made from leather and identified by the brand JACOB. The different types of wallets and purses referred to in these invoices, for example, the invoice dated June 10, 1997 to Vannoort, list different types of leather e.g. ostrich embossed cow hide, polishing cow hide. I am satisfied Vannoort could not have avoided the knowledge that Sribhan and Cheun Fah branded all of their goods as JACOB in a form that is identical or, if not identical, is not sufficient to alter the distinctive elements of the registered trade mark. I do not believe that Vannoort’s choice of the word JACOB in the stylised form shown in the current registration was accidental or a coincidence.

106. There is a significant disagreement between the parties as to the relevance of Exhibit JBD7. This exhibit clearly shows the word JACOB in stylised form identical to that in registration no. 2108705. It is signed by Mr Robin Finch and it appears on headed paper clearly identifying Vannoort Limited. Mr Finch claims that he signed this letter at the request of Mrs Davidson, who wrote it, in support of Sribhan so that they could claim a trade prize from the Thai Government. At the time that he did so, July 1997, Mr Finch states that “I worked as a consultant for the UN and on occasions for the Thai Leather Goods Association” and it was for these reasons that he was asked to sign the letter. However, at no point in the letter is it made clear that Mr Finch is writing the letter in any capacity other than as an employee or representative of his company Vannoort Limited. Mrs Davidson in paragraph 11 of her first witness statement points out that the text of this letter makes it clear that Jacob is a “well established Thai Brand”, and that Vannoort “has been marketing the products of ‘Jacob-Thailand’ (Cheun Fah) for a considerable number of years’. The foot of this letter shows the stylised JACOB trade mark and also states that Vannoort are ‘Distributors of Exclusive Leather Goods’. Clearly, Mr Finch must have been aware of all these facts when he signed the letter and would have had an opportunity to change them if he saw fit. The letter is dated 1997 and, from the invoices exhibited as JBD6, relates to a time when Vannoort was regularly purchasing goods from Sribhan/Cheun Fah. This clearly implies that Vannoort was well aware of the existence of Sribhan and Cheun Fah and of their use of the trade name JACOB to brand their goods.

107. Although Mrs Davidson states that her company 'mysteriously' lost contact with Mr Finch of Vannoort Limited in 2002, she has not provided any information regarding what efforts, if any, Sribhan made to find out why they had lost contact with Mr Finch and Vannoort Limited (see paragraph 10 of her first witness statement). The last invoice in Exhibit JBD6 for goods from Sribhan to Vannoort was dated 3 May 2001. Mr Finch states that his company Vannoort changed its name to Van Gestel Limited in December 2001 and Mr Finch and Mr Pattison confirm that trade mark registration number 2108705 was assigned to Checker Leather Limited in May 2002. I think that it is reasonable to expect that there would have been some mechanism of regular contact between supplier and distributor in terms of letter, FAX or telephone and that it would have been possible to show that efforts had been made to make contact, even allowing for the significant time and geographical distance between UK and Thailand. However, I do note that although it was only 12 months between the dates of the invoice sent by Sribhan to Vannoort and the sale and assignment of the trade mark registration to Checker, this was also the period in which Vannoort underwent its name change to Van Gestel. This would have made things more difficult in terms of communication especially if Sribhan had no knowledge of this change. I am prepared to accept that if one side does not want to be in contact with the other then letters, Faxes and telephone contacts will go unanswered and that 12 months is not all that long in the context of communication between a company in Thailand and one in the UK. I do consider it relevant that this loss in contact between Vannoort and Sribhan did occur shortly before the change in company name and sale of assets mentioned above.

108. I am satisfied that the mark in the form as registered was in use by Sribhan and Cheun Fah prior to its use by Vannoort and its successors in title Van Gestel and Checker. I find also that the mark as registered does not differ in a distinctive way from the form of the trade mark in UK trade mark registration number 1204192 which was purchased by Vannoort as part of the assets of Bailey Brook. The original applicant for trade mark registration 1204192 was Marcel Beller who was director of a company who had a distribution agreement with Sribhan and Cheun Fah.

109. I am not fully convinced that Sribhan and Vannoort had a distribution agreement of the type that existed between Sribhan and Bettonhouse. I am sure that if they had such a written agreement, Sribhan would have provided it in evidence. However, I am satisfied that Checker's predecessor in title, Vannoort, were fully aware that Sribhan and Cheun produced and sold leather goods under the trade name JACOB. I am also satisfied that, as indicated above, use of the trade mark JACOB for such goods in the UK can be traced back to Vannoort's predecessors in title, Bailey Brook Ltd, Jacob Ltd, Jacob House Ltd., Marcel Beller, Roben-Beller Marketing and Roben Marketing Consultancy, the trading name of Bettonhouse Ltd, who were agents of Sribhan and Cheun Fah in the UK. At the time of the application, Checker were the sole distributor of JACOB goods in the UK and they have taken steps, where necessary, to prevent others from selling or distributing JACOB branded goods in the UK (see Witness statement of Mr Pattison and Exhibit PP4). Thus, there was only one source in the UK of goods branded in the same way, for all intensive purposes, as those produced by Sribhan in Thailand (see above discussion).

110. I do not think that it is a coincidence that UK Trade Mark applications were filed for the mark JACOB by Mr Beller either by a company he was involved with in

1981, i.e., Roben Beller Marketing, or directly by Mr Beller as an applicant in 1983. I am satisfied that Mr Beller was attempting to obtain a registration in the UK for the trade mark Jacob for goods in class 18. I am satisfied that Mr Beller was aware that these goods were manufactured by Cheun Fah in Thailand and supplied to a company Mr Beller was involved in, i.e., Bettonhouse Limited trading as Roben Marketing Consultancy, for sale in the UK as part of an agency agreement between Sribhan and Bettonhouse.

## **Conclusion**

111. Taking all of the above into account, I conclude that, on balance, there is sufficient evidence to show that Checker Leather Limited is successor in title to Bettonhouse Ltd, trading as Roben Marketing Consultancy. Bettonhouse Ltd were sole agents in the UK for Sribhan Jacob Limited of Thailand. At the time of the application for rectification, Checker was the sole distributor of JACOB branded goods in the UK. As a consequence, I find that, as successor in title and sole distributor of goods bearing the JACOB band in the UK at the time of the application, Checker must also be considered as the agent or representative of Sribhan in the UK and this is sufficient to entitle Sribhan to seek rectification of the Trade Mark Register under Section 60(3)(b) of the Act..

## **DECISION**

112. The applicant Sribhan, a company based in Thailand, is entitled to seek rectification under Section 60(3)(b) of the Act.

113. The application to have the UK Trade Mark register rectified to show Sribhan instead of Checker as the registered proprietor of trade mark registration number 2108705 for various leather goods in class 18 succeeds.

## **COSTS**

**114. As Sribhan has succeeded in their action for rectification of the register under Section 60(3)(b), I order Checker to pay the sum of £900 as a contribution towards their costs. 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 this 18th day of June 2007**

**Dr Lawrence Cullen  
For the Registrar,  
the Comptroller-General**

# ANNEX

## THE PARIS CONVENTION

### **Provisions of Paris Convention Implemented into UK law by Sections 56-59 of Trade marks Act 1994**

1. Sections 56-59 implement Article *6bis* and Article *6ter* of the Paris Convention. These provisions ensure that well-known marks, emblems of convention countries, such as flags, and emblems of certain international organisations, such as the Olympic Organisation or the United Nations, recognised under the Paris Convention are given equivalent protection under UK law and how such matters should be notified to the UK.

### **Article 6septies of the Paris Convention**

2. Article 6septies of the Paris Convention reads as follows:

*“Marks: Registration in the Name of the Agent or Representative of the Proprietor Without the Latter’s Authorization*

(1) If the agent or representative of the person who is the proprietor of a mark in one of the countries of the Union applies, without such proprietor’s authorization, for the registration of the mark in his own name, in one or more countries of the Union, the proprietor shall be entitled to oppose the registration applied for or demand its cancellation or, if the law of the country so allows, the assignment in his favour of the said registration, unless such agent or representative justifies his action.

(2) The proprietor of the mark shall, subject to the provisions of paragraph (1), above, be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use.

(3) Domestic legislation may provide an equitable time limit within which the proprietor of a mark must exercise the rights provided for in this Article.”

## THE TRIPS AGREEMENT

### **Articles 2 and 3 of the TRIPS Agreement**

3. Articles 2 and 3 of the TRIPS agreement reads as follows:

#### *“Article 2 - Intellectual Property Conventions*

1. In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12, and Article 19, of the Paris Convention (1967).

2. Nothing in Parts I to IV of this Agreement shall derogate from existing obligations that Members may have to each other under the Paris Convention, the Berne Convention, the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits.

### ***Article 3 - National Treatment***

1. Each Member shall accord to the nationals of other Members treatment no less favourable than that it accords to its own nationals with regard to the protection of intellectual property, subject to the exceptions already provided in, respectively, the Paris Convention (1967), the Berne Convention (1971), the Rome Convention or the Treaty on Intellectual Property in Respect of Integrated Circuits. In respect of performers, producers of phonograms and broadcasting organizations, this obligation only applies in respect of the rights provided under this Agreement. Any Member availing itself of the possibilities provided in Article 6 of the Berne Convention (1971) or paragraph 1(b) of Article 16 of the Rome Convention shall make a notification as foreseen in those provisions to the Council for TRIPS.

2. Members may avail themselves of the exceptions permitted under paragraph 1 in relation to judicial and administrative procedures, including the designation of an address for service or the appointment of an agent within the jurisdiction of a Member, only where such exceptions are necessary to secure compliance with laws and regulations which are not inconsistent with the provisions of this Agreement and where such practices are not applied in a manner which would constitute a disguised restriction on trade.”

**Table A: Summary of names and interactions between Sribhan and various UK companies including use of various JACOB trade marks**

DATE	EVENT	UK COMPANY INVOLVED	TRADE MARK INVOLVED
	<p>Registration of mark in Thailand KOR 50849 Since 1956 for purses in International class 18</p> <p>Sribhan Jacob Co Ltd Cheun Fah Limited Partnership &amp; 2 others</p>		 <p>Thai TM Kor 50849</p>
1980	<p><b>Sribhan Jacob Company Limited,</b> 78 Bumrungruang Road, Wat Rachobopliith, Pharnakorn, Bangkok 10200, Thailand</p> <p>Leather goods sold by Sribhan were manufactured by <b>Cheun Fah Limited Partnership</b> 66/1 Asdang Road, Bangkok Thailand</p> <p>Both companies are part of the same group.</p> <p>Agency Agreement signed on 12 May 1980, between <b>Sribhan</b> as principal &amp; <b>Bettonhouse</b> Ltd as agent, Cheun Fah listed as manufacturer of the Goods</p>	<p><b>Bettonhouse Ltd t/a Roben Marketing Consultancy,</b> 163 Holland park Avenue; London W11 4UR</p>	

1981	<p>UK Application for trademark No 1147235 JACOB (word only)</p> <p>Filing Date: 19 January 1981 Application withdrawn 12 May 1989</p> <p>Applicant was <b>Roben Beller Marketing</b></p>	<p><b>Roben Beller Marketing</b></p> <p>163 Holland Park Avenue, London, W11 4UR</p>	<p><b>JACOB</b> (word only)</p> <p>UK TM 1147235 (appln)</p>
1989	<p>Mr Cyril Shack and Mr Marcel Beller 'enter business'</p>	<p><b>City Cash &amp; Carry Limited</b> or <b>Bailey Brook Limited t/a City Cash &amp; Carry Limited</b> 16 Andrew's Road, Hackney, London, E8 4QL</p>	
1987	<p>UK trade mark registration 1204192 (goods in class 18) registered on 6 February 1987 <i>[Attache cases, bags included in Class 18, briefcases, articles of luggage, purses, suitcases, trunks and pocket wallets, all made of leather or of imitation leather]</i></p> <p>Applicant for TM was <b>Marcel Beller</b></p> <p>Filing date: 28 September 1983 Renewal date: 28 September 1990 Expiry date: 6 January 1991</p> <p>TM1204192 part of the assets of <b>Bailey Brook t/a City Cash &amp; Carry Limited</b></p> <p>Expired because renewal fee not paid</p>	<p>Assigned on 11 May 1989 to <b>Jacob Ltd</b> Hadstock House Hadstock Cambridge CB1 6NY</p> <p>from <b>Jacob House Limited</b></p> <hr/> <p>Assigned on 9 May 1989 to <b>Jacob House Limited,</b> 130-134 Pentonville Road, London N1 9JF</p> <p>from <b>Marcel Beller</b> 1 Hive Close, Bushey Heath Hertfordshire</p>	<p><b>JACOB</b> (word only)</p> <p>UK TM 1204192</p>

1990	<p>Mr Finch of <b>Vannoort</b> purchased assets of <b>Bailey Brook t/a City Cash &amp; Carry Limited</b> in 1990</p> <p>Invoices from Cheun Fah - “Jacob” leather goods manufacturer &amp; exporter</p> <p>Sales dated 1997 (14/3; 10/6; 26/8; 13/11); 1998 (23/3; 21/5; 15/7; 29/8; 3/11)</p> <p>Invoices from Sribhan Jacob Co Ltd</p> <p>Sales dated 1999 (5/10); 2000 (12/2; 4/7; 27/10); 2001 (3/5)</p>	<p><b>Vannoort Limited</b></p> <p>48 Roman Way Longridge Road Ribbleton Preston PR2 5BD</p>	
1996	<p>UK trade mark registration 2108705 (goods in class 18) registered on 19 September 1997 <i>[Bags, backpacks, cases, travel bags, sports bags, briefcases, handbags, satchels, purses, wallets and key holders]</i></p> <p>Filing Date: 29 August 1996 Registration Date: 19 September 1997</p> <p>Vannoort Ltd was applicant</p>	<p>Vannoort Limited</p>	 <p>UK TM 2108705</p>
2001	<p>Change of name registered at Companies House 13 December 2001.</p> <p>Name change made by Mr Robin Finch , Managing Director of Vannoort who held same post for Van Gestel Limited</p>	<p><b>Van Gestel Limited</b></p> <p>Charter House, Garstang Road, Fulwood, Preston PR2 4NB</p>	

2002	Assets of Vannoort Limited sold to Checker Leather Ltd by Mr Robin Finch	<b>Checker Leather Limited</b>  The Station, Crosshouse Road, Kilmaurs, Ayrshire KA3 2TU	
2002	Assignment of UK TM registration 2108705 from Van Gestel Ltd to Checker Leather Ltd recorded on TM register on 14 June 2002	Checker Leather Limited	