

O-392-12

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 2540311
IN THE NAME OF ALAN LOVELL
IN RESPECT OF THE TRADE MARK:**

THE SWINGING BLUE JEANS

IN CLASS 41

AND

**AN APPLICATION TO RECTIFY THE REGISTER (UNDER NO. 83820) BY
RAY ENNIS**

THE BACKGROUND AND PLEADINGS

- 1) Registration 2540311 is for the trade mark THE SWINGING BLUE JEANS in respect of various musical production, recording and entertainment services in Class 41. It currently stands in the name of Mr Alan Lovell. The application for rectification relates to a dispute over ownership.
- 2) The trade mark was filed on 26 February 2010 by Mr Lovell and following publication in the Trade Marks Journal it completed its registration procedures on 4 June 2010.
- 3) On 28 June 2010, Mr Ray Ennis filed an application to rectify the register claiming that Mr Lovell is a former employee of Mr Ennis and that Mr Lovell has neither the authority nor consent to register the mark in his name. In his witness statement of 18 June 2010, Mr Ennis states that he formed the band "The Swinging Blue Jeans" in 1960 and that in 1966, two of the original band members left and the third died. He states that he became the sole proprietor in 1966.
- 4) Mr Ennis also states that Mr Lovell had been employed by him, as a musician, for the last ten years and was still employed by Mr Ennis at the time he filed the trade mark application.
- 5) Mr Lovell subsequently denied that he is a former employee of Mr Ennis or that Mr Ennis has been solely using the name "The Swinging Blue Jeans" and claims that he does not need the authority or consent of Mr Ennis, or any other party, to register the mark in his name. He further claims that Mr Ennis retired from the performing group known as "The Swinging Blue Jeans" on 30 May 2010 (i.e. before the mark became registered in the name of Mr Lovell).
- 6) Mr Lovell believes that Mr Ennis' objection is misfounded and is made in bad faith, especially as it has transpired that Mr Ennis has purportedly granted a licence to use the mark to a Mr Dicon Hubbard and Mr Mike Sweeney on 28 July 2010 with effect from 1 June 2010. Mr Lovell contends that these persons are totally unconnected to the performing group and that the attempt to licence the mark to them is deliberately calculated to mislead the public and is intended to seek to deprive Mr Lovell of his livelihood by preventing him from continuing to perform with others, as the band "The Swinging Blue Jeans".
- 7) Both sides filed evidence in these proceedings and both sides ask for an award of costs. The matter came to be heard on 13 June 2012 when Mr Lovell was represented by Mr Jeremy Heald of Counsel, instructed by Forrester Ketley & Co. Mr Ennis was represented by Mr Ian Morris for Kuit Steinhart Levy. Both Mr Ennis and Mr Lovell attended for cross examination.

Documentary Evidence

- 8) This takes the form of three further witness statements from Mr Ennis, dated 3

November 2010, 9 July 2011 and 23 January 2012 respectively and two witness statements by Mr Lovell, dated 4 June 2011 and 10 December 2012. There is also a witness statement by Peter Oakham, a further musician performing as part of The Swinging Blue Jeans and is submitted as part of Mr Lovell's evidence. At the hearing, I also permitted leave to admit a further witness statement, dated 13 June 2012, by Mr Ennis intended to clarify ownership issues regarding the band.

Undisputed facts and evidence

9) From the evidence submitted by the two parties, it appears that it is common ground that:

- The band was formed by Mr Ennis in 1957 and in 1963 it changed its name to "The Swinging Blue Jeans";
- The band had five singles and two albums released between 1963 and 1966 (see Exhibit RE2 of Mr Ennis' witness statement);
- The band has changed line up over the years, and Mr Ennis is the only original member who was still performing as The Swinging Blue Jeans at the date Mr Lovell made the application to register the mark;
- Following the death of guitarist, Colin Manley, in April 1999, Mr Lovell played lead guitar in all of the band's subsequent live performances;
- Mr Lovell was paid by Mr Ennis;
- Mr Ennis was in charge of the business side of the set-up, being in charge of booking etc.
- Mr Lovell was not involved in any of the band's studio recordings (all done in the 1960s);
- Mr Ennis told [the musicians playing as the Swinging Blue Jeans] that he intended to retire on 30 May 2010 following completion of the band's tour at that time.

Disputed facts and evidence

10) The parties do not agree in respect of the following issues:

- Mr Ennis claims that he is the only person who has rights in respect of The Swinging Blue Jeans (as evidenced by copies of contracts at Mr Ennis' Exhibits RE5 and RE6 showing Mr Ennis as "The Principal" and the band as "the Artist"). Invoices relating to the band's activities are also produced by Mr Ennis, at Exhibits RE7 and RE8 showing that they were addressed to him on behalf of the band. Similarly, the band's business bank account was in the name of "RV Ennis Esq" (see Exhibit RE9) and that Mr Lovell was paid from this account for his work as a self-employed musician hired by Mr Ennis to play in the band's live shows. Mr Ennis further claims that Mr Lovell was not involved in the day-to-day running of the band. Mr Lovell claims that he was, in fact, an important member of the band, being its lead guitarist and regular vocalist and "without missing a single engagement". He further submits that there is no legal documentation to support

the claim that Mr Ennis has ever been the sole proprietor of the band's name. Consequently, it is contended, that Mr Lovell did not have to consult Mr Ennis about filing the contested application.

- Whilst it is common ground that Mr Lovell was not involved in any studio recordings produced by "The Swinging Blue Jeans", Mr Lovell does point to a number of live recordings (see his Exhibits AL1 and AL5) on which he performed. Mr Ennis states these were bootleg recordings made without his permission.
- Mr Ennis claims that, once he had decided upon a date for retirement, he verbally approached Mr Lovell to ask if he was interested in keeping the band performing. He claims that Mr Lovell declined to take the band on. At this stage, Mr Ennis claims that he approached Diccon Hubbard and Mike Sweeney who, after a short deliberation agreed to perform under the name The Swinging Blue Jeans. Mr Lovell provides less detail about this, merely stating the following, in his first witness statement:

"9. On 14th August 2009, RE informed me and the other band members that he would be retiring at the end of the last tour on the 30th May 2010 and asked me if I would be interested in continuing with the SBJ after his retirement.

10. After deciding to continue with the SBJ, I thought it wise to protect the future livelihood of the band [by applying for the contested trade mark application]"

- Mr Lovell subsequently elaborated by explaining that initially, he did not take Mr Ennis seriously claiming that he was considering the offer and did not actually turn the offer down.
- A series of e-mails exhibited by Mr Ennis are helpful in shedding light on the issue and the relevant parts are reproduced below:

Mr Ennis' Exhibit RE12

22 September 2009, "rayjeans" to "bullet.man"

"Hi Dicon

...I have a problem which I would like you to discuss with Mike. My guitarist has e-mailed me saying he has changed his mind and would like to keep the SBJ's going. I have told him I have given you the go-ahead to take over the name so I will speak to him tonight ..."

Mr Ennis' Exhibit RE11

23 September 2009, "bullet.man" to "rayjeans"

"Hi Ray,

Following on from yesterday's email, both Mike & myself would be delighted if Alan was a part of the SBJ's post May 2010 – Nice guy, good player – would be really good!"

Mr Ennis' Exhibit RE15

16 June 2010, "rayjeans" to "alanlovellsbjs"

"Hi Al

Just got back to some disturbing news. Apparently you registered the Swinging Blue Jeans in your name in February without my permission or without mentioning it on the whole of the tour. As I have been trading under the name for 50yrs and still am until next year ..."

16 June 2010, "alanlovellsbjs" reply to "rayjeans"

"Hi Ray. ... This has all come about since Diccon Hubbard's crew has been calling themselves The Swinging Blue Jeans. When I called up agents etc for work I could not get any, unless I kept the name going. Diccon has called all the agents I have and it is getting very confusing & frustrating. So I did a search through solicitors to find out if the name was available. I had to wait until last week to know that it was. So it was registered last week, Not in February. I was going to ring you to tell you this morning. The reason I did'nt (*sic*) say anything on tour was I did'nt (*sic*) know if I would get it or not? I am only trying to stop Diccon going out as the SBJs. ... You said it was OK for me to use the name. ut (*sic*) when I tried. Everyone I rang said they had already spoke to Bullet Management. ... I hope you see. It was useless. Unless I used the name properly. This was not aimed at you! ..."

Mr Ennis' Exhibit RE13

17 June 2010, "rayjeans" to Mr Lovell

".... This mess has come about because you said you did not want to take over the band on numerous occasions. Diccon came on to me to book a gig in Aug 2010 I told him I was retiring in the May and would not be available. He asked me what would happen to the band so I told him you were not interested in carrying on. He came back a few days later to ask in the name was available I said yes only if they kept the SBJ's music style which he agreed. I sent him a letter saying they could use the name from 1st June 2010.

If you remember our conversation in the Norbeck Hotel in Blackpool when

said you had changed your mind. I explained that I could not go back on my word but could not object to you going out as Alan Lovell's SBJ's. (I hope you remember)."

17 June 2010, Mr Lovell reply to "rayjeans":

"...When I first heard that you were going to be retiring. Was the 25th July 2009 ... I did'nt (*sic*) really take a lot of notice of that [*as*] you were talking about doing the SST 2010. Nothing else was said until the next gig Belgium, August 14th ... Towards the end of August you formally told everybody in writing. Now I believe you! [*After detailing how he managed to get a band together to perform as the Swinging Blue Jeans, Mr Lovell goes on to say...*] Unfortunately! You have now told Diccon Hubbard he can take over. After 11yrs of loyalty to you. The truth is Ray, I felt let down. Before it got to this stage. I thought you would have sat me down and said. In your great dulcet tone! "Lovell". Now I'm telling you to think serious about this take a few months get a band etc together, otherwise I ship it all else where! Then it would have all made sense. The deal with Diccon did'nt (*sic*) give me a chance. I cannot get gigs as Alan Lovell's SBJ's. The agents say there is no room for 2 SBJs on the circuit..."

Cross Examination

11) As I have already mentioned, both Mr Ennis and Mr Lovell attended the hearing and were cross examined. Both struck me as being honest and trustworthy with both men answering questions in a straightforward and unguarded way.

Cross examination of Mr Ennis

12) Mr Heald directed questions to Mr Ennis in an attempt to clarify Mr Lovell's role within the band. Mr Ennis conceded that Mr Lovell is presented as one of four band members in promotional material and CD covers, that the four members are given the same level of billing and that people attending the band's concerts understand that the band has four members.

13) When asked if there was any agreement between Mr Ennis and Mr Lovell that any rights Mr Lovell accrued in the band's name would pass to Mr Ennis, he replied that there wasn't and that Mr Lovell "was just a hired musician". It was put to Mr Ennis that during the eleven years that Mr Lovell was a member of the band, he became part of the band's reputation. Mr Ennis concurred with this but added that it was a pre-existing reputation that originated from the band's 1960's hit records.

14) Mr Heald also asked a series of questions regarding tension between certain statements made by Mr Ennis in his written evidence. In his first witness statement he describes Mr Lovell as an employee, but under cross-examination he corrected this by explaining that he was a "hired musician" who was paid per show, plus expenses. Mr

Ennis stated he did not pay tax and national insurance for Mr Lovell, as would have been required if Mr Lovell was an employee.

Cross examination of Mr Lovell

15) Mr Lovell conceded that whilst he could not arrange gigs for the band, as that was a role performed by Mr Ennis, he felt he “had the legal right as a member of the band for 11 years to apply for the trade mark” and because it was not registered to Mr Ennis or anyone else. Further, he expressed the view that he didn’t think he needed to inform Mr Ennis that he had done so.

DECISION

16) Relevant provisions relating to rectification are contained in section 60 and 64 of the Trade Marks Act 1994 (“the Act”). Section 60 read:

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

(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.

17) A “Convention country” as referred to in Section 60(1), above, is defined in Section 55(1)(b) as a country, other than the UK, which is party to the Paris Convention or the WTO agreement.

18) Whilst not pursued with any vigor at the hearing, Mr Morris pointedly the claim based upon Section 60. His argument is that Mr Ennis’ mark has been used outside of the UK and he therefore qualifies as a “proprietor of the mark in a Convention country”.

Mr Heald contended that as Mr Ennis is relying upon an alleged right in an unregistered mark, Section 60 is not appropriate. He points out that Mr Ennis has not stated which Convention country such proprietorship exists and that, further, not all countries recognize unregistered rights and those that do, do not do so in the same way as the UK. Mr Heald summarised by saying that Mr Ennis' case is plainly not made out in the evidence. I concur with this view. Mr Ennis has done no more than make a broad claim that is unsubstantiated in his evidence. Therefore, I dismiss this limb of his case.

19) Section 64 of the Act reads:

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

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

(2) An application for rectification may be made either to the registrar or to the court, except that-

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

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

(3) Except where the registrar or the court directs otherwise, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.

(4) The registrar may, on request made in the prescribed manner by the proprietor of a registered trade mark, or a licensee, enter any change in his name or address as recorded in the register.

(5) The registrar may remove from the register matter appearing to him to have ceased to have effect.”

Sufficient interest

20) The applicant, Mr Ennis, must have a sufficient interest to apply for rectification. He claims he is the true owner of the unregistered mark THE SWINGING BLUE JEANS. As I will discuss in more detail below, ownership of an unregistered mark cannot exist without the ownership of the attached goodwill. As the claimed owner of this mark and the goodwill attached to it, Mr Ennis has an interest in this matter sufficient for the purposes of section 64(1) of the Act.

Is the claimed error capable of correction?

21) Section 64(1) relates to errors or omissions in the register. At the hearing, Mr Heald contended that no error or omission has been identified. Mr Morris claimed that the error or omission is the wrong registered proprietor. Mr Heald referred me to the Registry decision BL O/062/10 *TURBOCHIP*, where the hearing officer concluded (on different facts) that it is not permissible under Section 64 for a decision to effectively undertake a legal assignment from the current legal owner to a new owner. Mr Heald contends that Mr Ennis is similarly asking the Registrar to make a legal assignment in his favour. I am of the view that the Registry may, dependent on the facts of the case, find that it was in error when entering a mark onto the register, with a given proprietor, and where it was subsequently demonstrated that the correct proprietor was not that recorded on the register. This is what is pleaded in the current case. I have no doubt that the provisions of Section 64(1) cover more than the correction of simple clerical errors and can cover errors or omissions relating to the recorded ownership of a mark. Consequently, I am content that there is an alleged error identified relating to ownership. Whether the allegation is correct and admissible on the facts will depend on an interpretation of those facts in the context of Section 64, and in particular, the issue of the proviso that matters must not affect the validity of the mark. Therefore, there is potential for the claimed error to be rectified.

22) It is argued on behalf of Mr Ennis that he is the rightful owner of the mark and it is right and just that the register should be amended to reflect this. Mr Ennis' claim to ownership may or may not be correct, but the question that I must answer first is whether or not Section 64 provides the appropriate mechanism. It is submitted on behalf of Mr Lovell that Mr Ennis' argument amounts to a claim that he has goodwill identified by the mark THE SWINGING BLUE JEANS and he is, in effect, seeking to assert a passing-off right against Mr Lovell's registration. Mr Heald pointed out that such an action, if successful would affect the validity of the registration and is expressly out of scope of Section 64 by virtue of the proviso in Section 64(1).

23) In considering this point, Mr Heald drew to my attention the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in BL O/379/00, *device only mark*, where he stated at page 4:

"This Section [*Section 64*] is quite awkwardly worded. It permits rectification, but only as an exception to the general rule. The general rule is represented by the exclusion contained in the proviso to sub-section (1). That exclusion (of matters affecting the validity of the registration of a trade mark) is apparently intended to restrict the availability of rectification under sub-section (1) to errors and omissions of a kind which can properly be deemed never to have been made (unless otherwise directed) under sub-section (3). I infer that the general rule is intended to prevent circumvention of the unwaivable statutory requirements affecting the registration of a trade mark. These include the requirements of Section 38 to 40 of the Act. I think it is necessary, in order to ensure that the

requirements of those sections are not circumvented, to interpret the reference to “*matters affecting ... validity*” in the proviso to Section 64(1) quite broadly.”

24) Whilst Mr Hobbs made these comments when considering whether it was appropriate for rectification to be used as an avenue to circumvent Section 38 to 40 of the Act, Mr Heald considered that Mr Hobbs’ comments have wider application and he also referred me to the guidance provided in the Registry’s Work Manual at Chapter 7, paragraph 3.5.2. The relevant passage reads as follows:

“3.5.2 Section 64 of the Act

Under this section any person having a sufficient interest may apply for the rectification of an error or omission in the register provided that the application for rectification is not made in respect of a matter affecting the validity of the registration of a trade mark. The term ‘validity’, as it appears in the proviso, is to be interpreted quite broadly. The section cannot be used for example to:

- Alter the identity of the mark itself
- Increase the breadth of the specification

or

- Any other matter which might otherwise be more properly dealt with under another section of the Act, or which might involve circumvention of statutory requirements

Clerical errors and mistakes in the register are generally considered to be covered by the section, as are more substantive questions like the correct ownership of a mark, but, only if another, purpose-made, section of the Act does not cover the relief being sought.

Examples of rectifications which the Tribunal would accept are:

- Terms used in the specification which are self-evidently erroneous and no other party could possibly be disadvantaged by their correction
- Applicant’s or proprietor’s name and/or address, which appears on the register incorrectly and, on the basis of evidence provided, is incorrect
- Cases of genuine mistaken identity where the person filing the original forms was unaware of the correct ownership position in law. The Tribunal has held that section 64 was available to those who were unaware of the true position in law as to ownership but who, much later, realised their error [*FOOTNOTE: However, this was in circumstances where the rightful*

owner, capable of holding the property, existed at the time the application was made and the facts were not disputed]"

25) Mr Morris submitted that the critical difference between Section 64 and other sections such as Section 5(4)(a) is that if Mr Ennis is successful, he will become proprietor from the date of the application for registration. This overlooks the other obvious difference that is relevant because of the specific proviso in Section 64, namely that rectification can only be permitted if the matters raised do not affect the validity of the mark. On the other hand, a successful claim to a passing-off right at the date of the application will affect the validity of the mark. Consequently, if I find that Mr Ennis' case amounts to a proven passing-off right, then I must find that his case based upon Section 64 fails.

26) Mr Morris contended that there is a legal history supporting his position that the error should be corrected by recording Mr Ennis as the registered proprietor. To support this, he referred me to the speech of Lord Diplock quoted on page 330 in the House of Lords decision in *GE Trade Mark* [1973] RPC who in turn quoted from Section 5 of the Act of 1875. Whilst dealing with a different issue, I note that the section of the Act Lord Diplock referred to stated "...The court may, in any proceedings under this section [that provided provisions for rectification of the register], decide any question as to whether a mark is or is not such a trade mark as is authorised to be registered under the Act...". Mr Morris further contended that the Registry's Work Manual also supported this approach. I do not agree. The relevant part of the Act of 1875, quoted above, does not appear to be impacted upon by any proviso as exists in the current Act and as is clearly considered in the relevant part of the Work Manual reproduced earlier.

27) In this context, I note the following comments on this issue provided in *Kerly's Law of Trade Marks and Trade Names, 15th Edition*, at paragraphs 3-032 and 3-033:

"A question which arises under s.64 is the standard to be applied in determining whether the matter in question is one "affecting the validity" of the registration concerned and hence not capable of being addressed under the section. One reading of the section is that the powers conferred may be exercised unless the matter concerned is such that, if not addressed, the mark would actually be wholly or partially invalid. Another possible meaning is that correction under s.64 may not be performed if the matter is of such a nature and/or degree of seriousness that there is a reasonable prospect of the registration being wholly or partially invalid as a result of it.

It is suggested that the latter meaning is to be preferred. Otherwise, it may be necessary to decide whether and how the validity of the registration concerned would be affected by the correction sought, merely in order to determine the threshold question of whether there is power under the section to deal with the application for correction."

28) This passage is also consistent with the decision of Mr Hobbs QC and the Consequently, I reject Mr Morris' argument that the legal history supports Mr Ennis' position. It is therefore necessary for me to go on to consider the impact of the proviso upon the facts of this case.

29) It is claimed that Mr Ennis is the true owner of the mark THE SWINGING BLUE JEANS because he:

- i) was the only remaining original member of the band;
- ii) arranged all the business affairs of the band;
- iii) paid the other members of the band, including Mr Lovell, as jobbing musicians;
- iv) is sole proprietor of the business behind the band.

30) It is far from clear to me that this matter is not one that, as Mr Heald contended, may affect the validity of the mark. In the current case, the rights claimed by Mr Ennis are in the unregistered mark identifying the band. Ownership of an unregistered mark cannot exist separate to the attached goodwill. Consequently, in claiming ownership of the unregistered mark, Mr Ennis is, in effect, also claiming that he is the sole owner of the goodwill attached to it and that, consequently, this gives him the necessary control over the mark that should be sufficient to prevent Mr Lovell from using the mark without his consent. That is sufficient to provide a basis for invalidating the registrations under s.47(2)(b) of the Act.

31) Mr Heald submitted that Mr Ennis' case appears to be based upon the conflation of two related but independent concepts. Firstly, the ownership of an unregistered mark (and the goodwill attached to that mark) and secondly, ownership of the registered mark. He points out that ownership of the first does not automatically lead to ownership of the second and that the relationship between the two is governed by Section 5(4)(a) of the Act (dealing with passing-off rights). He claims that this precludes cases being brought under Section 64 where there is reliance upon an earlier unregistered mark.

32) On this basis, Mr Heald, in cross examination, attempted to elicit from Mr Ennis what was the true position regarding the goodwill associated with the band. Mr Ennis conceded that from the point of view of those who came to watch the band perform, all the musicians presented in the promotional material and CD covers would have been perceived as being members of the band. In the absence of any agreement to the contrary, the implication from this is that the goodwill associated with the band resided with all the band members. If the band was a partnership at will, such a conclusion would appear to be consistent with in findings of the High Court in *Saxon Trade Mark* [2003] EWHC 295 (Ch).

33) It is clear to me that proprietorship of the registered mark involves consideration of where the established goodwill resides and whether Mr Lovell's actions in applying for, and registering the mark result in misrepresentation. Mr Morris' own submissions at the hearing, to some degree, implicitly acknowledge this, as he relied upon the comments of the Appointed Person in *Croom's Trade Mark Application* [2005] RPC 2 which was a

case decided under Section 5(4)(a) of the Act and where the Appointed Person relied upon the stated passing-off principles that a senior user prevails over a junior user etc. Whilst Mr Morris submitted that such principles are not limited to passing-off actions, to my mind, it reinforces Mr Heald's point that Mr Ennis' case relies upon his claim to the unregistered mark and associated goodwill. In other words, it relies upon establishing a passing-off right, the consequence of which, if successful, would be to impact upon the validity of the registration.

34) I recognise that this alone may not preclude me from considering the issue under Section 64. Nevertheless, I pay particular attention to Mr Hobbs' guidance that "*matters affecting ... validity*" in the proviso to Section 64(1) should be interpreted quite broadly, and to the comments in *Kerly's* that a correction under Section 64 may not be performed if the matter is of such a nature and/or degree of seriousness that there is a reasonable prospect of the registration being wholly or partially invalid as a result of it. If Mr Ennis can be successful in demonstrating that he is the sole owner of the unregistered mark corresponding to the registered mark at issue, it follows that he is also the owner of the goodwill attached to it. If such a conclusion were to be reached, it would follow that Mr Lovell's use of his registered mark would amount to misrepresentation and damage to Mr Ennis's goodwill. In such a circumstance, the registration would be invalid. Consequently, when applying this guidance to the facts of this case, it is my view that the issues involved are such as to result in there being a reasonable prospect of the registration being wholly invalid.

35) Taking all of this into account, I conclude that Mr Ennis is precluded from being successful in his application to rectify the register because of the proviso in Section 64(1) that "an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark". In reaching this conclusion, I make no finding on the nature of Mr Lovell's actions in applying for, and registering the mark at issue. Such considerations are appropriate only under other sections of the Trade Marks Act.

36) In light of my findings above, the rectification action fails in its entirety.

COSTS

37) At the hearing the parties were permitted 14 days to inform me if there was any correspondence without prejudice, save as to costs. In light of written confirmation that there was none, I intend to consider an award of costs in the normal way.

38) The rectification action having failed, Mr Lovell is entitled to a contribution towards his costs. However, I will not award costs at this stage because it would need to reflect

any expenses incurred by Mr Lovell in attending the hearing for cross-examination. Such information, together with any supporting documents, should be sent for my consideration within 28 days of the date of this decision. I will then issue a supplementary decision on costs.

Dated this 11th day of October 2012

**Mark Bryant
For the Registrar
The Comptroller-General**