

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION N°s 11468 & 11469  
BY ZILA INC FOR  
RECTIFICATION OF THE ENTRY ON THE REGISTER  
IN RESPECT OF TRADE MARK N°s 2017179 & 2001980  
STANDING IN THE NAME OF ZILA INC

## TRADE MARKS ACT 1994

5 IN THE MATTER OF Application N°s 11468 & 11469  
by ZILA INC for  
rectification of the entry on the Register  
in respect of Trade Mark N° 2017179 & 2001980  
standing in the name of ZILA INC

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### 15 BACKGROUND

The trade mark registration numbered 2017179 was applied for on 10 April 1995 and the trade  
mark registration numbered 2001980 was applied for on 4 November 1994, both in the name of  
20 Zila Pharmaceuticals Inc. They were registered on 27 October 1995 and 8 March 1996,  
respectively, in that name. On 19 November 1999 these registrations were the subject of a change  
of name from Zila Pharmaceuticals Inc. to Zila Inc.

By applications filed on 11 February 2000, Zila Inc, “the applicants”, applied for the rectification  
25 of the Register under Section 64 of the Act in respect the trade mark registration referred to  
earlier, by the correction of the name of the proprietor from Zila Inc. to Zila Pharmaceuticals Inc.  
The trade mark registrations have been legally assigned from the original registered proprietor to  
the applicants but this has been incorrectly recorded as a change of name, this rectification is  
required before the assignment can be properly recorded.

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The statement of case, received with the form TM26, states that the grounds of rectification are  
that as a result of an error on the part of the Trade Mark Agents responsible for recording the  
assignment an incorrect form was used, a TM21 rather than a TM16. A subsequently filed  
statutory declaration provided a full explanation of this error with exhibits supporting this  
35 application for rectification, including a copy of the deed of assignment dated 30 July 1999  
between Zila Pharmaceuticals Inc. and Zila Inc.

### 40 DECISION

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I now turn to consider the grounds of rectification under Section 64 of the Act, which states:

45 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.

5 (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

5 (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.

10 (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.

15 (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.

20 I am satisfied that the applicants, as the registered proprietor of the trade mark registration, have the qualifying status demanded by Section 64 of the Act; that is that they have a sufficient interest in the registration. I am also satisfied that this is not a request that must be made to the Court. It is appropriate therefore for me to consider the request.

25 Insofar as the error is concerned I am satisfied that it was a clerical error on the part of the Trade Mark Agent acting for the registered proprietor in that they filed for the assignment of these registrations on an incorrect form. The consequence is that the registrations have not been recorded as assigned to the registered proprietor. In the circumstances I am satisfied that it would be right to correct matters and in the exercise of the discretion conferred upon me by Section 64 of the Trade marks Act 1994, I direct that the Register be rectified by the deletion of the name and address shown against the registered proprietor in respect of trade mark registration N<sup>o</sup>s 30 2017179 and 2001980 and replaced with the name Zila Pharmaceuticals Inc. at the following address 5227 North 7<sup>th</sup> Street, Phoenix, Arizona 85014, USA.

35 In accordance with Section 64(3) I deem that the error was never made.

Dated this 10<sup>th</sup>. day of April 2000

40  
45 G J ATTFIELD

Acting for the Registrar  
The Comptroller General