TRADE MARKS ACT 1994

IN THE MATTER OF:

APPLICATION No. 12462

IN THE NAME OF PEPSICO INC.

FOR REVOCATION OF TRADE MARK No. 1077371

REGISTERED IN CLASS 30

IN THE NAME OF CITYLINK GROUP LIMITED

---

**DECISION**

---

1. On 12th April 2001 Pepsico Inc applied under Section 46(1) of the Trade Marks Act 1994 for revocation of trade mark number 1077371 registered in respect of various goods in Class 30 in the name of Citylink Group Limited.

2. A copy of the application for revocation was sent to the registered proprietor at its address for service on 24th April 2001.

3. The registered proprietor then had 3 months within which to file a counter statement and evidence of use of the trade mark (or reasons for non-use of the mark) in accordance with the provisions of Rule 31(2) of the Trade Marks Rules 2000.

4. On 19th July 2001 the registered proprietor assigned the trade mark in suit to Pepsico Inc.

5. However, the parties inadvertently omitted to inform the Registrar of the assignment. They became aware of the omission when they received a decision, issued by Mr. Edward Smith on behalf of the Registrar on 12th September 2001, revoking the trade mark registration with effect from 12th April 2001.

6. The decision was issued under the provisions of Rule 31(3) which enable the Registrar to treat an application for revocation under Section 46(1) of the Act as unopposed if the proprietor of the trade mark in issue does not file a counterstatement and evidence of use (or reasons for non-use) within the period prescribed for that purpose.

7. On 6th November 2001 Pepsico Inc. gave notice of appeal to an Appointed Person under Section 76 of the 1994 Act. It asked for the decision issued on 12th September 2001 to be set aside on the ground that the Registrar could and would have made no order for revocation if she had known of the assignment which had taken place on 19th July 2001.

8. The Registrar does not oppose the present appeal. She confirms that if she had been aware of the assignment in favour of Pepsico Inc. she would have regarded it as fully determinative of the proceedings and made no order for revocation of the trade mark in issue. She joins with the appellant in suggesting that the appeal may be determined on the papers without recourse to a hearing.

9. I am essentially being asked by the appellant, without opposition from the Registrar, to follow the approach I adopted in my decision on appeal in the matter of Application No. 8712 by Dale Farm Dairy Ltd for revocation of Trade Mark 342777 registered in Class 30 in the name of Kraft Jacobs Suchard SA (12th December 1996).

10. In that case, as in this case, an applicant for revocation became the proprietor by assignment of the trade mark in suit during the pendency of the proceedings; the parties to the proceedings inadvertently omitted to inform the Registrar of the assignment which had taken place; the Registrar issued a decision revoking the registration of the trade mark for default of defence on the part of the erstwhile registered proprietor; the applicant asked for the decision to be set aside on appeal; and the Registrar did not oppose the applicant's request for an order to that effect.

11. I decided that the order for revocation could properly be set aside on the basis: (i) that the parties had ceased to have opposing interests in the subject matter of the proceedings upon execution of the relevant assignment; (ii) that the lis between them had abated for lack of any continuing need or desire on either side to have the status of the relevant registration determined by the Registrar; (iii) the Registrar had been legally and factually entitled on the ground of abatement to make no order for revocation under Rule 31(4) of the Trade Marks Rules 1994 when the order under appeal was made; and (iv) the order for revocation would not have been made if the Registrar had not thought that there was an unresolved

dispute between the parties which remained to be determined. I allowed the appeal and set aside the order in question.

12. The present case stands upon the same footing. I see no reason to deal with it any differently.

13. I cannot see that any useful purpose would be served by requiring the appellant and the Registrar to attend a hearing and argue, in unison, for a reversal of the decision under appeal on the basis of my reasoning in the Kraft Jacobs Suchard case.

14. I therefore determine, without recourse to a hearing, that Pepsico Inc's appeal be allowed and the decision issued on 12th September 2001 be set aside. There will be no order for costs in respect of the appeal or the proceedings before the Registrar.

Geoffrey Hobbs Q.C.

13th December 2001