

TRADE MARKS ACT 1994

IN THE MATTER OF Trade Mark No. 2215825

in the name of Sativa SL

and

IN THE MATTER OF an application for a declaration of invalidity

No. 80967 by Arrogance Accessories Ltd

Background

1. On 30th November 1999, Sativa SL applied to register the trade mark SATIVA SL for clothing and headgear in Class 25.
2. The application was accepted, published and proceeded to registration.
3. On 23rd August 2002, Arrogance Accessories Ltd (the applicant) applied for a declaration of invalidity under section 47 of the Trade Marks Act 1994. The statement of case states that following investigations by the applicant, it is believed that Sativa SL does not exist and, it could be inferred that this 'company' did not exist when the application was filed.
4. The results of the investigations are further detailed as follows:
 - that there is no registered company with the name Sativa SL. Companies with the name SATIVA in them operate in unconnected fields of activity;
 - that the address given by the registered proprietor when he applied for the registration, 70 Fortress Road, Kentish Town, London, NW5 1AG, is occupied by a retail establishment unconnected with the goods of the registration;
 - that letters sent to Sativa SL at the address above are returned by the Post Office marked 'addressee unknown'; and
 - that there is no listing for Sativa SL in the London telephone directory.
5. Based on the fact that the proprietors did not exist at the material date of filing and do not exist to this day, the applicant sets out his legal grounds in support of the application as follows:

Under section 3(3)(b), in that a trade mark is intended to indicate a connection in the course of trade between the goods and the proprietor. If the proprietor does not exist there can be no connection and the public is deceived.

Under section 3(4) in that use of the trade mark would offend against an enactment or rule of law as the relevant goods in the UK are required to have a 'care label' identifying the source of the goods. If the proprietor does not exist this is not possible.

Under section 3(6) in that the application was made in bad faith as the declaration signed by the proprietor on the original Form TM3 states that: “The trade mark is being used by the applicant or with his or her consent, in relation to the goods or services stated, or there is a bona fide intention that it will be so used.” This is not possible if the applicant for registration does not exist. Further, that section 12 of Form TM3 requests the full name, address and post code of the applicant. The information provided was untrue and therefore the registrar was misled.

6. In accordance with rule 33(2) of the Trade Marks Rules 2000, the application was sent, on 5th September 2002, to the registered proprietor at their stated address, no alternative address for service having been provided. The registered proprietor had 6 weeks from 5th September 2002 to file a Form TM8 and counterstatement to defend the registration. The consequence of failure to defend the registration was set out in the official letter of 5th September; namely, that the application for a declaration may be granted in whole or in part.

7. No Form TM8 or counterstatement has been filed within the relevant period, or at all. Instead, the papers comprising the application have been returned to the registry by the Post Office marked ‘addressee unknown’. Thus the application has been undefended, but this does not of itself result in a default decision with no consideration of the merits.

8. In the *Firetrace case* [2002] RPC 15 (*Firetrace*), at paragraph 17 of that decision, the registrar’s principal hearing officer states:

‘It is not sufficient to simply allege that a registration offends either section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.’

9. The reason that the hearing officer arrived at this view is the statutory presumption in section 72 of the Act which states:

‘In all legal proceedings the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.’

10. Of course, in the present case it is most unlikely that the registered proprietor, assuming he does exist, has exercised the conscious choice not to defend, spoken of in *Firetrace*. That said, on the basis that it is always the responsibility of the applicant or proprietor to maintain register records as regards addresses for service, I am not prepared to deny this application purely on the basis that the registered proprietor could not be located, and therefore has not exercised any conscious choice not to defend.

11. Having regard to *Firetrace* and on the basis of the facts pleaded, I invoked rule 57 of the Trade Marks Rules 2000 to require that the applicants provide a witness statement setting out

their investigations into the alleged non-existence of the proprietor, in particular to provide me with more details as to when their investigations took place. If the registrar was to accept the inference pressed on her that the proprietor did not exist at the date of filing then this further information was needed.

12. In response the applicants filed two witness statements: one dated 29th November 2002 from Alpesh Vora, a director of the applicants, and the second, dated 29th November 2002, from Michael Downing, the applicants' trade mark attorney. Mr Vora explains that at some time in late August, prior to the date the application was made, he visited the premises at 79 Fortress Road, Kentish Town London to see whether Sativa SL were there. This was at the request of the applicants' trade mark attorney. He found a recording studio but no sign of the company Sativa SL. He visited the premises again on 24th November 2002, following my letter requesting further evidence and explains that No 79 is in a yard set off Fortress Road with access from the yard. There are several name plates for companies in No 79 but they do not include Sativa SL. To see whether there had previously been a company called Sativa SL he spoke to a person working in the recording studio who did not recall any such company. Exhibit AV1 is a set of photographs of the name plates of the companies at 79 Fortress Road.

13. Mr Downing explains that prior to filing the application, he conducted a search of the Companies House website which did not reveal any company called Sativa SL. Exhibit MPD1 is a copy of search using the Companies House website. He says that the visit by Mr Vora, prior to the application being made, was at his request as it was more convenient, since Mr Vora had offices close by. Exhibit MPD2 and MPD3 are original letters sent by Mr Downing on 2nd August 2002 and 8th August 2002 to Sativa SL which were returned by the Post Office marked 'addressee unknown'. Finally, he explains that immediately prior to the application being made, he contacted BT Directory Enquiries who said there was no business or personal entries for Sativa SL at 79 Fortress Road.

Decision

13. The difficulty in this case is the same as that which confronted the Principal Hearing Officer in *Blarney Spring Water v Irish Water Resources Ltd (BL O/175/02) (Blarney)*. Sections 2, 22 and 27 of the Act refer to registrations being objects of personal property, and it follows that they can only be owned, or applied for, by natural or legal persons capable of holding property. So, if it can be shown that at the date of filing there was no natural or legal person capable of holding the property, then any resulting registration must be void ab initio. Matters cannot be put right at a later date (see *Nonogram Trade Mark [2001] RPC 355 at pages 362 -363*). As the registration may be a nullity then it could be argued that it cannot be rectified or invalidated, since it never came into being in the first place.

14. That said, the Principal Hearing Officer in Blarney was prepared to decide the section 3 grounds of invalidity argued before him whilst, at the same time, expressing the view of nullity expressed above. I am prepared to do the same. So, on the basis that there is a registration capable of being invalidated I make the following findings in relation to the section 3 grounds.

15. Whilst I may have some qualms over the applicant's evidence, for example:

- the enquiries over Sativa SL's existence were only made in August 2002, from which I am asked to infer that the company did not exist in November 1999 when the application was filed. The 'hearsay' evidence (if I can even call it that) of the person spoken to by Mr Vora, who said he had never heard of Sativa SL is weak at best ;

- better evidence, perhaps, is provided by the Companies House web site extracts of past and present companies, which contains no record of SATIVA SL. Several entries show companies with 'SATIVA' in them but they are either dissolved or operate in an entirely unrelated field; and

- one has to ask whether a director of the applicant is the most impartial person to undertake to visit the premises at 79 Fortress Road to establish whether Sativa SL existed;

I must remember that the applicant is only required to establish a prima facie case. There is, after all, no alternative version of the facts. With that in mind and with the evidence before me, I find that on the balance of probability the 'registered proprietor' could not have had, as it was not capable of having, the required intention to use under section 32(3) (see also *Demon Ale Trade Mark [2000] RPC 345*). I also find that, on the balance of probability, the 'registered proprietor' failed to give the required information under section 32(2)(b), being his name and address. Having thus found, I conclude that the application was made in bad faith under section 3(6).

16. I have found that the trade mark was registered in breach of section 3(6) of the Trade Marks Act 1994 and, under section 47(1), I declare that the registration is invalid. In accordance with section 47(6) the registration shall be deemed never to have been made.

17. Having found for the applicants under section 3(6), I express no view on the alternative grounds under section 3 pleaded.

18. I have not dealt with the question of costs in this decision but I will consider any written submission made within 14 days from the date of this decision. Any submission may also address the issue of who any award should be made against.

Dated this 12TH day of December 2002

Edward S Smith.
For the registrar, the Comptroller-General