

O-003-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN INTERLOCUTORY HEARING  
IN RESPECT OF REGISTRATION NOS. 2325253 AND 2308256  
IN THE NAME OF PHILIP MAITLAND**

**AND**

**IN THE MATTER OF APPLICATIONS FOR DECLARATIONS OF  
INVALIDITY THERETO BY O2 LIMITED UNDER NOS. 81656 and 81657**

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Hearing in respect of registration Nos.  
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**in the matter of applications for  
declarations of invalidity thereto  
by O2 Limited under Nos. 81656 and 81657.**

### **Background**

1. Trade Mark No. 2308256 was applied for on 16 August 2002 by Large Distilleries of Manchester. On 29 January 2003, a Form TM16 was filed seeking to record a change of proprietor to Philip Maitland who gave his address as Rue Jacob, Paris. The registry issued a letter dated 4 February 2003 to Mr Maitland at his Paris address asking him to contact the writer to provide an address for service in the UK. Although the letter gave no indication of this, an address for service in the UK was required under the provisions of Rule 10 of the Trade Marks Rules 2000.

2. I presume Mr Maitland telephoned the registry shortly after receiving the letter giving an address at Lindsay Drive, Harrow as on 14 February 2003, the registry issued a letter to that address, confirming the recordal of the assignment of the registration to Mr Maitland. Thus the applicant's address was recorded as Rue Jacob, Paris, with an address for service at Lindsay Drive, Harrow. The application subsequently proceeded to registration and no further changes to the address details have been made.

3. Trade Mark No. 2325253 was applied for on 3 March 2003 by Philip Maitland with an address at Lindsay Drive, Harrow. No agent was appointed so this address was also recorded as the address for service. Again the application subsequently proceeded to registration and no changes to the address details have been made.

4. Separate applications to invalidate both registrations were filed on 11 March 2004 on behalf of O2 Limited. The Registrar later sent the applications, separately, by recorded delivery to the registered proprietor at the recorded address for service at Lindsay Drive, Harrow. Both sets of documentation were subsequently returned by the Royal Mail marked "not called for". It appears from the papers on file that further copies were sent by ordinary post to the same address. The registered proprietor did not file counter-statements within the period allowed to him under the provisions of Rule 33. Both sets of proceedings continued, however, with the applicant filing evidence.

5. Nothing was heard or received from the registered proprietor and no request for a hearing was made by either party. On 11 May 2006 a decision from the papers was issued in relation to applications for invalidation of the two registrations and was sent to both parties by recorded delivery. I should perhaps point out at this stage that whilst

it is clear now that the registered proprietor for both registrations are one and the same, for reasons which are unknown to me and despite the address of the registered proprietor differing in both cases, a single decision was issued in relation to the two applications.

6. No appeal against that decision was received within the period allowed and the two registrations were subsequently recorded as having been invalidated.

7. On 7 August 2006, a letter was received from Mr Maitland, indicating that he had had no knowledge of the proceedings and seeking to re-open them. The letter also indicated that in November 2003 he had filed a Form TM21 to record a change of address and suggested the request had been overlooked by the Trade Marks Registry. A Form TM21 dated 3 November 2003 and marked "copy" was enclosed with the letter, indicating a change of address in relation to registration No. 2308256. The form made no mention of registration No. 2325253.

8. The letter and copy Form TM21 was considered by registry and, on 17 August 2006, a letter was issued which confirmed that there was no record on file of the prior receipt of any such request for a change of address. The letter also indicated that the copy form supplied could not have been filed in November 2003 as the registered proprietor suggested it had, as that particular version of the form did not come into use until October 2004 as was indicated on it.

9. Mr Maitland responded by way of a letter dated 22 August 2006 confirming he did file the change of address form on 3 November 2003 but did not keep a copy of it. He maintained his request for the proceedings to be re-opened.

### **The hearing**

10. Prior to the hearing I asked that the Appointed Person's decision O-340-04 *Ms A J Coggins v Skjelland Group AS* be brought to the parties' attention.

11. The hearing took place before me on 30 November 2006 by telephone. Mr Maitland represented himself whilst Mr Stobbs, of Boulton Wade Tennant represented the applicant. In line with having issued a single decision, a single hearing in respect of both invalidated registrations took place. Neither party raised any objections regarding the single decision and therefore I proceeded on this basis.

12. Following the hearing, I issued my decision in a letter later the same day. The letter to Mr Maitland, copied to Boulton Wade Tennant, stated:

"The issue before me was the registrar's preliminary view to refuse your request to re-open the above proceedings. I received some papers from you in advance of the hearing along with a very brief skeleton argument from the applicant.

In response to my questions, you indicated that you were not familiar with the hearing process. I explained to you the procedure that would be followed. I also asked you to clarify the remedy you sought. You confirmed that you were seeking to re-open these cases by having the decisions set aside.

After considering all the submissions made, my decision is to uphold the preliminary view and refuse to set aside the decisions and re-open these proceedings. As I explained, the registrar has very limited powers to set a decision aside. He may do so where a decision contains a clerical error or other error arising from an accidental slip or omission. You submitted that there had been a procedural irregularity in these proceedings because of the failure to update the address for service details.

Whether or not third parties were aware of your change of address, the responsibility rested with you to keep the records up to date and advise the registry of any changes. You insisted that you had sent the appropriate documents but conceded that you did not check to see that they had been actioned. I confirmed that there is no record on any of the relevant files of you having notified the registrar of your change of address at any time before the issue of the decisions.

Once the registrar has issued a decision he is *functus officio*. This means that he has discharged his duty and cannot revisit his decision. The proper avenue is for the party seeking to challenge the decision to appeal it. Further details on the appeal process are available on our website; [www.patent.gov.uk](http://www.patent.gov.uk).

This letter does not contain a full statement of reasons for my decision. As I explained at the hearing, if either party wishes to appeal this decision, they should file a Form TM5 together with the required fee (£100) requesting a statement of reasons within one month of the date of this letter. A copy of this letter has been sent to Boulton Wade Tennant.”

13. Mr Maitland subsequently filed a Form TM5 (with fee) within the period allowed, seeking a full statement of the reasons for my decision. These I now give.

## **Submissions**

### **Registered proprietor**

14. Mr Maitland submitted that “the logos” the subject of the registrations were first used on 21 February 2002 and have been used since then. They have, he said, actively featured in the press and on a website. The registrations were, he said, important to him. He submitted the applicants knew both that the marks were being used and that he would want to defend the registrations.

15. Mr Maitland explained the address at Lindsay Drive was that of his mother. He had used this address as his address for service because at the time he was resident in Paris. Unfortunately, in June 2003, Mr Maitland’s mother died and, on 11 August the same year, Mr Maitland moved to Hampstead.

16. Mr Maitland said that he had not been sent any letters regarding these two registrations. If letters had been sent to him by the registry to the Lindsay Drive address then he had not received them. If letters had been sent there he would not

have seen them as he had moved. He had not signed for anything received at that address.

17. Mr Maitland said he was aware that the onus was on him to update the Trade Marks Registry's records and thought he had done so. But with the complications caused by his mother's death he did not check whether anything had "gone astray". Mr Maitland is an officer of a company called English Distillers Ltd. He submitted that the applicant's agent was well aware of this and of the address of that company as a letter of complaint had been sent by them to that address. Knowing of his office address, Mr Maitland said that Boulton Wade Tennant could have offered it up to the Trade Marks Registry. The only contacts from them made concerning these applications for invalidation, were those received after the decision to invalidate the registrations had been issued and after the expiry of the period for lodging appeal against that decision.

18. In response to Mr Stobbs' comment, Mr Maitland denied that he had buried his head. The applicant, he reiterated, knew the mark was being used and that he would want to defend the registrations.

19. Mr Maitland concluded by saying that he might have been at fault in not checking that the form seeking a change of address had been received and actioned by the registrar but that the onus on ensuring an address was correct should not only be on him or the registrar.

### **Applicant's submissions**

20. It is, I think, appropriate to mention at this point that when invited to begin his submission Mr Stobbs indicated that he was "mainly attending the hearing as an observer". I challenged him on this as I was uncertain exactly what this was intended to mean taking into account that he had filed written submissions and had made no mention of this prior to the commencement of the hearing. Mr Stobbs then indicated that he would take a full part in the hearing.

21. Mr Stobbs said that he agreed with the registrar's preliminary view; there was no case to answer. The onus was on the registered proprietor to keep his address for service up to date and he had failed to do so. In terms of deciding whether there had been any procedural irregularity, what was within the knowledge of Boulton Wade Tennant was not the issue as they held no responsibility to inform the Trade Marks Registry of a third party's address. Procedural irregularity meant it was the procedures carried out by the Trade Marks Registry that were important.

22. Mr Stobbs accepted that a letter had been sent by his firm to Mr Maitland's company's office address. This was, he said, a cease and desist letter. He submitted that many such letters are sent out and it was not unusual to receive no response to them. His company had sent letters to both Mr Maitland's home address, as recorded at the Trade Marks Registry, and to his company's office address. There was no obligation to copy cease and desist letters to the Trade Marks Registry.

23. Whilst Mr Stobbs expressed his sympathy for Mr Maitland's bereavement, he countered that this was not relevant. The onus was on the registered proprietor

to keep his address for service up to date and he had failed to do so.

## **Decision**

24. The applications which subsequently became registration Nos. 2308256 and 2325253 were applied for some seven months or so apart in August 2002 and March 2003. Applications for declarations of invalidity of both registrations were filed on 11 March 2004. At all relevant times the registrations and the applications for declarations of invalidity have been subject to the requirements of the Trade Marks Rules 2000.

25. Rule 10 of these rules state:

“**10.**-(1) For the purposes of any proceedings before the registrar under these Rules or any appeal from a decision of the registrar under the Act or these Rules, an address for service in the United Kingdom shall be filed by-

- (a) every applicant for the registration of a trade mark;
- (b) every person opposing an application for registration of a trade mark;
- (c) every applicant applying to the registrar under section 46 for the revocation of the registration of a trade mark, under section 47 for the invalidation of the registration of a trade mark, or under section 64 for the rectification of the register;
- (d) every person granted leave to intervene under rule 35 (the intervener); and
- (e) every proprietor of a registered trade mark which is the subject of an application to the registrar for the revocation, invalidation or rectification of the registration of the mark.

(2) The address for service of an applicant for registration of a trade mark shall upon registration of the mark be deemed to be the address for service of the registered proprietor, subject to any filing to the contrary under paragraph (1) above or rule 44(2) below.

(3) In any case in which an address for service is filed at the same time as the filing of a form required by the registrar under rule 3 which requires the furnishing of an address for service, the address shall be filed on that form and in any other case it shall be filed on Form TM33.

(4) Anything sent to any applicant, opponent, intervener or registered proprietor at his address for service shall be deemed to be properly sent; and the registrar may, where no address for service is filed, treat as the address for service of the person concerned his trade or business address in the United Kingdom, if any.

(5) An address for service in the United Kingdom may be filed at any time by the proprietor of a registered trade mark and by any person having an interest in or charge on a registered trade mark which has been registered under Rule 40.

(6) Where an address for service is not filed as required by paragraph (1) above, the registrar shall send the person concerned notice to file an address for service within two months of the date of the notice and if that person fails to do so-

(a) in the case of an applicant as is referred to in sub-paragraph (a) or (c), the application shall be treated as abandoned;

(b) in the case of a person as is referred to in sub-paragraph (b) or (d), he shall be deemed to have withdrawn from the proceedings; and

(c) in the case of the proprietor referred to in sub-paragraph (e), he shall not be permitted to take part in any proceedings.”

26. As stated above, at the time the two trade mark applications achieved registration, they both stood in the name of Philip Maitland. In the case of No. 2308256 the form Mr Maitland filed to record himself as the proprietor (Form TM16) gave details of his address in Paris but, after challenge, Lindsay Drive was given as an address for service within the UK. This complied with the requirements of Rule 10(1) taking into account Rules 10(3) and 10(6). In respect of No. 2325253, the application form (Form TM3) gave the Lindsay Drive address as Mr Maitland’s address. As no separate address was provided, Lindsay Drive was also taken to be his address for service. In respect of both trade mark applications, the address for service remained as Lindsay Drive upon registration, in accordance with Rule 10(2).

27. On 11 March 2004 separate applications for a declaration of invalidity of each of the two registered marks were filed at the Trade Marks Registry by Boulton Wade Tennant on behalf of O2 Limited. Invalidity of a registration is provided for by Section 47 of the Act. The procedure to be followed on application for invalidity of a registration can be found under Rule 33 which states:

“**33.** (1) An application to the registrar for a declaration of invalidity under section 47(1) or (2) of the registration of a trade marks shall be made on Form TM26(I) together with a statement of the grounds on which the application is made; the registrar shall send a copy of the application and the statement to the proprietor.

(2) Within six weeks of the date on which a copy of the application and statement is sent by the registrar to the proprietor, the proprietor may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement to the applicant.

(3) Where a notice and counter-statement are not filed by the proprietor within the period prescribed by paragraphs (2), the registrar may treat his opposition to the application as having been withdrawn.

(4) Within six weeks of the date upon which a copy of the counter-statement is sent by the registrar to the applicant, the applicant may file such evidence as he may consider necessary to adduce in support of the grounds stated in his application and shall send a copy thereof to the proprietor.

(5) If the applicant files no evidence under paragraph (4) above in support of his application, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his application.

(6) If the applicant files no evidence under paragraph (4) above or the registrar otherwise directs under paragraph (5) above, the proprietor who has filed a notice and counter-statement under paragraph (2) above may, within six weeks of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such evidence as he may consider necessary to adduce in support of the reasons stated in the counter-statement and shall send a copy thereof to the applicant.

(7) Within six weeks of the date upon which a copy of the proprietor's evidence is sent to him under paragraph (6) above, the applicant may file evidence in reply which shall be confined to matters strictly in reply to the proprietor's evidence, and shall send a copy thereof to the proprietor.

(8) No further evidence may be filed, except that, in relation to any proceedings before her, the registrar may at any time if she thinks fit give leave to either party to file such evidence upon such terms as she may think fit.

(9) Upon completion of the evidence the registrar shall request the parties to state by notice to her in writing whether they wish to be heard; if any party requests to be heard the registrar shall send to the parties notice of a date for the hearing.

(10) When the registrar has made a decision on the application she shall send the parties to the proceedings written notice of it, stating the reasons for her decision; and for the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision."

28. The applications for declarations of invalidity of the registrations were made on Form TM26(I) as required by Rule 33(1). The statement of case in support of the application was revised at the request of the registrar in order to clarify the basis on which the applications were made. In accordance with the requirements of Rule 33(1) the registrar sent copies of the applications for declaration of invalidity of the registrations and the revised statement to the registered proprietor. The copies were sent to him, by recorded delivery, on 19 May 2004 and to the address for service which he had provided.



29. Both of the envelopes and their contents were returned to the registrar by the Royal Mail on 1<sup>st</sup> June 2004 endorsed “not called for”. The returned envelopes bear an indication that the registrar sent further copies of the documents by ordinary post. I am unable to tell from the papers before me on which date these further copies may have been sent but I have no reason to doubt that it was done on receipt of the returned letter as is usual practice. These further copies were not returned by the Royal Mail.

30. Section 7 of the Interpretation Act 1978 provides that:

“Where an Act authorises or requires any document to be served by post (whether the expression “serve” or the expression “give” or “send” or any other expression is used) then, unless the contrary intention appears, the service is deemed to be effected by properly addressing, pre-paying and posting a letter containing the document and, unless the contrary is proved, to have been effected at the time at which the letter would be delivered in the ordinary course of the post”.

31. Referring to the service of documents under Rule 31 in the case of *Ms AJ Coggins and Skjelland Group AS* (O-340-04), Mr Geoffrey Hobbs QC sitting as the Appointed Person said that service of documents:

“is deemed to have been effected when they were sent, i.e. despatched, to her address for service by pre-paid post under cover of the unreturned letter of 23 January 2004.”

32. In any event Mr Maitland claims not to have received any such letters because, essentially: (1) the address to which the letter was sent was not his address but his mother’s; (2) his mother died in June of 2003; (3) he moved to a new address in August 2003; (4) he filed notification of his new address with the registrar in November 2003; (5) the registrar took no action on the notification; and (6) the applicant was aware of the registered proprietor’s business address and should have informed the registrar.

33. Whilst I accept the first three of Mr Maitland’s claims, I am unable to accept the remaining three.

34. In respect of the fourth claim outlined above, despite a thorough search of all the relevant papers, including the application files, I can find no indication that a Form TM21 or any other documentation seeking a change of address was ever filed in respect of either of these two registrations. Mr Maitland did file what he says was a copy of the form he had filed on 3 November 2003. This “copy” was filed in August 2006 and referred only to Registration No. 2308256. As with many official forms the Form TM21 has been subject to a number of reviews over the years. As set out in paragraph 8 above, he could not have filed this form in November 2003 as this particular version was not introduced or available for use until October 2004. Following a challenge on this point, Mr Maitland said, in a letter dated 22 August 2006, that whilst he did not keep a copy of it, he did file a form requesting a change of address on 3 November 2003. He gave no details to explain how he could be so

specific about the date he says the original form was filed when he had not kept a copy of it.

35. In respect of claim five outlined above, the registrar cannot action a request which he has not received.

36. In respect of the sixth claim outlined above, I accept, and indeed it is not disputed, that the applicants knew of Mr Maitland's company's office address. But I fail to see the relevance of this. The registrations were and remained recorded in Mr Maitland's personal name. As he was required to do, he provided an address for service within the UK. It was up to Mr Maitland to specify which address he wanted recorded. He chose the Lindsay Drive address. It is well established that the registrar is entitled to accept the address for service provided at face value. The onus to notify the registrar of any change of a registered proprietor's address or a change of his address for service, rests solely with that registered proprietor.

37. The registered proprietor not having not filed a Form TM8 and counter-statement under Rule 33(2), proceedings continued and led to the issue of the single decision on 11 May 2006. A copy of the decision was sent to Mr Maitland at his recorded address for service but was returned marked "person not known at this address".

38. Despite his claims that the applicant could have told the registrar of his current contact address, in his submissions at the hearing Mr Maitland accepted that the onus was on him. In these cases, there is no evidence that he discharged that onus. I am unable to find that there was any failure on the part of the registrar in this regard.

39. That being the case, I did not consider that the relief Mr Maitland sought was within my powers. I also bear in mind the comments of Mr Simon Thorley QC sitting as the Appointed Person in *OMI International PLC v EMITEC Gesellschaft Fur Emissionstechnologie MBH* (BL O-018-02), where he said:

"Once the Registrar has issued a decision revoking a trade mark she is functus and can thereafter not revisit her decision."

40. Whilst Mr Thorley's decision was in relation to an application to revoke a trade mark registration, I believe the same applies to all decisions of the registrar including decisions regarding the invalidation of a registration.

41. I therefore upheld the registrar's preliminary view, refusing to set aside the decision and re-open proceedings.

42. For completeness, and for the benefit of any appellant tribunal, I would add that neither party sought an award of costs and therefore I made no such award.

**Dated this 4th day of January 2007**

**ANN CORBETT**  
**For the Registrar**  
**The Comptroller-General**