

O-025-09

**TRADE MARK REGISTRATION No. 1100363  
AVON GRIPSTER (stylised) IN CLASS 12  
IN THE NAME OF COOPER TIRE AND RUBBER COMPANY**

**AND**

**APPLICATIONS FOR RECTIFICATION OF THE REGISTER  
AND CORRECTION OF A PROCEDURAL IRREGULARITY**

## **Background.**

1. Trade mark application 2227320 was filed in the name of Norhead Ltd, of Uttoxeter, Staffordshire ('Norhead') on 27<sup>th</sup> March 2000. The details of the application are as follows:

GRIPSTER

Class 12

Agricultural tyres

2. The mark was accepted and advertised for opposition purposes. On 23<sup>rd</sup> June 2003 Cooper Tire and Rubber Company, of Ohio, United States of America ('Cooper') opposed the application.

3. The application was opposed on the basis of sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994. Details of the earlier right upon which the s.5(2) opposition was based are as follows:

UK Trade Mark No 1100363



Class 12

Tyres for vehicle wheels

Filing and registration date: 18<sup>th</sup> August 1978

4. There is a disclaimer recorded in the register for this mark as follows:

“Registration of this mark shall give no right to the exclusive use of the word “Gripster””

5. On 19<sup>th</sup> April 2004, the applicant duly filed a counterstatement to the opposition. The counterstatement noted that Cooper's earlier trade mark was the subject of the disclaimer noted above, in consequence of which the proprietor's rights conferred by section 9 of the Act were restricted accordingly.

6. On 8<sup>th</sup> March 2004 the subject application had been assigned from Norhead to Hercules Tyres Ltd of 66 Outram Street, Sutton in Ashfield, Nottinghamshire

(‘Hercules’). This assignment was recorded on the register and published in the Trade Marks Journal of 21<sup>st</sup> May 2004.

7. From this point on all references to sections of the Act and to the Rules are references to the Trade Marks Act 1994 and the Trade Mark Rules 2000, unless the context of the reference requires otherwise or the contrary is indicated. The relevant sections of the Acts and the various Rules made under them are set out in Annex A.

8. On 21<sup>st</sup> July 2004, Cooper applied under the provisions of s.64(1) of the Act to rectify the register to remove the disclaimer referred to above. Cooper said that as of 18<sup>th</sup> August 1978 the word ‘Gripster’ qualified as an ‘invented word’ in accordance with s.9(1)(c) of the Trade Marks Act 1938. The word ‘Gripster’ moreover was not common in the automotive trade in general nor was it descriptive or otherwise non-distinctive. Thus it was eligible for separate registration under s.9(1)(c) or (d) of the 1938 Act at the time of registration, and still was in 2004.

9. Consequently, the requirement of the Registrar that exclusive rights in the word ‘Gripster’ be disclaimed in accordance with s.14(b)(i) of the Trade Marks Act 1938 was an error on the part of the Registrar.

10. At the same time as filing the application for rectification, Cooper asked for an extension of time in which to file evidence in the opposition stating that the application for rectification would have a “material bearing” on the outcome of the opposition. By letter dated 2<sup>nd</sup> August 2004 the registrar indicated that the requested extension of time to file evidence in the opposition should be refused on the basis that the time requested was not for the proper purpose of preparing evidence in the opposition.

11. Meanwhile, the application for rectification was considered by an official in the Administration area of the Registry, Mr Roger Evans, who was Deputy Head of that area of the Trade Marks Registry at the time. He says, in a witness statement dated 24<sup>th</sup> January 2005 that he received the application for rectification from the Registry’s Law Section on 23<sup>rd</sup> July 2004. It was referred to him because the section had not come across an application of this type before. He allowed the application to rectify on the basis that he could not discern, having regard to s.14(1)(b) of the Trade Marks Act 1938, any reason why the disclaimer might have been considered an appropriate condition to the registration of the mark now owned by Cooper. He did not take any possible third party interest in the removal of the disclaimer into account as he thought that this had already been done by the Registry’s Law Section. Thus, in effect, the application had been considered on an ex-parte basis only. A member of Mr Evans’ staff subsequently conveyed his decision to Cooper in a letter dated 30<sup>th</sup> July 2004. The letter said that the Patent Office was “satisfied that, at the time of application, the disclaimer was entered in error” and continued “In accordance with section 64(3) .... I deem the error in respect of the registration was never made.”

12. By letter dated 4<sup>th</sup> August 2004, Hercules, the new owners of the trade mark application, applied to intervene in the rectification proceedings. The application for intervention was rejected in a letter from the Registry dated 9<sup>th</sup> August 2004, which expressed the preliminary view that the rectification application had already been

determined. On 23<sup>rd</sup> August 2004, Hercules asked to be heard on the matter of intervention.

13. On 24<sup>th</sup> August 2004, Cooper, in connection with the Registrar's refusal of the extension of time request in the opposition proceedings, withdrew its opposition under section 5(4)(a) of the Act and elected to proceed only with the ground under section 5(2)(b), which required no evidence. That letter appears to have crossed with a letter from the then Head of Law Section, Mr Keven Bader, dated 25<sup>th</sup> August 2004. This letter, sent separately to both parties, forms the 'genesis' of the matter currently before me and it needs to be reported in detail.

14. Mr Bader stated that he had reviewed the case and that it was clear to him that there might be a party (Hercules) who would be affected by the removal of the disclaimer and therefore Rule 45(1)(b) applied. Notice of intention to remove the disclaimer had not been sent to Hercules as required by that Rule and therefore a 'procedural irregularity' had taken place. To put matters right, Mr Bader set a three month period for Hercules to file a notice of opposition or their objections, if any, to the removal of the disclaimer. In consequence he determined that Hercules' request to intervene was no longer necessary and that the hearing that had been requested to determine that issue was not therefore required.

15. Mr Bader's letter also dealt with the consequences of Cooper's failure to file evidence in support of its opposition within the period allowed. It is not necessary to go into this in any more detail than to record that following a procedural hearing on 9<sup>th</sup> December 2004 it was decided (a) to allow Cooper's opposition to Hercules trade mark application to continue under section 5(2)(b) alone; (b) that a second ground of opposition under section 5(4)(a) based on Cooper's claimed common law rights under the name 'Gripster' should be struck out and (c) that Cooper's opposition proceedings should be suspended pending the outcome of its rectification application. Thus the focus then transferred to the reinstated rectification action.

### **The Reinstated Rectification Application**

16. On 18<sup>th</sup> November 2004, Hercules filed an opposition to Cooper's application for rectification of its earlier trade mark registration. In summary, Hercules:

- a) Challenged Cooper's claim that 'Gripster' qualified for registration under s.9(1)(c) or (d) of the Trade Marks Act 1938.
- b) Pointed out that no evidence had been provided to show that any 'error' had arisen as a result of actions on the part of the Registrar. Even if the Registrar had required the disclaimer as a condition of registration the entry of the disclaimer in the register could not be said to be an error.
- c) Claimed that the application to rectify the registration by the removal of the disclaimer was outside the scope and jurisdiction of section 64 entirely because, inter alia, the disclaimer was entered with the consent of the applicant and was therefore procedurally regular.

- d) Submitted that the Registrar was empowered to determine the question of a disclaimer once and once only, and that it was not therefore open to the Registrar to revisit a procedurally regular entry of a disclaimer.

17. On 31<sup>st</sup> December 2004, Cooper filed its notice of defence and counterstatement to Hercules' opposition to its application for rectification. It maintained that the entry of the disclaimer on the register was a mistake on the part of the Registrar. Cooper maintained that such an error was rectifiable under section 64 and, whilst admitting that the removal of the disclaimer affected the scope of protection of the mark, argued that it did not affect the validity of the mark in suit (which would otherwise have excluded the application of s.64(1)).

18. Fiona McBride filed a witness statement dated 9<sup>th</sup> March 2005 on behalf of Cooper. She is a partner in the firm Withers and Rogers who acted for Cooper at that time. She says that at the time of filing UK Registration 1100363, Cooper did not own the mark: it was owned by Avon Rubber plc, whose agents were D Young & Co. The mark was assigned to Cooper in 1999. In consequence she could not vouch for the circumstances surrounding the entry of the disclaimer. Exhibit FMB2 is a copy from 'The Shorter Oxford English Dictionary in Historical Principles' covering the words listed alphabetically from GRINT to GROOM. There is no entry for the word 'gripster'. Given that the scope of this dictionary embraced not only colloquial and literary English but also obsolete, archaic and dialectal uses, she says that this shows that 'gripster' never was a known word. Thus the word 'Gripster' was registrable with or without the stylised word 'Avon'.

19. Cooper also filed the witness statement from Roger Evans, the contents of which I have already described above.

20. Hercules filed no evidence.

21. On 10<sup>th</sup> August 2005 the Registry wrote to the parties, noting that a decision of the High Court had just issued on 29<sup>th</sup> July 2005 in the case of *General Cigar Co Inc. v Partagas y Cia SA* [2005] FSR 45 (the "Cifuentes proceedings"). In his judgment in that case, Mr Justice Collins had upheld the Registrar's published practice of rejecting oppositions under s.5(2) of the Act alleging a likelihood of confusion with an earlier trade mark in circumstances where the only similarity between the later trade mark and the earlier mark related to an element of the earlier mark that was the subject of a disclaimer of any exclusive rights. However, at paragraph 90 of his judgment the judge had speculated that an application under s.64(5) to remove a disclaimer may be possible where the basis for the original disclaimer reflected a particular approach at the time which had subsequently been superseded. Mr Justice Collins then stayed the Cifuentes proceedings before him to allow such an application under section 64(5) to be made and determined. Consistent with the Registrar's decision to treat the current proceedings as proceeding under s.64(5), the Registry proposed a further suspension of Cooper's application to rectify to await the final outcome of the Cifuentes proceedings. Cooper agreed to this course. Hercules did not object.

22. In the event, although an application under s.64(5) was apparently made in the Cifuentes proceedings, it does not appear to have been pursued. The instant

rectification proceedings were lost sight of until the middle of 2008 when the Registrar proposed that a hearing be scheduled. A hearing was subsequently set for 9 December 2008. Cooper's agents (by then Frank B Dehn & Co) instructed Mr M Edenborough of Counsel to represent Cooper. Mr Edenborough filed a skeleton argument a few days before the hearing. Having read his skeleton it appeared to me that Cooper did not intend to advance any arguments at the hearing in support of the merits of its rectification application. Instead the skeleton amounted to an application under Rule 74 of the Trade Mark Rules 2008 for the correction of an irregularity in procedure. Hercules' agent was unable to obtain instructions to waive the requisite 14 days notice of the hearing of this application. Consequently, I postponed the hearing until 19 January 2009 so that it could cover both Cooper's Rule 74 application and the rectification application.

23. In the event, Hercules was not present or represented at the hearing. Cooper was represented by Mr Edenborough.

### **Cooper's Case**

24. Cooper's case is that Hercules' opposition to its application for rectification should be struck out under Rule 74 of the Trade Mark Rules 2008. As I understand it, the justification for the Rule 74 application is that:

- a) The Registrar's decision of 30 July 2004 to rectify the register by removing the disclaimer of "Gripster" from Cooper's registration was regular and should stand.
- b) The Registrar's subsequent decision of 25 August 2004 was therefore irregular because:
  - i) The 30 July decision terminated the rectification proceedings under s.64(1);
  - ii) The subsequent decision of 25 August 2004 incorrectly treated the application as a continuing application under s.64(5) and therefore wrongly assumed that an opposition to the application was possible under Rule 45(1)(b);
  - iii) Even if the 30 July 2004 decision was procedurally irregular, the Registrar was *functus officio* after making it.

25. It is submitted on behalf of Cooper that in view of the above the Registrar should treat all the events in the rectification proceedings subsequent to 30 July 2004 as an irregularity in procedure. The irregularity should be corrected by treating the disclaimer of "Gripster" as having been properly removed on 30 July 2004, and striking out the subsequent rectification proceedings.

26. It will be appreciated that in order to determine whether the decision of 25 August 2004 was procedurally irregular it is also necessary to determine whether the earlier decision it set aside was procedurally regular as Cooper contends.

## **Decisions of 30 July 2004 and 25 August 2004 – Irregularities in Procedure?**

27. Prior to the hearing, I invited Cooper to comment on the relevance (if any) of Rule 54 to the procedural regularity of the decision of 30 July 2004. On behalf of Cooper Mr Edenborough submitted that:

- a) The procedure in Rule 34 for the processing of an application for rectification made by the proprietor of a registered trade mark is *ex parte*.
- b) The Registrar was therefore under no duty to give Hercules the right to be heard before granting Cooper's application for rectification.
- c) The requirement in Rule 54 that the Registrar shall "before taking any decision on any matter under the Act or these Rules which is or may be adverse to any party to any proceedings before her, give that party an opportunity to be heard", should not be taken to mean that a party to proceedings A has a right to be heard in relation to a prospectively adverse decision taken in proceedings B. Rather the words "any party to any proceedings" in Rule 54 should be taken to mean 'any person who is a party to the proceedings before the Registrar, whatever kind of proceedings they may be' rather than literally 'any party to any current proceedings'. This interpretation was said to be consistent with Rule 54's role as a 'sweeping up' provision guaranteeing a right to be heard in any proceedings to which a person is a party even where there is no express right to be heard specified in the Sections and Rules governing those proceedings.
- d) In any event, the Registrar was *functus* after the decision of 30 July 2004 and therefore had no power to correct that decision, even if it was procedurally irregular.

28. In response to a concern that I expressed at the hearing, Mr Edenborough submitted that his suggested approach would not operate so as to deny Hercules any opportunity to object to the removal of the disclaimer before the "material bearing" that this would have had on its opposed trade mark application had taken effect. According to Mr Edenborough, the proper course was for Hercules to have applied to intervene in the rectification proceedings under Rule 35 thereby becoming a party to those proceedings and acquiring a right to be heard in their determination.

29. Hercules did of course make such an application on 4 August 2004, just 15 days after Cooper's application for rectification on 21 July 2004, but on Mr Edenborough's analysis this was too late because the Registrar had processed Cooper's application with unusual speed and granted it on 30 July 2004, just 9 days after it was made.

30. I reject the interpretation of Rule 54 contended for on behalf of Cooper. I agree that Rule 54 (which has now been superseded by Rule 63 of the Trade mark Rules 2008) did not require the Registrar to give any person a right to be heard before the

making of any decision that may adverse to them. That would have placed an impractical burden on the Registrar and unduly weigh down the tribunal's processes. However, where, as here, there were related proceedings before the Registrar involving the same subject matter (Cooper's trade mark and the disclaimer) and it was apparent that the outcome of an application made in proceedings A in relation to that subject matter was likely to have a material bearing on the outcome of proceedings B, I believe that Rule 54 required the Registrar to give the other party to proceedings B an opportunity to be heard on the application before making a decision that was liable to be adverse to that party in those proceedings.

31. Doing otherwise in this case meant that Hercules was effectively denied an opportunity to be heard on Cooper's application to remove the disclaimer of "Gripster" from the registration of the earlier trade mark in the opposition proceedings. This was despite the fact that the applicant for rectification had itself acknowledged that the outcome of its rectification application was liable to have a "material bearing" on the outcome of the opposition proceedings. Cooper was plainly right in its assessment of the significance of the application to remove the disclaimer to its opposition to Hercules trade mark application. With the disclaimer in place Cooper's s.5(2) ground of opposition was bound to fail as a matter of law. With it removed, there was a good prospect that the ground would succeed and Hercules' trade mark application would be refused. In these circumstances and notwithstanding the absence of a specific requirement in Rule 34, Rule 54 required that Hercules should be given an opportunity to be heard before a decision was made on Cooper's application.

32. I have adopted a relatively literal interpretation of Rule 54. However, if there is any ambiguity in the meaning of the Rule I believe that I should resolve it in Hercules favour. This is because:

- a) Trade Mark applications represent a property right;
- b) Property rights are covered by Article 1 of the 1<sup>st</sup> Protocol to the European Convention of Human Rights (ECHR);
- c) Article 6 of the ECHR guarantees a right to a fair trial;
- d) Cooper's application to remove the disclaimer from the earlier trade mark was likely to be determinative of a ground in the opposition proceedings;
- e) Making a decision on Cooper's application without giving Hercules an effective right to be heard therefore contravened Hercules right to a fair hearing in the opposition proceedings;
- f) Section 3 of the Human Rights Act 1998 (HRA) requires that legislation, including subordinate legislation, be read as far as possible in a way that is compatible with the ECHR.

33. Mr Edenborough disagreed that the HRA required the interpretation I have placed on Rule 54. This was because:

- a) The opposition proceedings were the vehicle for resolving Hercules' rights in its application and Hercules had a right to be heard in those proceedings;
- b) Hercules was not directly affected by the outcome of the rectification proceedings;



- c) If Hercules was adversely affected by the removal of the disclaimer it could have applied for a judicial review of the decision of 30 July 2004, thereby satisfying Article 6 ECHR without resorting to a broad interpretation of Rule 54;
- d) The suggested interpretation of Rule 54 was, in any event, too much of a stretch to be accommodated under s.3 of the HRA.

34. My finding that the rectification application, if successful, was likely to be determinative of a ground in the opposition proceedings and that Hercules had no effective opportunity to be heard about that matter is sufficient to dispose of points a) and b). I do not regard the availability of judicial review to correct any incompatibility between the Rules and the ECHR as being relevant to the question of whether the Rules should be interpreted in a way that is consistent with the ECHR. I therefore reject point c). In any event, Cooper's apparent acceptance of the 25 August 2004 decision setting aside the earlier decision of 30 July 2004 effectively removed any question of a judicial review of that decision in this case. I also reject point d). Far from being a stretch, the interpretation of Rule 54 that I have adopted simply attaches a literal meaning to the words in that Rule rather than the purposive interpretation (plausible though it is) proposed by Mr Edenborough.

35. It appears from Mr Evans' witness statement that he was the person who made the decision to accept the rectification application on behalf of the Registrar. In doing so it seems as though Mr Evans was under the mistaken belief that another section in the Office had somehow taken account of any third party interest in the application before passing the papers to him. This misunderstanding meant that the Registrar took no account of any apparent third party interest in the application before it was determined in Cooper's favour. In *Rapier Trade Mark* BL O/170/07, Mr Geoffrey Hobbs Q.C. as The Appointed Person held (at paragraph 56) that a decision taken in breach of Rule 54 was procedurally irregular and capable of being corrected under Rule 66. For the reasons given above I therefore conclude that the decision of 30 July 2004 was procedurally irregular.

36. It follows that the later decision of 25 August 2004 was not procedurally irregular to the extent that it set aside the earlier decision of 30 July 2004 on the grounds that it was made without giving Hercules a right to be heard.

37. It was procedurally irregular in that it purported to treat Cooper's application as an application under s.64(5) for the removal from the register of matter which had ceased to have effect, and consequently invoked the related opposition procedure in Rule 45(2). It follows that Hercules' subsequent formal opposition and Cooper's formal defence to it were also strictly procedurally irregular. However, the misuse of the Rule 45 procedure does not appear to have had any undue consequences. The parties continued to treat the rectification application as having been made under s.64(1). The Notice of Opposition and Counterstatement were used to set out in the form of pleadings, objections to, and arguments for, the s.64(1) application, which could otherwise have been made simply as written submissions.

## **Was the Registrar *Functus Officio* after the decision of 30 July 2004?**

38. On the footing that the decision of 30 July 2004 was procedurally irregular, I find that the Registrar was not, and is not, *functus officio* as regards the rectification proceedings. I am fortified in that view by the analysis of the relevant law by Mr Geoffrey Hobbs Q.C., again as The Appointed Person, in paragraphs 15 to 45 of his decision in *Andreas Stihl AG & Co's Application* [2001] RPC 12. I will not set out the whole of Mr Hobbs' analysis here. It is sufficient to record his conclusions at paragraph 43 of his decision.

“43. I think it is open to the registrar in the context of the Act and the rules as a whole to rectify procedurally irregular acts of registration and procedurally irregular refusals of registration as and when they occur. I am reinforced in that view by the provisions of [sections 12\(1\), 21\(1\) and 23\(1\) of the Interpretation Act 1978](#) which make it a rule that where an Act or subordinate legislation "confers a power ... it is implied, unless the contrary intention appears, that the power may be exercised from time to time as the occasion requires". I am aware that this provision was enacted for the purpose of overcoming the inconvenience formerly caused by the doctrine that a statutory power was exhausted by its first exercise unless a contrary intention could be discovered: see Halsburys Laws of England, 4th Edn, Vol. 44(1), (1995 re-issue) para. 1343. It is nonetheless sufficient, in my view, to confirm that the discretionary power should be exercised when the occasion for its exercise has in fact arisen, whether by way of a procedurally irregular act of registration or by way of a procedurally irregular refusal of registration or in some other way. To confine the exercise of the discretionary power to the period during which an application for registration remains pending would be to place a limitation upon the scope of it which the legislation does not appear to me to envisage.”

39. I acknowledge that the part of Mr Hobbs' decision on which I rely is strictly obiter. This is because Mr Hobbs went on to accede to a request from the Registrar for the matter to be referred to the court under s.76(3) of the Act. However, no such application to the court was ever made and the Registrar subsequently changed the Office's practice in accordance with Mr Hobbs' assessment of the law. This was no doubt because the reasoning in Mr Hobbs' written decision was comprehensive and compelling and left little room for doubt as to correct position in law. For this reason, I respectfully adopt his reasoning and conclusions. The case before Mr Hobbs concerned a procedurally irregular registration. However, I have no doubt that the same reasoning can be applied to a procedurally irregular rectification. Indeed in the penultimate sentence of the paragraph that I have highlighted, Mr Hobbs expressly envisaged the power to correct procedural irregularities being exercised to reverse other concluded actions.

40. Mr Edenborough submitted that the Registrar's decision of 30 July 2004 should be distinguished from the types of purely procedural errors apparent in the *Andreas Stihl* case. In Mr Edenborough's submission, the decision of 30 July 2004 was a substantive decision on the merits of the application which should only have been set aside through appeal. By contrast, the Registrar's subsequent decision of 25

August 2004 (which Cooper now asks to be set aside on the grounds that it was procedurally irregular) was a procedural decision. Accordingly, the Registrar is *functus officio* with regard to the first decision, but not *functus officio* with regard to the second decision.

41. I reject the distinction that Mr Edenborough seeks to make on behalf of Cooper. I have found that the Registrar's decision of 30 July 2004 was procedurally irregular. In those circumstances the fact that it purported to make substantive findings was neither here nor there.

42. I therefore reject the submission that the Registrar was *functus* with regard to the rectification application at the time of the decision of 25 August 2004.

### **The Outcome of Cooper's Application under Rule 74 of the Trade Mark Rules 2008**

43. It follows from the above findings that I believe that I have a discretionary power under Rule 74 of the Trade Mark Rules 2008 to correct any irregularity in the Registrar's decision of 25 August 2004. The question remains whether I would be justified in exercising that discretion.

44. I can think of two good reasons for not doing so. Firstly, Cooper delayed for over 4 years before making an application to have the decision of 25 August 2004 set aside as irregular. Secondly, by filing a formal defence to Hercules opposition to its application for rectification, Cooper acted as though it had accepted that decision.

45. Nevertheless, there is one aspect of the Registrar's decision of 25 August 2004 which must be set aside. It was plainly irregular to treat Cooper's application under s.64(1) as an application under s.64(5) without Cooper having made an application to amend its case. I will therefore correct that irregularity by setting aside those aspects of the decision that invoked the formal opposition procedure envisaged in Rule 45(2).

46. The decision to set aside the 30 July 2004 decision on the grounds that Hercules should have been given a prior opportunity to object to it was not irregular. Consequently, that part of the decision of 25 August 2004 should stand. The subsequent formal opposition and counterstatement should be treated as simply Hercules' written objections to Cooper's s.64(1) rectification application, and Cooper's submissions in response. This approach respects both Cooper's and Hercules' rights to be heard on the s.64(1) application without unnecessarily disturbing the course of proceedings that have already taken far too long.

### **The outcome of the s.64(1) rectification application**

47. The net effect of the above findings is, however, that Cooper's s.64(1) application remains outstanding. I will therefore determine the application taking into account the written arguments from Cooper's 'counterstatement', the written arguments from Hercules 'opposition' and the oral submissions made on behalf of Cooper by Mr Edenborough at the hearing.

48. Much of Cooper's case focuses on whether the disclaimer of 'Gripster' was justified according to the case law under the Trade Marks Act 1938 as it applied at the time of Cooper's predecessor's application for registration in 1978. According to Cooper, 'Gripster' qualified as an invented word under s.9(1)(c) of the 1938 Act and therefore qualified for registration in Part A of the two part register maintained under that Act. On that footing, there was no need for the applicant to have disclaimed rights to the word 'Gripster' as part of the composite Avon (stylised) Gripster trade mark.

49. Whether the word 'Gripster' qualified for registration under s.9(1) of the Trade Marks Act 1938 turns on whether the word was at that time more than a trivial variation on the undeniably descriptive word 'grip', or a word composed of that descriptive word with a 'trifling addition'. However, I do not find it necessary or appropriate to determine whether or not the disclaimer was necessary in 1978. I am satisfied that its entry in the register was not an error. It is not clear on the evidence whether the disclaimer was proposed by the applicant for registration or required by the Registrar under Rule 34 of the Trade Mark Rules 1986 as a condition of registration. If the disclaimer was proposed by the applicant (whether or not in anticipation of a requirement of the Registrar) it seems to me to be stretching the language of s.64(1) well past breaking point to describe the entry of the disclaimer in the register as an error.

50. However, even if the disclaimer was required by the Registrar, the applicant had the right under Rule 34(2) of the Trade Mark Rules 1986 to object to that requirement and to be heard. Further, if the applicant maintained his objection to any such requirement, Rule 35 of the 1986 Rules provided a right of appeal against the imposition of a disclaimer. There is no evidence that the applicant for registration objected to the disclaimer. On the contrary, the entry of the disclaimer in the application form indicates that the applicant for registration at least consented to the disclaimer under Rule 34(3) of the 1986 Rules. In these circumstances I do not see how the entry of the disclaimer in the register maintained under the 1938 Act can be regarded as error.

51. According to paragraph 3(2) of Schedule 3 to the Trade Marks Act 1994, disclaimers entered in the register maintained under the 1938 Act were transferred to the register created by the 1994 Act and treated as having been made under s.13 of that Act. Consequently, if the disclaimer was not entered in error under the 1938 Act, the transfer of the disclaimer to the current register cannot have created any error. Further, the requirement to treat the disclaimer as having been entered under s.13 of the 1994 Act provides a further obstacle to re-examining the trade mark in order to re-assess whether the disclaimer was objectively justified in 1978 under the preceding legislation and the case law made under it. Indeed, in the light of the transitional provisions in the 1994 Act and the absence of any express provision for third parties to oppose applications under s.64(1) for the removal of longstanding disclaimers, I find it hard to imagine that Parliament could have had intended s.64(1) to be used for this purpose, at least where the entry of the disclaimer was procedurally regular.

52. For the avoidance of doubt, I do not by these comments mean that Cooper should have made its application under s.64(5) instead of s.64(1), as perhaps

implied in the Registrar's decision of 25 August 2004. It is not obvious to me how a disclaimer can be said to have "ceased to have effect" when the very reason for making the application is the undesired limiting effect it continues to have on the proprietor's rights. However, the potential relevancy of s.64(5) to this type of application must remain open until a suitable application comes before the Registrar.

53. For all the reasons given above, I reject the application for rectification under s.64(1).

### **Costs**

54. I will direct that the £200 official fee paid by Hercules to file the unnecessary Notice of Opposition on Form TM7 should be refunded.

55. Hercules has played no further active part in the rectification proceedings. I will therefore make no further award of costs.

56. Cooper has asked for the Registrar to pay its costs because of the multiple errors in the handling of this application. Before me, Mr Edenborough accepted that I had no power to award costs against the Registrar. It is therefore for Cooper to make a request to the Registrar outside of these proceedings for any appropriate compensation that it can quantify and show is due.

**Dated this 26<sup>th</sup> day of January 2009**

**Allan James  
For the Registrar**

## **Annex A**

### **Trade Marks Act 1938**

#### **Section 9(1)**

In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness

#### **Section 14.**

If a trade mark-

- (b) contains matter common to the trade or otherwise of a non- distinctive character;

The Registrar or the Board of Trade or the Court, in deciding whether the trade mark shall be entered or shall remain on the register, may require as a condition of its being on the register, -

- (i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter as aforesaid, to the exclusive use of which the tribunal holds him not to be entitled;
- ii) that the proprietor shall make such other disclaimer as the tribunal may consider necessary for the purpose of defining his rights under the registration:

Provided that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

## **The Trade Marks and Service Marks Rules 1986**

### **Rule 34(1)**

If the Registrar is willing to accept the application subject to any conditions, amendments, disclaimers, modifications or limitations he shall send to the applicant written notice of such willingness.

### **Rule 34(2)**

If the applicant objects to such conditions, amendments, disclaimer, modifications, or limitations he shall within six months from the date of the receipt of the notice apply for a hearing or file his considered objections in writing, and if he does not do so he shall be deemed to have withdrawn his application.

### **Rule 34(3)**

If the applicant does not object to such conditions, amendments, disclaimer, modifications, or limitations he shall within six months from the date of the receipt of the notice file a written statement of his absence of objection and alter his application accordingly, and if he does not do so he shall be deemed to have withdrawn his application.

### **Rule 35**

1)When the Registrar has made a decision following a hearing as mentioned in Rule 33 or 34(2) above or, if the applicant has not applied for a hearing in accordance with those Rules, after considering any considered reply or considered objections filed in accordance with those Rules the Registrar shall send his decision to the applicant in writing

2)If the applicant objects to the decision he may within one month from the date of receipt of the decision by filing form TM5 require the Registrar to state in writing the grounds for his decision and the materials used by him in arriving at it

3)Where the applicant does not object to every condition, amendment, disclaimer, modification or limitation sent to him under Rule 34(1) above, the Registrar may decline to issue a statement as required in paragraph (2) above until the applicant has altered his application with those to which he does not object

4)The date when the statement is sent to the applicant shall be deemed to be the date of the Registrar's decision for the purpose of appeal

## **The Trade Marks Act 1994**

### **Paragraph 3(2) of schedule 3**

A disclaimer or limitation entered on the former register in relation to an existing registered mark immediately before the commencement of this Act shall be transferred to the new register and have effect as if entered on the register in pursuance of section 13 of this Act.

### **Section 5**

(2) A trade mark shall not be registered if because –

(a) -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,

### **Section 9**

(1) The proprietor of a registered trade mark has exclusive rights in the trade mark which are infringed by use of the trade mark in the United Kingdom without his consent.

The acts amounting to infringement, if done without the consent of the proprietor, are specified in section 10.

(2) References in this Act to the infringement of a registered trade mark are to any such infringement of the rights of the proprietor.

(3) The rights of the proprietor have effect from the date of registration (which in accordance with section 40(3) is the date of filing of the application for registration):

Provided that –

(a) no infringement proceedings may be begun before the date on which the trade mark is in fact registered; and

(b) no offence under section 92 (unauthorised use of trade mark, &c. in relation to goods) is committed by anything done before the date of publication of the registration.



### **Section 13**

(1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may –

- (a) disclaim any right to the exclusive use of any specified element of the trade mark, or
- (b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation;

and where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 9 (rights conferred by registered trade mark) are restricted accordingly.

(2) Provision shall be made by rules as to the publication and entry in the register of a disclaimer or limitation.

### **Section 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.

## **Trade Marks Rules 2000 (as amended)**

### **Rule 34**

(1) An application for rectification of an error or omission in the register under section 64(1) shall be made on Form TM26(R) together with:

(a) a statement of the grounds on which the application is made; and

(b) any evidence to support those grounds.

(2) Where any application is made under paragraph (1) by a person other than the proprietor of the registered trade mark the registrar-

(a) shall send a copy of the application and the statement, together with any evidence filed, to the proprietor; and

(b) may give such direction as she thinks fit with regard to the filing of subsequent evidence upon such terms as she may think fit.

(2A) A direction under paragraph (2)(b) may include a requirement that evidence shall only be considered filed when –

(a) it has been received by the registrar accompanied by Form TM54; and

(b) it has been sent to all other parties to the application.

(3) Where the periods for filing evidence specified in directions given under paragraph (2)(b) have expired, 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.

(4) 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.

### **Rule 35**

(1) Any person, other than the registered proprietor, claiming to have an interest in proceedings on an application under rule 31, rule 32, rule 33 or rule 34 may file an application to the registrar on Form TM27 for leave to intervene, stating the nature of his interest and the registrar may, after hearing the parties concerned if so required, refuse such leave or grant leave upon such terms and conditions (including any undertaking as to costs) as she thinks fit.

(2) Any person granted leave to intervene (the intervener) shall, subject to any terms and conditions imposed in respect of the intervention, be treated as a party to the proceedings for the purposes of the application of the provisions of rules 31 to 31B, rules 32 to 32B, rules 33 to 33B or rule 34 (as appropriate).

## **Rule 45(1) and (2)**

(1) Where it appears to the registrar that any matter in the register has ceased to have effect, before removing it from the register-

(a) -

(b) where any person appears to her to be affected by the removal, she shall send notice of her intention to that person.

(2) Within three months of the date on which her intention to remove the matter is published, or notice of her intention is sent, as the case may be-

(a) any person may file notice of opposition to the removal on form TM7;

and

(b) the person to whom a notice of opposition is sent under paragraph (1)(b) above may file, in writing-

(i) his objections, if any, to the removal, or

(ii) a request to have his objections heard orally;

and where such objections or opposition are made, rule 54 shall apply.

## **Rule 54**

(1) Without prejudice to any provisions of the Act or these Rules requiring the registrar to hear any party to proceedings under the Act or these Rules, or to give such party an opportunity to be heard, the registrar shall, before taking any decision on any matter under the Act or these Rules which is or may be adverse to any party to any proceedings before her, give that party an opportunity to be heard.

(2) The registrar shall give that party at least fourteen days' notice of the time when he may be heard unless that party consents to shorter notice.

## **Rule 66**

Subject to rule 68 below, any irregularity in procedure in or before the Office or the registrar, may be rectified on such terms as the registrar may direct.

## **Trade Marks Rules 2008**

### **Rule 74**

(1) Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office.

(2) Any rectification made under paragraph (1) shall be made—

(a) after giving the parties such notice; and

(b) subject to such conditions,  
as the registrar may direct.