

1 UK INTELLECTUAL PROPERTY OFFICE

The Rolls Building,
7 Rolls Buildings,
Fetter Lane,
London, EC4A 1NL.

4 Wednesday, 28th May, 2014

5 Before:

6 MR. GEOFFREY HOBBS Q.C.
(sitting as the Appointed Person)

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8 In the Matter of the Trade Marks Act 1994

9 -and-

10 In the Matter of a Request by EDGE INTERACTIVE MEDIA INC
11 ("EIM") for Recordal of Partial Assignment of UK Trade Mark
12 Application Nos. 2552136 and 2552147 in the name of
FUTURE PUBLISHING LIMITED ("FUTURE")

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14 (Appeal from Decision No. O/283/12 of Mr. David Landau, acting
15 on behalf of the Registrar, dated 25th July 2012)

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17 (Transcript of the Shorthand Notes of Marten Walsh Cherer
18 Ltd., 1st Floor, Quality House, 6-9 Quality Court,
Chancery Lane, London, WC2A 1HP.
19 Tel No: 020-7067 2900. Fax No: 020-7831 6864.
email: info@martenwalshcherer.com. www.martenwalshcherer.com)

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21 MR. ROBERT DEACON (instructed by Edge Interactive
Media Inc.) appeared for the Appellant.

22 MR. J.G. PEARSON (Abel & Imray) appeared for the Respondent.

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24 D E C I S I O N
25 (As approved by the Appointed Person)

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1 THE APPOINTED PERSON: On 5 July 2010, Future Publishing Limited
2 applied under no. 2552136 to register the word EDGE
3 graphically represented in a slightly stylised form as a trade
4 mark for use in relation to a wide variety of goods and
5 services in Classes 9, 16, 25, 35, 38 and 41. Also on 5
6 July 2010, it applied under no. 2552147 to register the word
7 EDGE graphically represented without any stylisation as a
8 trade mark for use in relation to the same wide variety of
9 goods and services in those classes. Both applications
10 proceeded to registration on 25 November 2011.

11 At the time of filing, Future Publishing Limited was in
12 dispute with the Edge Interactive Media Inc. over the
13 implementation and operation of the provisions of a Concurrent
14 Trading Agreement and Deed of Trademark Assignment made
15 between them on, and with effect from, 15 October 2004.
16 Future Publishing was contending that the 2004 Agreement had
17 come to an end on 2 July 2010, the day on which it had
18 written to Edge Interactive stating, "For the avoidance of
19 doubt, we hereby put you on notice that your client's breaches
20 of the CTA complained of in the Particulars of Claim amount to
21 a repudiation thereof and with effect from today's date our
22 client accepts that repudiation and treats the CTA as
23 discharged."

24 Edge Interactive was disputing that allegation and all
25 other allegations that Future Publishing was making against it

1 in connection with, and arising out of, the operation of the
2 2004 Agreement. They litigated their dispute in the Chancery
3 Division of the High Court in London and the litigation
4 culminated in a judgment delivered by Proudman J on 13 June
5 2011 under reference [2011] EWHC 1489 (Ch), which can be found
6 reported at [2011] ETMR 50.

7 Future Publishing succeeded in establishing all of the
8 claims it pursued at trial. As part of a comprehensive order
9 for relief made on 7 July 2011, it was declared that the
10 2004 Agreement had 'terminated with effect from 20th August
11 2010'. The judgment and order of the court became final on
12 7 February 2012 on refusal of Edge Interactive's application
13 to the Court of Appeal for permission to appeal. The
14 declaration made by Proudman J was and remains equivalent
15 to a mutually binding admission by Future Publishing and Edge
16 Interactive, from which neither of them can resile, to the
17 effect that the 2004 Agreement came to an end on 20 August
18 2010. That is all the more so in circumstances where
19 Proudman J considered and rejected an application by Future
20 Publishing on 15 January 2013 for amendment of her order
21 dated 7 July 2011 so as to declare that the 2014 Agreement
22 had terminated on 2 July 2010, rather than 20 August 2010.

23 Following the refusal of its application for permission
24 to appeal to the Court of Appeal, Edge Interactive filed an
25 application at the Trade Marks Registry on 7 March 2012 for

1 the recordal of an assignment-in-part of trade mark
2 registrations 2552136 and 2552147 then standing in the name of
3 Future Publishing. The Form TM16 was filed by Dr. (now Rev.
4 Dr.) Tim Langdell on behalf of Edge Interactive. It identified
5 Edge Interactive as 'the assignee' for the purposes of rule
6 48(a)(i) of the Trade Marks Rules 2008. It identified 5 July
7 2010 (the filing date of the applications which had matured
8 into the subject registrations) as 'the date of the assignment'
9 for the purposes of rule 48(a)(ii).

10 As stated in the notes to Form TM16, the form is not
11 itself a substitute for the assignment document or other proof
12 of the transaction to which the request for recordal relates.
13 When notified by the Registry of the filing of the Form TM16,
14 Future Publishing objected to it on the basis that there had
15 been, and could be, no assignment susceptible of recordal in
16 favour of Edge Interactive. Thereafter, the application for
17 recordal proceeded as a contested inter partes proceeding
18 between Edge Interactive and Future Publishing.

19 In order for the application for recordal to succeed,
20 Edge Interactive had to be able to produce a valid and
21 effective assignment transferring to it in writing the
22 property it claimed to have acquired on 5th July 2010 in
23 accordance with the requirements of sections 24(3) and 27(1)
24 of the Trade Marks Act 1994. It appeared from the Form TM16
25 and the letter of 5 March 2012 which accompanied it that

1 Edge Interactive was relying solely upon clause 2.8 of the
2 2004 Agreement as being sufficient in and of itself to effect
3 the necessary assignment in writing in accordance with the
4 requirements of those sections of the Act.

5 Subsequently, on 27 July 2012, Edge Interactive wrote to
6 the Registry enclosing a Deed of Assignment bearing the date
7 30 July 2010 which Dr. Langdell had signed both on behalf of
8 Future Publishing as assignor and on behalf of Edge Interactive
9 as assignee. On 17 July 2012, Dr. Langdell filed a skeleton
10 argument for use in the Registry proceedings. He
11 attached an affidavit made on 16 July 2012 in which he
12 claimed to have executed the Deed of Assignment on 30 July
13 2010 in the exercise of the rights conferred upon Edge
14 Interactive by clause 2.8 of the 2004 Agreement. Although he
15 referred in his affidavit to the assignment of 30 July 2010
16 as being 'exhibited hereto', what he actually exhibited was a
17 further Deed of Assignment dated 17 July 2012.

18 The application for recordal was refused for the reasons
19 given by Mr. David Landau, on behalf of the Registrar of Trade
20 Marks, in a written decision issued under reference
21 BL O/283/12 on 25 July 2012. In summary, the hearing
22 officer found, firstly, that clause 2.8 of the 2004 Agreement
23 was not sufficient in and of itself to effect an assignment of
24 the rights that Edge Interactive claimed to have acquired in
25 accordance with the requirements of the Act; secondly, that

1 Dr. Langdell's evidence and assertions with regard to the
2 execution of a Deed of Assignment on 30 July 2010, or indeed
3 at any time prior to 20 August 2010, were false; and, thirdly,
4 that it ceased to be possible for Edge Interactive to invoke
5 the provisions of clause 2.8 of the 2004 Agreement once it had
6 ended, as declared by the order of Proudman J, on 20 August
7 2010.

8 Edge Interactive appealed to an Appointed Person under
9 section 76 of the Trade Marks Act 1994 contending that the
10 hearing officer's decision was wrong in all three
11 of the respects I have identified. Future Publishing
12 filed a respondent's notice contending that the hearing
13 officer's decision should additionally, or alternatively, be
14 upheld on the basis that the 2004 Agreement terminated on 2
15 July 2010 in accordance with the notification of acceptance of
16 repudiatory breach which Future Publishing sent to Edge
17 Interactive on that date.

18 I can deal briefly with the point raised in the
19 respondent's notice. It is not open to Future Publishing or
20 Edge Interactive to contend that the 2004 Agreement terminated
21 on any date other than 20 August 2010. 20 August 2010 is,
22 for present purposes, conclusively determined by the final
23 order of Proudman J to have been the date of termination.

24 During the pendency of the appeal, there has been much
25 to-ing and fro-ing as to what was and was not being contended

1 by Edge Interactive in support of its appeal. The end result
2 of successive proposed amendments to the grounds of appeal is
3 that Edge Interactive no longer challenges the second of the
4 hearing officer's three findings, that is to say, there is no
5 issue as to the correctness of the hearing officer's
6 determination that Dr. Langdell's evidence and assertions with
7 regard to the execution of a Deed of Assignment prior to 20
8 August 2010 were false. It continues to challenge the first
9 and third of the hearing officer's findings. However, the
10 third of his three findings does not arise for determination
11 if the first of his three findings was correct, as I think it
12 was.

13 Clause 2.8 of the 2004 Agreement provided as follows:
14 "Subject to Clauses 2.6 and 2.7, Future further undertakes
15 that it shall not without prior written consent from EIM at
16 any time on or after Completion register or apply to register
17 in any country or otherwise use any trademark which is the
18 same as or similar to the Trademarks (or any one of them) in
19 respect of goods or services other than those detailed in the
20 Assigned Rights or as permitted pursuant to clause 2.1.2. In
21 the event that Future shall register or apply to register in
22 any country any such trademark in breach of this Clause 2.8,
23 Future shall forthwith and without prejudice to any other
24 rights of EIM under this Agreement and Deed assign all right,
25 title and interest in such trademark(s) in respect of those

1 goods and services, to EIM (at EIM's reasonable cost) on the
2 same terms as those set out in this Agreement and Deed, save
3 that no fee shall be payable by EIM to Future in respect
4 thereof. To guarantee compliance by Future with their
5 obligations under Clause 2.8, Future irrevocably appoints EIM,
6 with further power to delegate its powers to any director or
7 other duly authorised officer of EIM, to be their true and
8 lawful attorney and to do and perform any acts and to execute
9 any documents necessary or desirable in connection with this
10 Clause 2.8 and Future hereby undertakes to ratify whatever EIM
11 shall do or cause to be done under this power of attorney.
12 Save however, Future shall be free of the restraints on it
13 imposed by Clause 2.6, Clause 2.7 and this Clause 2.8 in the
14 event that EIM should cease use of the mark and brand EDGE for
15 a continuous period of five years or more or becomes insolvent
16 or ceases trading."

17 The regime established by clause 2.8 appears to me to be
18 quite clear. The clause begins with a restriction on Future
19 Publishing's freedom of action with regard to the registration
20 and filing of applications for registration of trade marks.
21 It then provides that if Future Publishing breaches that
22 restriction, it, Future Publishing, shall forthwith assign the
23 entirety of its right, title and interest in and to the
24 impermissible registrations and applications for registration
25 to Edge Interactive. It further provides Edge Interactive

1 with a power of attorney which it can, if it wishes, exercise
2 by way of self-help so as to effect the transfer of the
3 registrations and applications for registration to which it is
4 entitled under the antecedent provisions of the clause.
5 Finally, it places an obligation on Future Publishing to
6 ratify whatever Edge Interactive may lawfully have done in the
7 exercise of its rights under the power of attorney.

8 Unless and until the power of attorney was exercised by
9 Edge Interactive so as to effect the required transfer, the
10 registrations and applications for registration acquired by
11 Future Publishing in breach of the restriction at the front
12 end of clause 2.8 remained in the name of Future Publishing, but
13 subject to Edge Interactive's contractual right to acquire
14 them. That, in effect, left Future Publishing holding the
15 legal title to the relevant property on trust for Edge
16 Interactive until such time as Edge Interactive had either
17 sought and obtained an order for specific performance of the
18 obligation to transfer or validly exercised its power of
19 attorney.

20 So, when the Form TM16 is considered from that
21 perspective, it is apparent that on the specified date of 5
22 July 2010 Edge Interactive had no more than an equitable
23 interest in the then pending trade mark applications 2552136 and
24 2552147, with Future Publishing continuing to hold the legal
25 title thereto. No assignment of those applications (or the

