

O-301-16

1 UK INTELLECTUAL PROPERTY OFFICE

2 The Rolls Building,  
3 7 Rolls Building,  
London, EC4A 1NL

4 Monday, 6th June, 2016

5 Before:

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

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9 In the Matter of the Trade Marks Act 1994  
-and-  
10 In the Matter of Trade Mark Registration No. 2387842  
FROM RUSSIA WITH LOVE in Class 14  
11 in the name FABERGE LIMITED

-and-  
12 In the matter of an Application for Revocation  
No.500837 thereto by SIMMONS & SIMMONS LLP

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14 (Appeal of the Proprietor from the decision of Mr. Raoul  
15 Colombo, acting on behalf of the Registrar,  
dated 1st October 2015.)

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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 MS. PATRICIA COLLIS (Bird & Bird LLP) appeared on behalf of  
22 the Appellant/ Proprietor.

23 THE RESPONDENT/APPLICANT was not present and was not  
represented.

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25 D E C I S I O N  
(As approved)

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1 THE APPOINTED PERSON: On 5th May 2015, Simmons & Simmons LLP  
2 applied under No. 500837 for revocation of Trade Mark No.  
3 2387842 FROM RUSSIA WITH LOVE registered in Class 14 as of  
4 24th March 2005 in the name of Faberge Limited. The  
5 application was made under sections 46(1)(a) and 46(1)(b) of the  
6 Trade Marks Act 1994 for revocation on the ground of non-use.

7 A copy of the application made on Form TM26(N) was sent  
8 to the registered proprietor on 12th May 2015 in accordance  
9 with the provisions of rule 38(2) of the Trade Marks Rules  
10 2008. It then became necessary for the proprietor to file a  
11 Form TM8(N) and counterstatement in answer to the revocation  
12 application within two months of the date on which it had been  
13 sent (see rule 38(3)). This was not a flexible time limit  
14 (see rule 77(6) and Schedule 1 to the 2008 Rules).

15 The required Form TM8(N) and counterstatement could be  
16 filed after expiry of the period of two months allowed by rule  
17 38(3) "if and only if" the failure to file within that period  
18 was "attributable, wholly or in part, to a default, omission  
19 or other error by the registrar, the Office or the  
20 International Bureau" and "it appears to the registrar that  
21 the irregularity should be rectified" by resetting the due  
22 date for filing (see rule 77(5)).

23 The proprietor was warned of the consequences of not  
24 filing within two months in the official letter enclosing the  
25 Form TM26(N). The specified deadline of 13th July 2015 came

1 and went without any filing or other response on the part of  
2 the proprietor in answer to the application for revocation.  
3 It then became necessary for the Registrar to consider whether  
4 the registration of the proprietor's Trade Mark No. 2387842  
5 should, as provided for in rule 38(6), be revoked pursuant to  
6 the apparently unopposed application.

7 To that end, the Registrar sent an official letter to  
8 the proprietor on 21st July, 2015 stating: "The Registry's  
9 letter dated 12 May 2015 informed you that if you wished to  
10 continue with your registration you should file TM8(N) and  
11 counterstatement on or before 13 July 2015.

12 "As no TM8(N) and counterstatement have been filed  
13 within the time period set, Rule 38(6) applies. Rule 38(6)  
14 states that:

15 "'.... the registration of the mark shall, unless the  
16 registrar directs otherwise, be revoked.'

17 "The Registry is minded to treat the proprietor as not  
18 opposing the application for revocation and revoke the  
19 registration as no defence has been filed within the  
20 prescribed period.

21 "If no response is received on or before 4 August 2015  
22 the Registrar will proceed to issue a short decision on the  
23 issue of failure to comply with the Rules governing the filing  
24 of a defence."

25 The deadline of 4th August 2015 came and went without

1 any response on the part of the proprietor to the statement of  
2 position contained in the official letter of 21st July, 2015.  
3 On 1st October, 2015, Mr. Raoul Colombo, acting on behalf of  
4 the Registrar, proceeded to issue a decision under rule 38(6)  
5 revoking the registration of Trade Mark No. 2387842 upon the  
6 following basis: "The registered proprietor did not file a  
7 counter-statement within the two months specified by Rule  
8 38(3) of the Trade Mark Rules 2008 and neither party requested  
9 a hearing or gave written submissions in respect of the  
10 official letter of 21 July 2015. Such circumstances are  
11 covered by Rule 38(6) which states:

12 " '.... the registration of the mark shall, unless the  
13 registrar directs otherwise, be revoked. '

14 "Under the provisions of the rule, the Registrar is  
15 required to exercise discretion. In this case no reasons have  
16 been advanced as to why revocation should not take place and  
17 no reasons have been given why I should exercise this  
18 discretion in favour of the Registered Proprietor. I  
19 therefore decline to do so.

20 "The application for revocation, under the provisions of  
21 Section 46(1)(a) has set out the five year period during which  
22 it is alleged that the trade mark was not in use and therefore  
23 has requested revocation from a date earlier than the date of  
24 the application for revocation.

25 "As the registered proprietor has not responded to

1           allegations made, I am prepared to infer from this that they  
2           are admitted. Therefore, in accordance with Section 46(6)(b)  
3           I am satisfied that the grounds for revocation existed at an  
4           earlier date than that of the application for revocation.

5                       "Accordingly, the mark is revoked with effect from 22  
6           August 2014 and I direct that it be removed from the  
7           Register."

8                       I pause at this point to observe that the Registrar was  
9           not required to conduct an investigation into the proprietor's  
10          attitude or approach to the revocation application in order to  
11          try and work out what its subjective intentions might or might  
12          not be with regard to the registration in issue. The  
13          proprietor was placed, by statute, in much the same position  
14          as if it had written to the Registrar saying, "I have not  
15          filed a Form TM8(N) and counterstatement under rule 38(3) because I  
16          am not opposing the application for revocation made in the  
17          Form TM26(N) sent to me under rule 38(2)."

18                      It was open to the Registrar to allow the apparently  
19          unopposed application for revocation to succeed without making  
20          any independent determination of his own as to whether the  
21          application should be regarded as well-founded. That is what  
22          he did in circumstances where the proprietor provided no  
23          information, evidence or submissions upon which a decision in  
24          its favour, allowing the Registry proceedings to continue,  
25          might possibly have been made.

1           I should add that there is no general power to grant  
2 relief from sanctions in Registry proceedings under the 1994  
3 Act and 2008 Rules. If a trade mark proprietor who is in  
4 default of compliance with the deadline imposed by rule 38(3)  
5 wishes to avoid revocation under that rule, he must (1) seek  
6 to satisfy the Registrar that relief should be granted on the  
7 basis of a procedural irregularity under rule 77(5); and/or  
8 (2) seek to satisfy the Registrar that the discretion  
9 available under rule 38(6) should be exercised so as to allow  
10 the Registry proceedings to continue.

11           After a decision has been made under rule 38(6) revoking  
12 the registration of a trade mark, it may be set aside if  
13 (within a period of six months beginning immediately after the  
14 date that the register was amended to reflect the revocation)  
15 the proprietor of a trade mark successfully applies to the  
16 Registrar under rule 43(1)(b) for an order to that effect.  
17 For that purpose, the trade mark proprietor must demonstrate  
18 to the reasonable satisfaction of the Registrar that his  
19 failure to comply with rule 38(3) "was due to a failure to  
20 receive" the relevant Form TM26(N) and that the decision ought  
21 to be set aside in the exercise of the discretion conferred by  
22 that rule.

23           The Registrar's discretionary power under rule 74 to  
24 rectify "an irregularity in procedure ... connected with any  
25 proceeding or other matter before the registrar or the Office"

1 is expressly "subject to rule 77" and therefore cannot be used  
2 in circumstances where rule 77(5) could not be used to alter  
3 the operation or effect of the two-month time limit set by rule  
4 38(3).

5 The proprietor seeks by means of the present appeal to  
6 an Appointed Person under section 76 of the 1994 Act to  
7 nullify the decision dated 1st October 2015 for the following  
8 reasons as stated in its Form TM55P Notice of Appeal: "The  
9 Trade Mark Owner disagrees with the decision to revoke Trade  
10 Mark No. UK00002387842 with effect from 22 August 2014.

11 "The registration in question was due for renewal on 24  
12 March 2015, by which date, no request to renew the  
13 registration had been filed. As a result, the registration  
14 expired. No request to late-renew was filed by the deadline  
15 of 24 September. As a result, the registration remained  
16 expired.

17 "The application to revoke the registration was filed on  
18 5 May 2015, i.e. after the date on which the renewal was due,  
19 but within the six month grace period for late renewal  
20 provided for under s43(3) of the Trade Marks Act 1994. The  
21 Trade Mark Owner did not file a defence.

22 "The Registrar issued a decision on 1 October 2015,  
23 revoking the registration with effect from 22 August 2014,  
24 being the first possible effective date of revocation for this  
25 registration. However, by 1 October 2015 the registration in

1 question no longer existed as by that date no request to renew  
2 had been filed and the grace period for late renewal had  
3 already expired. The rights in the registration ceased to  
4 exist on 25 March 2015. Therefore, the registration could not  
5 be, and should not have been, the subject of a revocation  
6 decision on 1 October 2015."

7 These contentions were further developed in oral  
8 argument at the hearing before me. It should be noted that  
9 there is no suggestion that Trade Mark No. 2387842 was used  
10 by or with the consent of the proprietor in the course of  
11 trade in the United Kingdom in relation to any goods of the  
12 kind for which it was registered in Class 14 at any time  
13 during the period following completion of the procedure for  
14 registration on 21st August, 2009.

15 The appeal is essentially intended to shield the  
16 registration from the legal consequences of non-use. In  
17 accordance with the provisions of sections 40(3) and 42(1) of  
18 the Trade Marks Act 1994, the trade mark in issue was  
19 registered for ten years with effect from 24th March 2005.  
20 On 24th March 2015, the registration was due for renewal at  
21 the request of the proprietor in accordance with the  
22 provisions of section 43 of the Act and rules 34 to 37 of the  
23 Trade Marks Rules 2008.

24 It was open to the proprietor under section 43(3) and  
25 rule 36(2) to request renewal within six months of the end of



1 the ten-year registration period set by section 42(1). In the  
2 absence of any such request for renewal, the Registrar was  
3 required to remove the mark from the register under section  
4 43(5) and rule 36(3), subject to the proprietor's right to  
5 request restoration of the mark to the register under section  
6 43(5) and rule 37 within a yet further period of six months  
7 from the date of removal.

8 On examining the registration details for Trade Mark No.  
9 2387842, I can see that it was not removed from the register  
10 until 2nd October, 2015, the day following the date of the  
11 decision under appeal. It was at all material times before  
12 that a registered trade mark within the meaning of section  
13 63(1) of the 1994 Act and therefore covered by a  
14 registration with respect to which an order for revocation  
15 could be made by the Registrar in the exercise of the powers  
16 conferred upon him by section 46 of that Act.

17 It is simply not correct to say, as the proprietor says  
18 in its reasons for appeal, that by 1st October 2015 the  
19 registration in question no longer existed. On analysis, it  
20 appears to me that the proprietor is trying to say that the  
21 Registrar should not allow an application for revocation filed  
22 after the renewal date of the relevant registration to proceed  
23 to a conclusion in the absence of renewal or restoration of  
24 the relevant trade mark to the register, the suggestion being  
25 that the registration cannot otherwise be treated as a real

1 live registration.

2 I am satisfied that there is no substance or utility in  
3 the position for which the proprietor contends in that regard.  
4 An order for revocation or invalidity is needed if the rights  
5 conferred by registration of a trade mark are to be  
6 extinguished or altered with retrospective effect. The expiry  
7 or surrender of the registration is not sufficient either to  
8 secure or to prevent the attainment of that objective. This  
9 has been recognised in proceedings under the Trade Marks Act  
10 1994: See BUSINESS ZONE and BUSINESS ZONE PLUS trade marks  
11 (BL O/364/07; 30 December 2007; at paras 24-36) and RAPIER  
12 Trade Mark (BL O/170/07; 30 June 2007; at paras 27-36).

13 I was referred to a decision dated 30th May, 2001 of the  
14 registrar's hearing officer, Mr. Knight, in a case relating to  
15 the trade mark DREAMBOYS, in which it was determined that an  
16 application for revocation filed after the renewal date for  
17 the registration in issue should not be allowed to proceed  
18 because the registration had, at that point, ceased to be the  
19 registration of a trade mark within the meaning of the 1994  
20 Act. It will be apparent from what I have said that I  
21 disagree with this reasoning, which is inconsistent in  
22 particular with the reasoning of the Appointed Person in the  
23 subsequent BUSINESS ZONE and BUSINESS ZONE PLUS trade marks  
24 case.

25 I do not rule out the possibility that there may be

1 circumstances in which the bringing of revocation proceedings  
2 might be an abuse of process. In such cases, the appropriate  
3 response will be for the respondent to the proceedings to  
4 apply for the proceedings to be struck out or stayed. That is  
5 not the position in the present case. No case has been made  
6 out for any relief against the sanction duly applied by the  
7 Registrar's hearing officer for default under the rules. The  
8 appeal will be dismissed and the hearing officer's decision will  
9 stand. In accordance with the agreement between the parties, there  
10 will be no order for costs in relation to the appeal.

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