

1 UK INTELLECTUAL PROPERTY OFFICE

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

5 Monday, 6th June, 2016

6 Before:

7 MR. GEOFFREY HOBBS Q.C.
(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 Registration No. 2044089
in the name of MRS. MARIA DE LOS ANGELES BROTONS MOLLA

11 -and-
12 In the Matter of an Application for Revocation thereof
under No. 83919 by EGMONT UK LTD

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14 (Appeal of the Proprietor from the decision of Mr. Edward Smith,
15 acting on behalf of the Registrar, dated 14th December 2011.)

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

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21 THE APPELLANT/PROPRIETOR was not present and was not
represented.

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

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

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1 THE APPOINTED PERSON: Trade Mark No. 2044089 was registered in
2 the name of Mrs. Maria de Los Angeles Brotons Molla on 24th
3 March 2000 with effect from 9th November 1995. This is a
4 device mark prominently featuring the word "ROVERS". It was
5 registered in Class 25 for use in relation to "footwear being
6 articles of clothing". On 24th November 2010, Egmont UK
7 Limited applied under section 46(1)(b) of the Trade Marks Act
8 1994 for revocation of the registration of the trade mark with
9 effect from 24th November 2010. The application was based
10 upon the contention that there had been no genuine use of the
11 trade mark in the United Kingdom for any goods of the kind for
12 which it was registered during the preceding five years.

13 Marks & Clerk LLP, as agents of record for the
14 registered proprietor, filed a Form TM8 and counterstatement
15 in defence of the registration on 8th February 2011. The
16 counterstatement contained no positive averments as to any use
17 of the trade mark in issue. It consisted essentially of a
18 series of paragraphs denying the allegations of non-use made
19 in the application for revocation.

20 Shortly after that, the registered proprietor appointed
21 Messrs. Williams Powell to be her agents of record in place of
22 Marks & Clerk LLP. Williams Powell then proceeded to file a
23 witness statement signed by Mrs. Brotons Molla. It was dated
24 22nd March 2011 and, as noted in the letter under cover of
25 which it was filed, it contained a typographical error: at

1 paragraph 4, it referred to an exhibit comprising a
2 representative selection of goods, orders and invoices as
3 "Exhibit 2"; however, there was only one exhibit to the
4 witness statement and this should have been referred to as
5 "Exhibit 1".

6 More importantly, for present purposes, the witness
7 statement was signed and dated, but it did not contain a
8 statement of truth as required by rule 64 of the Trade Marks
9 Rules 2008. This was important because rule 64(2)
10 specifically provides that: "A witness statement may only be
11 given in evidence if it includes a statement of truth."

12 The filing of the witness statement without a statement
13 of truth was an irregularity in procedure capable of being
14 rectified by the Registrar on such terms as he might think fit
15 in the exercise of the discretionary power conferred upon him
16 by rule 74 of the 2008 Rules: "74.-(1) Subject to rule 77, the
17 registrar may authorise the rectification of any irregularity
18 in procedure (including the rectification of any document
19 filed) connected with any proceeding or other matter before
20 the registrar or the Office. (2) Any rectification made under
21 paragraph (1) shall be made – (a) after giving the parties
22 such notice; and (b) subject to such conditions, as the
23 registrar may direct."

24 The power conferred by this rule is exercisable in the
25 first instance by the Registrar. I record, without further

1 comment at this point in my decision, that the failure to
2 include a statement of truth in the registered proprietor's
3 witness statement was an irregularity which has remained
4 unrectified down to the present day.

5 The applicant for revocation filed evidence in answer to
6 the registered proprietor's witness statement. The evidence,
7 in answer, took the form of a witness statement in which a
8 private investigator, Mr. Godwin Sharples of Farncombe
9 International Limited, reported on the results of
10 investigations he had carried out for the purpose of checking the
11 reliability of the registered proprietor's evidence. His
12 witness statement dated 6th June 2011 referred to a number of
13 matters which raised questions as to the veracity of
14 the registered proprietor's evidence in several significant
15 respects.

16 The registered proprietor filed no evidence in reply.
17 Williams Powell removed themselves from the record by a letter
18 dated 4th July, 2011. Neither party requested a hearing and
19 the application for revocation therefore proceeded to a
20 determination simply on the basis of the papers on file. The
21 Registrar's hearing officer, Mr. Edward Smith, found himself
22 in the unenviable position of having to decide, without the
23 benefit of cross-examination and without the assistance of
24 focused submissions from the parties, what effect, if any, he
25 should give to the contested evidence which the registered

1 proprietor had provided without a statement of truth in her
2 witness statement dated 22nd March 2011.

3 In his decision issued under reference BL O/453/11 on
4 14th December 2011, he explained that steps were taken to
5 secure compliance by the registered proprietor with her
6 obligation to file evidence in properly solemnised form as
7 required by rule 64 of the 2008 Rules: "19. Whilst I have
8 faithfully recorded what Mrs. Brotons Molla has said in her
9 statement I was concerned that it did not contain the
10 customary statement of truth required in a witness statement.
11 Evidence in registry proceedings is governed by rule 64 of the
12 Trade Marks Rules 2008 ('TMR') which reads in full:

13 "Evidence in proceedings before the registrar; section
14 69.

15 "64 - (1) Subject to rule 62(2) and as follows, evidence
16 filed in any proceedings under the Act or these Rules may be
17 given -

18 "(a) by witness statement, affidavit, statutory
19 declaration; or (b) in any other form which would be
20 admissible as evidence in proceedings before the court.

21 "(2) A witness statement may only be given in evidence
22 if it includes a statement of truth.

23 "(3) The general rule is that evidence at hearings is to
24 be by witness statement unless the registrar or any enactment
25 requires otherwise.

1 "(4) For the purposes of these Rules, a statement of
2 truth -

3 "(a) means a statement that the person making the
4 statement believes that the facts stated in a particular
5 document are true; and (b) shall be dated and signed by -

6 "(i) in the case of a witness statement, the maker of
7 the statement,

8 "(ii) in any other case, the party or legal
9 representative of such party.

10 "(5) In these Rules, a witness statement is a written
11 statement signed by a person that contains the evidence which
12 that person would be allowed to give orally.

13 "(6) Under these Rules, evidence shall only be
14 considered filed when -

15 "(a) it has been received by the registrar; and

16 "(b) it has been sent to all other parties to the
17 proceedings."

18 "20. It is plain from this rule that the absence of a
19 statement of truth is fundamental and renders the material
20 inadmissible.

21 "21. I was, of course, aware Mrs. Brotons Molla is
22 resident in Spain and probably a Spanish National. I asked
23 the Registry Case Worker to write to Mrs. Brotons Molla to get
24 her to rectify matters by filing a proper witness statement or
25 a sworn affidavit before a notary public or its equivalent in

1 Spain. This was done by letter dated 5th October 2011, sent
2 to her address of record in Elche, Spain. Attorneys in the
3 UK, Williams Powell, previously acting for her, had by letter
4 dated 4th July 2011 removed themselves from the record. I
5 notice the address on the letter contained a minor
6 typographical error; instead of the street name 'Manuel Lopez
7 Quereda 31', the designation 'Manual Lopez Quereda 31' was
8 used. There is no information before me however that would
9 suggest this letter was not received. The letter gave one
10 month in which Mrs. Brotons Molla could rectify matters. No
11 reply to this letter was received."

12 Against that background, he decided as follows:

13 "36. Consideration has to be taken, also, of section 100 of
14 the Act which states:

15 "'100. If in any civil proceedings under this Act a
16 question arises as to the use to which a registered trade mark
17 has been put, it is for the proprietor to show what use has
18 been made of it.'

19 "37. I have already recited rule 64 TMR above in
20 relation to evidence in proceedings.

21 "38. The consequence of rule 64 and the absence of a
22 statement of truth in Mrs. Brotons Molla's 'statement' is that
23 it cannot constitute evidence before me and I am obliged,
24 accordingly, to rule it inadmissible.

25 "39. This has the further consequence that the legal

1 burden faced by the registered proprietor to prove its use in
2 this case has not been discharged and the application for
3 revocation must then succeed."

4 On that basis, it was unnecessary for him to decide
5 whether the registered proprietor's evidence would have been
6 sufficient to demonstrate genuine use of the trade mark in
7 issue if it had been properly solemnised. He nevertheless
8 went on to observe as follows: "40. I say this with some
9 regret. Had Mrs. Brotons Molla's evidence been formally
10 acceptable, in my view, she would have had, on the face of it
11 at least, a strong defence against the application. In this
12 regard, although certain alleged 'discrepancies' in her
13 'evidence' may have been exposed, it must nonetheless be
14 accepted by Egmont that, at least, the retailer Macsimillion
15 in Oxford imported ROVERS shoes in 2006/2007. Other
16 criticisms by Egmont of Mrs. Brotons Molla's 'evidence' are
17 themselves undermined by absence of detail, for example, in
18 relation to the people at Debenhams to whom the private
19 investigator spoke. There is no information as to who they
20 were or what responsibilities they had, and thus whether they
21 may have been expected to speak with any knowledge of the
22 facts. In the circumstances, however, it is not for me to
23 conduct a full analysis as to whether, had Mrs. Brotons
24 Molla's statement been formally acceptable, she would have
25 demonstrated genuine use."

1 I, for my part, would observe that what he referred to
2 as the "certain alleged 'discrepancies' in her 'evidence'"
3 raised real questions as to whether she had put forward
4 fabricated invoices in support of her claim to genuine use and
5 that this was a circumstance which made the absence of a
6 statement of truth even more unsatisfactory than might have
7 been the case if her evidence had not been contested in the
8 witness statement in answer from Mr. Sharples.

9 In the result, the hearing officer upheld the
10 application for revocation in its entirety and revoked the
11 registration of the trade mark in issue with effect from 24th
12 November, 2010. He ordered the registered proprietor to pay
13 £1,000 to the applicant for revocation as a contribution
14 towards its costs of the Registry proceedings. His decision
15 was sent by post to the registered proprietor at her address
16 in Spain. She clearly received it in good time since she was
17 able to file a Form TM55 Notice of Appeal to the Appointed Person
18 on 10th January 2012.

19 The Form TM55 confirmed that her postal address in Spain
20 remained as previously notified to, and used by, the UK IPO.
21 In her Statement of Grounds of Appeal, she contended as
22 follows: "First of all, I must point out that the
23 primacy of the community norm occupies first place on any norm
24 of national character, already it is a law, a regulation, a
25 decree, a resolution, a circular letter, etc. And regarding

1 the National Constitutions, these also will be subject to the
2 above mentioned principle. This characteristic arises
3 immediately after the judgment of the Court of Justice of
4 November 19, 1991, in the matter Francovich and Bonifaci. Is
5 admitted that when the Member state breaks the obligation of
6 transposition of a community Board, it generates a
7 vulnerability of the individuals for the absence of practical
8 application of rights that correspond to him chord to the
9 juridical community classification. This vulnerability,
10 attributable to the breach of the obligations of the Community
11 law on the part of the State, makes arise the responsibility
12 from this one, so that the individual will be able to obtain a
13 repair, indemnification that guarantees the full efficiency of
14 the procedure and the full protection of rights.

15 "In this case, I have been prejudiced by the
16 Intellectual Property Office and my prior agent in that
17 country.

18 "First of all, because my agent, Williams Powell, never
19 informed me that a statement of truth was necessary. If so,
20 of course I would have done the same.

21 Secondly, because the Intellectual Office once noticed
22 the mistake, sent me a letter to a wrong address, and so, I
23 never received the letter. The Intellectual Office should
24 have send me a new letter to my correct address, and inform me
25 about the mistake, and also should have given me a term in

1 order to rectify matters and file a proper witness statement,
2 as this was an important case.

3 "Nevertheless, the Intellectual Office, knowing that I
4 had not receive the letter, because there was a mistake in the
5 address, issues a decision accepting the revocation petition,
6 against my rights, and ignoring all the proof of use in
7 respect to trademark 2044089, I had filed.

8 "In this sense, I consider that the actuation of the
9 Intellectual Office is contrary to the European Law, and also
10 that it has caused me helplessness.

11 "For this reason I request you to send me a proper model
12 of witness statement, including a statement of truth, in order
13 to file it before the Intellectual office, so that the
14 evidence of use submitted by me can be considered, and then,
15 the Intellectual Office proceed to reject the petition of
16 revocation of trade mark 2044089 filed by Egmont.

17 "And that, as the Office accepts in the resolution that
18 the evidence filed by me in respect to my trademark ROVERS in
19 Great Britain, shows the use I did of my trademark in your
20 country, and because it is obvious that if I had been given a
21 term to rectify the due formalities, the petition of
22 revocation should have been rejected.

23 "I am not a national of your country and I don't know
24 your laws, so that I expect from you the full support as an
25 European citizen."

1 The appeal was listed for hearing before me on 14th
2 September, 2012. However, the appointment was vacated when it
3 became apparent to me that I had been given contact details
4 for Marks & Clerk LLP on the mistaken assumption that they
5 were still the registered proprietor's agents of record and
6 because it was not clear to me that she had received the
7 required period of notice in relation to the date, time and
8 place for the hearing of her appeal. The intention at that
9 stage was to set a new date and time for the hearing of the
10 appeal when the opportunity next arose. However, nothing
11 further was heard from the registered proprietor or from the
12 applicant for revocation and nothing further was done to set a
13 date for the appeal, which appeared to have gone into
14 abeyance.

15 In accordance with the Registrar's usual practice, the
16 hearing officer's order for revocation was not implemented
17 pending the outcome of the appeal. That resulted in the
18 automated sending of a registration renewal reminder letter to
19 Williams Powell on 9th July, 2015. It is odd that the letter
20 was sent to them in circumstances where they had ceased to be
21 the registered proprietor's agents of record in July 2011 and
22 when historical case details for the registration in issue
23 contained an entry dated 29th August 2011 stating, "Agent
24 role closed".

25 It is even more odd that Williams Powell then proceeded

1 to renew the trade mark registration on 6th November, 2015.
2 They have since confirmed to the Registrar that they did so on
3 instruction from the registered proprietor's representative in
4 Spain, Ms. Clara Martin of Gabimar Servicios Empresariales
5 S.L.

6 Having renewed the registration, Williams Powell again
7 distanced themselves from the registered proprietor in a
8 letter they sent to the Registry on 8th December, 2015
9 stating: "Please note that Williams Powell is no longer
10 instructed in connection with the above matter. Please see
11 the attached copy of our letter of 4 July 2011 in this regard,
12 and remove our name from the record."

13 When the applicant for revocation discovered that the
14 registration had been renewed, it asked the Government Legal
15 Department for clarification as to the status of the
16 registered proprietor's appeal. That set in train a process
17 of communication in which the registered proprietor and those
18 who were known to have been acting for her in connection with
19 the renewal of the registration (Williams Powell and Gabimar)
20 were contacted, initially with requests for information as to
21 whether she wished to pursue her appeal and then subsequently
22 with notice, as required by the 1994 Act and the 2008 Rules,
23 of the date and time set for today's hearing of the appeal.

24 The Government Legal Department's letters to the
25 registered proprietor at her postal address in Spain elicited

1 no response. The letters sent by this tribunal to the
2 registered proprietor at her postal address in Spain likewise
3 elicited no response. The emails and faxes sent by this
4 tribunal to Ms. Clara Martin of Gabimar also elicited no
5 response. Williams Powell responded to this tribunal in
6 January saying that they were unable to help with the attempt
7 to obtain a reliable direct means of contacting the registered
8 proprietor.

9 The parties are not present or represented before me
10 today and there is no attendance on behalf of the Registrar.
11 I have also received no written representations on the
12 substance of the appeal. My intention in giving this
13 decision is to bring finality to the proceedings. It is
14 clear to me that the registered proprietor is not prepared to
15 engage with the proceedings. Her approach is to declare that
16 she has always been willing to comply with the requirements of
17 rule 64 whilst actually taking no steps to regularise her
18 position in that regard. She was given an opportunity to do
19 so prior to determination of the application for revocation,
20 but did not take it. She has not subsequently done anything
21 of which I am aware to make good the known deficiency.

22 Her objective appears to be to hold on to the
23 registration in issue for as long as she can without providing
24 either the Registry or this tribunal with evidence of use in
25 properly solemnised form. That reinforces me in the view that

1 the failure to solemnise her evidence should not be seen as
2 trivial or technical, but rather as fully within the scope of
3 rule 64(2), as it is intended to operate in relation to
4 evidence on which the Registrar is being asked to act in the
5 face of other evidence which goes to contradict it.

6 I think the hearing officer was right to adopt the
7 approach he adopted in the particular circumstances of the
8 present case. For the reasons I have given, the appeal will
9 be dismissed. I have no reason to believe that any
10 significant costs have been incurred by the respondent in
11 connection with the appeal. I therefore make no order as to
12 costs.

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