

**BLO/625/19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION 3224986**

**IN THE NAME OF DARREN CROZIER**

**IN RESPECT OF THE TRADE MARK:**



**IN CLASSES 9, 38 & 41**

**AND AN APPLICATION TO RECTIFY THE REGISTER (UNDER NO. 84799) BY:**

**DANIEL CREGGAN**

## **BACKGROUND AND PROCEDURAL HISTORY**

### **The filing and registration of the subject trade mark**

1. The subject trade mark was filed on 13 April 2017. The given owners of the mark at the time of filing were Mr Crozier and Mr Creggan. No indication was given at the time of filing about the nature of the relationship between Mr Crozier and Mr Creggan.
2. The mark was accepted by the IPO and subsequently registered on 7 July 2017, in the above joint names.

### **The change of ownership request**

3. On 25 April 2018, Mr Crozier filed a Form TM16, a form which is used “to record a change of ownership” of a trade mark registered under the Trade Mark Act 1994 (“the Act”). That change was to remove Mr Creggan from the mark’s ownership, so that Mr Crozier became its sole owner. The form was signed by Mr Crozier and was also purportedly signed by Mr Creggan. I note from the Form TM16 that:

- i) The method of transfer is given as “Assignment” – (box 6 of the form refers)
- ii) The date of transfer of ownership is given as 11 February 2018.
- iii) In a covering letter it is stated that the form is “..to remove one partner from the trademark rights to TM number...”.

4. The request to change the ownership was actioned by the IPO, in line with its existing practice. That practice is that, in the event of the Form TM16 being signed by both the old and the new owner (which it purportedly was), the request will be actioned without the need to have sight of any underpinning assignment document or, if the ownership has changed other than by way assignment, evidence of that.

5. In consequence of the above, the IPO wrote to Mr Crozier on 30 April 2018 to inform him that the change of ownership had been recorded.

## **The application to rectify the register**

6. On 2 May 2018, Mr Creggan filed a Form TM26R, requesting that the register be rectified. Put simply, he states that he did not sign the Form TM16 and, thus, he should not have been removed from the mark's ownership details. He acknowledges that he and Mr Crozier had a falling out which led to them going their separate ways. This was said to have occurred 3 months ago (which puts the timeline around February 2018). He says that the two have been in certain legal disputes. He states that they have both operated under ENERGY 106 and that this is permissible as they both hold the trade mark, but that Mr Crozier has had things like his [Mr Creggan's] Facebook page taken down.

## **Mr Crozier's counterstatement**

7. Mr Crozier was invited to file a counterstatement. He did so on 11 December 2018. In summary, he states that:

- The parties were involved in a business partnership, albeit one without a formal agreement.
- Mr Creggan left the business and set up a rival company, at which point Mr Crozier "inherited" the business.
- He did have screen grabs (from 11 February 2018) of Mr Creggan publicly stating on social media that he had officially left ENERGY 106 BELFAST, but these were submitted to the police during an interview with them that subsequently took place.
- In April 2018, after discussions with solicitors and letters to Mr Creggan (which he says were ignored), he went to Mr Creggan's home and asked him to sign the Form TM16. He explained to Mr Creggan that it was not ethical for him to remain an owner of the mark for a brand he was no longer involved with. He says Mr Creggan agreed to do so without hesitation and signed the form on his

IPAD. He says that the meeting was amicable and was witnessed by two volunteer DJs.

- A few days later Mr Crozier was contacted by the police with a complaint from Mr Creggan that his signature had been forged. He co-operated with the police and was interviewed by them, accompanied by his solicitor. He says the police interview is available, but that the tribunal must request it if it is to be released.
- Mr Crozier says that the police found no wrong doing. He says the case was also considered by the Public Prosecution Service who decided not to prosecute Mr Crozier. The letter informing Mr Crozier of this, dated 17 October 2018, is attached to the counterstatement. It records that it has been decided “..having considered the evidence currently available, not to prosecute you in relation to an incident on the 2<sup>nd</sup> May 2018...”. I note that the date the “incident” took place is after the date on which Mr Crozier says he visited Mr Creggan’s home. In fact, the date of this incident, whatever it was, is the same day that Mr Creggan filed his application for rectification.
- Mr Crozier says that there are no legal disputes between the parties but that he may pursue avenues against Mr Creggan for trade mark breaches. Mr Crozier adds that Mr Creggan’s claim that there were proceedings ongoing, means that the TM26R is void because he declared on it that there were no legal proceedings afoot.
- Mr Crozier does not believe that these Tribunal proceedings are the appropriate forum for dealing with the matters between the parties.
- Mr Crozier’s statement ends with him stating that “I believe the facts in this reply statement of case are true”.

8. The counterstatement was accompanied by two documents described as statements of fact, from the two volunteer DJs mentioned by Mr Crozier, both of whom end their statements with: “I believe the facts stated in this reply statement of case are true”. The statements are from:

- Mr Robert Hillaby, an event supervisor associated with ENERGY 106 BELFAST. He states that he is a friend of both parties. He states that he witnessed Mr Creggan signing “the form removing himself from the trademark earlier this year”. He states that Mr Crozier explained to Mr Creggan that it was unethical for him to remain as the owner now that he had launched a rival station, KISS FM. He says that the form was signed on the doorstep of Mr Creggan’s girlfriend’s home. He says he witnessed Mr Creggan print the form and put it into an envelope for posting and that he signed it in good spirits. He says that Mr Creggan still runs KISS FM.
- Mr Conor McDonald, who was previously affiliated with ENERGY 106 BELFAST (he has now moved on). He considers himself a friend of both parties and owes neither any bad will. He states that he was also present when Mr Creggan “knowingly and willingly signed the form in question knowingly giving [Mr Crozier] complete control of the trademark”. He is unsure why Mr Creggan is now disputing this and is saddened at having to become involved to correct a close friend’s untruth.

### **The Tribunal’s initial directions**

9. Following receipt of the counterstatement and a consideration of its content, the Tribunal wrote to the parties (on 19 December 2019) directing:

- i) That the parties should seriously consider mediation to resolve the dispute between them.
- ii) Further, given that a) an assignment of a trade mark must be in writing for it to be effective, b) that the Form of TM16 is not a substitute for a deed of assignment, and c) that neither party claims that a deed of assignment has been executed, the parties should consider whether the rectification should be allowed with consent.

10. The parties did not agree to mediate nor did they agree that the rectification should be allowed with consent.

### **Further engagement from the parties**

11. In terms of the above, the Tribunal received, from Mr Creggan:

- i) A letter from his representative, FR Kelly, dated 9 January 2019, in which it was requested that the rectification be unilaterally allowed, in response to which the Tribunal set (correctly in my view) a period of time for the parties to file evidence in support of their respective cases.
- ii) Evidence in the form of a witness statement from Mr Creggan, which does little more than confirm that a) he did not sign the Form TM16, b) that he has never signed a deed of assignment and, c) that, in fact, no assignment document exists.
- iii) At a hearing before me on 26 September 2019, Mr Creggan was represented by Mr Kelly of FR Kelly; I also had the benefit of a skeleton argument from him.

12. From Mr Crozier:

- i) A request via email for an extension of time to file evidence. Mr Crozier was advised by the Tribunal that a TM9 was required to seek more time, but nothing further was heard. Mr Crozier has, therefore, filed no further evidence and did not attend, nor was represented, at the hearing before me.

### **DECISION**

13. The provisions relating to rectification are contained in section 64 of the Act, which read:

“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.”

### **Sufficient interest?**

14. As per section 64(1), the person applying for rectification, Mr Creggan, must have sufficient interest to do so. A claim to being the joint legal owner of a registration is one of the clearest forms of interest possible. Mr Creggan has an interest in this matter sufficient for the purposes of section 64(1) of the Act.

### **Is the claimed error capable of correction?**

15. Section 64(1) relates to errors or omissions in the register. The claim is that the name of the current recorded owner (solely Mr Crozier) is erroneous. I have no doubt that the provisions of section 64(1) cover more than the correction of simple clerical errors and can cover, for example, issues of disputed ownership including rescinding erroneous assignments. Therefore, there is potential for the claimed error to be rectified.

### **Should rectification be allowed?**

16. Section 24(1) of the Act states that:

“a registered trade mark is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property”

17. Section 24(3) states that:

“an assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is in writing signed by or on behalf of the assignor or, as the case maybe, a personal representative”.

18. As noted earlier, when he filed the Form TM16 Mr Crozier ticked the box that indicated that an assignment had taken place. Therefore, on this basis, for it (the assignment) to be effective, it must be in writing. There is no suggestion that the parties have executed any form of written assignment. All that has been done (if Mr Crozier’s version of events is to be believed) is that a Form TM16 has been signed by both parties. The TM16 is not a deed of assignment. Indeed, the form itself carries a warning to parties completing it that it is not a substitute for a deed of assignment. Thus, I agree with Mr Kelly’s submission that, absent evidence of a written assignment, no assignment can be deemed to have taken place. The trade mark cannot therefore have properly moved to the sole ownership of Mr Crozier as the result of an assignment.



19. In view of the above, it is not necessary to make a formal finding as to whether Mr Creggan did or did not sign the form. However, for the benefit of the parties, I will give an indication of my likely view. Had this matter been crucial to the outcome, the onus would have been on Mr Creggan to prove that he did not sign the form. He has filed a witness statement categorically stating that he did not. However, this has been countered by Mr Crozier categorically stating the opposite, a statement which is supported by two people who say they witnessed the event. Those two people consider themselves mutual friends of both parties, one of whom has moved on from the business. On the face of it, it is difficult to see how I can hold that Mr Creggan has proved his claim. He has provided nothing in corroboration and has not sought to challenge the statements from the other side by way of, for example, cross examination. In giving this view, I have had due regard to the fact that Mr Crozier's statement, and those in corroboration, were not filed as witness statements during the evidence rounds – however, all three statements do contain a statement of truth and I would have given them some weight.

20. I note in passing that there are two other ways in which a transfer of ownership may arise. One is testamentary disposition. However, this relates to the transfer of property following death; this is clearly not applicable here. The other is “by operation of law” a broad legal term which could potentially involve a transfer of ownership based on particular legal principles. However, given that i) Mr Crozier indicated on the Form TM16 that the change of ownership stemmed from an assignment, and ii) that Mr Crozier has not identified, argued or evidenced what that “operation of law” may be; it is not for me to speculate whether there is anything in the businesses relationship between Mr Crozier and Mr Creggan that would have given rise to a transfer of ownership even if the circumstances described by Mr Crozier in his statement were true.

## **Conclusion**

21. As the claimed assignment is not in writing, the rectification is allowed. The register is to be rectified with the ownership details being rectified to reflect both Mr Crozier and Mr Creggan, as was the position when the mark was filed.

22. I strongly suggest that the parties attempt, by all means possible, that any further disputes in relation to this trade mark be settled through mediation or negotiation.

### **Costs**

23. Mr Creggan is the successful party so is entitled to an award of costs. At the hearing, Mr Kelly indicated that he was not pursuing off-scale costs. My assessment is, therefore:

Filing a statement of case and considering the counterstatement - £200

Filing evidence – £200<sup>1</sup>

Preparing for and attending the hearing - £500

24. I order Darren Crozier to pay Daniel Creggan the sum of £900 within 21 days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16<sup>th</sup> day of October 2019**

**Oliver Morris**  
**for the Registrar,**  
**the Comptroller-General**

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<sup>1</sup> This is below the scale minimum because it is so light.