

O/0475/23

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION UK3569473

IN THE NAME OF DEA BAKER AND SIMON RICHARD WILSON HOYLE

AND

APPLICATION FOR RECTIFICATION THERETO UNDER NO. 84852

BY SIMON RICHARD WILSON HOYLE

BACKGROUND AND PLEADINGS

1. The following trade mark (“the contested mark”) stands registered in the names of Dea Baker and Simon Richard Wilson Hoyle (“the proprietors”):

AQUA & ROCK

UK Registration no. UK3569473

Filing date 18 December 2020; date of entry in register 16 July 2021

Registered for the following goods and services:

Class 9: *Sunglasses*

Class 11: *Lighting*

Class 18: *Bags*

Class 25: *Clothes*

Class 35: *Retail shop window display arrangement services*

2. On 10 February 2022, Simon Richard Wilson Hoyle (“the applicant”) filed an application seeking to rectify the register and replace the name of the current proprietors of Dea Baker and Simon Richard Wilson Hoyle to solely his name under section 64 of the Trade Mark Rules 1994 (“the Act”). Mr Hoyle sets out his pleadings in his Form TM26(R) as follows:

“I would like to remove D Baker from the UK and International trademark. I paid for both personally, D Baker never paid her 50%.

I appointed her as a joint holder in good faith. However I have since become aware that she has fraudulently tried to remove me from the International trademark on 04.10.2021. She blocked me from my work e-mail address

[applicant's email address]¹ and sent an e-mail claiming to be me to the IPO in Geneva requesting the trademark be put in her sole name. This is being investigated by metropolitan police and I understand she will be charged with fraud for this.

She is my co-director and shareholder of Aqua & Rock International Ltd. We have a shop in London selling high end fashion. I became aware she set up a company Aqua & Rock UK Ltd, and started trading in this company name. A breach of her duties as a director and our shareholder agreement. She issued shop staff contracts in this company name. She is being investigated by the metropolitan police for forging staff signatures and is likely to be charged with forgery. She is also likely to be charged with breaches of her duties as a director.

She is on trial in July in Scottish Courts for fraud, theft and embezzlement in a former name & company (McGill). All this information has been emailed to Leigh- Anne Crowley today.”

3. Ms Baker did not file a defence or counterstatement. Neither party filed evidence. The applicant is unrepresented and due to no counterstatement being filed, I have no indication that Ms Baker is represented. Neither party requested a hearing. Neither party filed submissions in lieu of a hearing. This decision is taken following a careful consideration of the papers.

DECISION

4. The rectification of the register is governed by section 64 of the Trade Marks Act 1994 (“the Act”), which states:

“64. (1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register:

¹ I have removed the applicant's email address and referred to it as above to protect the privacy associated with the applicant's personal information.

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.”

5. That section of the Act must be interpreted and applied with reference to Section 63, which provides as follows:

“63. The Register

(1) The Register shall maintain a register of trade marks:

References in this Act to “the register” are to that register; and references to registration (in particular, in the expression “registered trade mark”) are, unless the context otherwise requires, to registration in that register.

(2) There shall be entered in the register in accordance with this Act –

(a) registered trade marks,

(b) such particulars as may be prescribed of registrable transactions affecting a registered trade mark, and

(c) such other matters relating to registered trade marks as may be prescribed.

(3) The register shall be kept in such manner as may be prescribed, and provision shall in particular be made for –

(a) public inspection of the register, and

(b) the supply of certified or uncertified copies, or extracts, of entries in the register.”

6. The particulars prescribed for the purposes of Section 63(2)(b) are set out in Rule 48 of the Trade Marks Rules 2008. The ‘other matters’ prescribed for the purposes of Section 63(2)(c) are those set out in Rule 47 of the 2008 Rules:

“47. Entry in register of particulars of registered trade marks; section 63(2) (Form TM24)

In addition to the entries in the register of registered trade marks required to be made by section 63(2)(a), there shall be entered in the register in respect of each trade mark the following particulars –

(a) the date of registration as determined in accordance with section 40(3) (that is to say, the date of the filing of the application for registration);

(b) the date of completion of the registration procedure;

(c) the priority date (if any) to be accorded pursuant to a claim to a right to priority made under sections 35 or 36;

(d) the name and address of the proprietor;

(e) the address for service (if any) filed under rule 11;

(f) any disclaimer or limitation of rights under section 13(1)(a) or (b);

- (g) any memorandum or statement of the effect of any memorandum relating to a trade mark of which the registrar has been notified on Form TM24;
- (h) the goods or services in respect of which the mark is registered;
- (i) where the mark is a collective or certification mark, that fact;
- (j) where the mark is registered pursuant to section 5(5) with the consent of the proprietor of an earlier trade mark or other earlier right, that fact;
- (k) where the mark is registered pursuant to a transformation application,
 - (i) the number of the international registration, and (ii) either - (aa) the date accorded to the international registration under Article 3(4), or (bb) the date of recordal of the request for extension to the United Kingdom of the international registration under Article 3ter, as the case may be, of the Madrid Protocol;
- (l) where the mark arises from the conversion of a Community trade mark or an application for a Community trade mark, the number of any other registered trade mark from which the Community trade mark or the application for a Community trade mark claimed seniority and the earliest seniority date.”

7. Firstly, the form TM26R filed by the applicant included a signed statement in which he states that he is one of the current recorded owners of the trade mark; I, therefore, consider that the applicant has sufficient interest to make an application for rectification. There do not appear to be proceedings concerning the trade marks ongoing at court.

8. Sections 63 and 64 are all about the recordal of particular items of information in the register. Section 64 of the Trade Marks Act enables the Registrar to change the Register by adding, altering or removing information for the purpose of correcting errors or omissions, but only within the latitude allowed by the proviso to Section 64(1). The proviso prevents the Registrar from adding, altering or removing information for the purpose of correcting any error or omission affecting the validity of registering the trade mark to which the information relates. Since nothing can be done under Section 64 to correct such errors or omissions that affect the validity of the register, it is a key concern when considering an application under that section to ascertain whether the applicant actually is seeking to rectify an error or omission which lies outside the scope of the proviso.

9. Therefore, according to the legislation concerning rectification, a claim for rectification can be accepted under this section in relation to:

- 1) Claims that the mark was registered in the wrong name in error
- 2) If the true intention was to register the mark in the name now sought (not a change of mind)
- 3) If claims of the assignment was unlawful and should be reversed or
- 4) If there are claims that the register contains an error or omissions in some other respect.

10. The name and address on the register should be that of the proprietor, which for the purposes of the provision should be the intended grantee of the registration. According to the applicant's submissions, Ms Baker was "appointed [her] as a joint holder in good faith." It is clear that when the mark was registered that both Ms Baker and Mr Hoyle were recorded proprietors as they were the intended grantees of the registration and Ms Baker was not incorrectly identified when registering the mark. This indicates that the true intention of registration was to record both parties as proprietors and not to record it in the name of Mr Hoyle solely, which is now sought. From this and the applicant's submissions, it suggests that there has been a change of mind by Mr Hoyle – with respect to which the registrar has no power of rectification under Section 64.

11. It is clear that the intention at registration was for both parties to be proprietors and, therefore, there was no error/omission made at registration as to the proprietorship that has taken place. To state that it was the case would mean an objection that affects the validity of the application – which as previously mentioned is not permitted under section 64 legislation. I note that in *Swinging Blue Jeans*, Case BL O/148/14, where Mr Geoffrey Hobbs QC as the Appointed Person dismissed an appeal for rectification in a case where the application affected the validity of the registration of the trade mark and was excluded from consideration under section 64(1). At paragraph 22, he gave the following reasoning:

“(1) There was no apparent error or omission as to ‘the name and address of the proprietor’ to be recorded in the Register under Section 63(2)(c) and Rule 47(d). The ‘proprietor’ for the purposes of those provisions should be the intended grantee of the registration: see paragraphs [9] and [10] above. That was Alan Lovell in the present case and there was no failure to identify him correctly in the Register. In the absence of any objection to the validity of the application filed by GH/Decision 3 April 14 -15- Alan Lovell, there was nothing further to say about that or any other aspect of the recordal of the resulting registration.

(2) The suggested error or omission as to proprietorship was on any view dependent upon the making of a determination by a court or tribunal of competent jurisdiction to the effect firstly, that the application for registration was illegitimate for the reasons asserted by Ray Ennis and secondly, that Ray Ennis was entitled to have the resulting registration transferred into his name. In order to obtain a determination to that effect, it would be necessary for Ray Ennis to displace the presumption set out in Section 72 of the Act: ‘In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it’. His challenge to proprietorship would accordingly be ‘a matter affecting the validity of the registration of a trade mark’ from which the alleged error or omission was inseparable and with respect to which the Registrar had no power of rectification under Section 64.”

12. There is nothing to suggest from Mr Hoyle’s submissions that the initial registration was illegitimate – as he intentionally registered the mark in his name and that of Ms Baker. To find that ownership should have transferred to the name of Mr Hoyle would mean that the presumption under section 72 would need to be displaced. Mr Hoyle’s challenge to proprietorship of the mark would, therefore, be ‘a matter

affecting the validity of the registration of a trade mark' from which the alleged error or omission is inseparable. The registrar has no power to amend such matters in rectification proceedings under section 64.

13. Mr Hoyle also mentions that he paid for both parties to be recorded on the register and that Ms "Baker never paid her 50%". I have taken this submission to mean that due to the subsequent failure to pay for half of the registration costs and alleged criminal activity, Ms Baker should not be recorded as a proprietor— however, I note that I have not received any evidence of a contract/assignment between the parties that suggests that failure by Ms Baker to pay for half of the registration of the mark would result in her being removed from the proprietorship of the mark. Further, I note that there has been no suggestion that the registration of the mark was unlawful in any other way, nor am I able to identify that the register contains an error or omission in some other respect.

14. Taking all of this into account, I conclude that Mr Hoyle is precluded from being successful in his application to rectify the register because of the proviso in section 64(1) that "an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark". I conclude that the proposed action affects the validity of the registration of the trade mark and, therefore, is excluded from consideration by the proviso to section 64(1). I decline to make any findings with regard to Ms Baker being recorded on the register regarding the mark at issue and any alleged behaviour.

CONCLUSION

15. In light of my findings above, the rectification fails in its entirety.

COSTS

16. As the application for rectification failed in its entirety, I would usually make an award in favour of Ms Baker. However, as Ms Baker was not involved in the proceedings and suffered no expense associated with the proceedings, I make no award of costs.

Dated this 23rd day of May 2023

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FOR THE REGISTRAR