

O/081/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. 2450593 OF THE TRADE MARK  
KATE KANZIER  
IN THE NAME OF SUHEL MIAH**

**AND**

**AN APPLICATION FOR RECTIFICATION UNDER NO. 83892 THERETO BY  
EIGHTEEN SIXTY FOUR LIMITED**

## BACKGROUND

1) On 24 March 2007 Eighteen Sixty Four Limited (hereinafter 1864) applied for registration of the trade mark KATE KANZIER. The application was numbered 2450593. Following examination of the application, it was accepted and published before being registered on 28 September 2007.

2) On 2 March 2010, an application to amend the register to record a change of ownership of the trade mark was filed on Form TM16 by Suhel Miah. The form, dated 1 March 2010, states that the change occurred on 1 November 2009 and the form was signed by Revomark, Mr Miah's Trade Mark Attorneys. It sought to amend the name of the registered proprietor to Suhel Miah and was said to be the result of an assignment of the trade mark. That change to the register was subsequently effected and the registration now stands in the name of Suhel Miah.

3) On 27 October 2010, 1864 filed an application to rectify the register. It seeks to return the recorded ownership of the registration from Suhel Miah to 1864. Mr Kaiser Janjoo, a Director of 1864, signed the form and states that Mr Miah was a director of 1864 until his resignation on 19 February 2010 and that Mr Miah did not have permission to assign the trade mark and, at the time of the alleged assignment, he was not a Director of 1864.

4) Mr Miah filed a counter-statement. He states that he set up the company (1864) in June 2003 having created the brand KATE KANZIER in 2001. He claims that he worked with someone called Jilly Kanzier but preferred the name Kate as it sounded more English. He states that he appointed Mr Janjoo as a co-director in 2003. Mr Miah claims that at this point it was agreed between the two men that the brand name was the personal property of Mr Miah. He states that he allowed 1864 to use his brand. In November 2009 he states that he applied to transfer the trade mark from 1864, of which he was a director to his personal name. He states:

“20. At no time have I resigned as a Director of my company as stated by my co-director. I was forced to resign under threats of duress. In fact the nature and manner of the purported resignation is a matter that has been reported to the police and I continue to assist in relation to that enquiry.”

5) Mr Miah then states that in November 2009 he assigned the trade mark to himself, albeit not filed until much later. He states that he was held captive in his shop for several hours on 19 February 2010 by Mr Janjoo and two other men, his life and those of his family were threatened unless he agreed to resign as a director of 1864.

6) Both parties filed evidence, and both seek an award of costs in their favour. The matter came to be heard on 11 January 2012. At the hearing, Mr Miah was represented by Ms McFarland of Counsel and Mr Lynch of Her Majesty's Counsel instructed by Messrs My Business Counsel whilst 1864 was represented by Mr Fernando of Counsel instructed by Messrs Briffa.

## **Mr MIAH'S EVIDENCE**

7) In a witness statement, dated 10 January 2011, Mr Miah repeats his claims that he alone created, established and developed the brand KATE KANZIER in respect of shoes and handbags. He states that he began using the mark on such goods in 2001, prior to setting up 1864 by himself in June 2003. At paragraph 5 of his statement he states: "I alone set up a company called Eighteen Sixty Four Ltd in June 2003". He states that in July 2003 he appointed Mr Janjooa as a co-director. He repeats his claim that the two directors agreed that the brand was Mr Miah's personal property. Mr Miah states that in November 2009 he assigned the mark to himself. He repeats his allegations of intimidation against Mr Janjooa and states that he was forced to resign as a director of 1864. He describes the actions of Mr Janjooa as "fraudulent" and he had his solicitor set out the accusations in a letter to Companies House, copy at exhibit SM5. He also supplied the following exhibits:

- SM1: Copy of Companies House registration certificate dated June 2003 for Eighteen Sixty Four Limited.
- SM2: Copy of the Companies House register showing Mr Janjooa being appointed a Director in July 2003.
- SM3: A copy of the return to Companies House showing that as of January 2010 Mr Miah was still a director of 1864.
- SM4: A copy of the assignment document transferring ownership of the trade mark from 1864 to Mr Miah. This is dated November 2009. There is no mention of payment being made to 1864.

## **APPLICANT'S EVIDENCE**

8) The applicant company, 1864, filed five witness statements. The first, dated 21 April 2011, is by Kaiser Janjooa, the sole Director of 1864. He states that he paid for 1864 to be set up and that he was involved in every aspect of its inception. He states that it was his other company (Emporium Shoes) that leased the premises and paid for the refurbishment. Mr Janjooa states that Mr Miah was unable to get any credit and so it was left to him to finance the company. The lease of the property occupied by 1864 Ltd was paid for by Emporium Shoes. He denies that the mark was used prior to the setting up of the company and states that the second part of the mark is a play upon his and his wife's names (Kaiser & Nazir). He also states that he instructed the agent to register the trade mark in 1864's name. He points out that there is no documentary evidence to back up Mr Miah's claims that he had allowed 1864 to use the mark. He denies all of Mr Miah's claims to rights in the mark and in particular he denies knowing of the assignment to Mr Miah. He comments on the fact that given the serious nature of the assignment surely there should have been board minutes, or his signature on behalf of 1864 or at least a form of payment for a very important and valuable part of the company.

9) Mr Janjoo states that the reason that Mr Miah resigned as a director was because he had stolen £120,000 from the company. Mr Miah had promised to repay the monies, resign as a director and transfer his shares to Mr Janjoo on the basis that the police were not involved. On the date that Mr Miah alleges he was held against his will and threatened with violence was the day that the theft was uncovered and a meeting took place between Mr Miah and Mr Janjoo as Directors of 1864 and also Mr A Bhatti and Mr I Bhatti who are both directors of KBM UK Limited (hereinafter KBM) accountants for 1864. The meeting was at the offices of KBM. Mr Janjoo states that in the year since the alleged incident the police have not contacted him, nor have Companies House who were supposedly written to by Mr Miah's solicitors. However, Mr Janjoo notes that Mr Miah's sister works at this law firm and he casts doubt as to whether the letter was ever sent. He confirms that he never agreed to an assignment to Mr Miah. Mr Janjoo also provides the following exhibits:

**KJ1:**

- Pages 35-79: The lease for the premises which shows Emporium shoes leasing the property and paying the deposit.
- Pages 87-102 various invoices most of which are addressed to "1864 t/a Kate Kanzier", although some are simply to Kate Kanzier.
- Pages 103-177 copies of magazines (*Vogue, Grazia, Vanity Fair, Look and Heat*), newspapers (*Daily Telegraph, Daily Express and Observer*) and websites (*Elle, Guardian and Glamour*) showing that the brand was receiving publicity. These date from 2003-2009.
- Page 229A: A copy of the cheque sent to the Trade Mark registry to register the mark in suit which is on the account of 1864.
- Pages 230-235: Copies of deposit slips showing payments of cash totalling £33,170 being paid into an account said to be Mr Miah's during the month of September 2009.
- Pages 236-238: a copy of the minutes of a board meeting on 19 February 2010 at the premises of KBM accountants. The allegations of theft were put to Mr Miah who ultimately admitted the theft stating that he used the money to purchase a house and also to refurbish a juice bar for his brother. The minutes show that those present were Mr Miah, Mr Janjoo, Mr A Bhatti and Mr I Bhatti.

10) The second witness statement, dated 20 April 2011, is by Paul Anthony Derek Tutton the principal of Lease Link a management consultancy company. He states that in early 2003 Mr Miah contacted him and a meeting was arranged between the two men and also Mr Janjoo. The meeting was arranged to discuss the setting up of a new business, although the name KATE KANZIER was not mentioned at the meeting. Mr Tutton was tasked with setting up a new company with both Mr Miah and Mr Janjoo being

directors. Mr Tutton states that Mr Miah's very poor credit history was an issue but Mr Janjooa's excellent credit rating overcame these issues. He states that shortly after the formation of the company he was informed that the brand name Kate Kanzier had been devised by the applicant's two directors. He states that in his experience Mr Miah ran the shop whilst Mr Janjooa travelled abroad arranging design, manufacture and shipping of shoes being sold in the shop. He states that in early 2007 he arranged for the mark to be registered at the request of Mr Janjooa. Mr Tutton states that he helped to rearrange matters after the theft by Mr Miah was discovered.

11) The third witness statement, dated 21 April 2011, is by Mohammed Afzaal Bhatti, a Chartered Certified Accountant and a director of KBM UK Limited. He confirms that Mr Janjooa ran a highly respected firm prior to setting up 1864. He also confirms that Mr Janjooa was the major force in 1864. He states that, in late December 2009, Mr Miah asked him to provide a false accountant's reference in support of a mortgage application, which he refused to do. Mr Bhatti states that, in February 2011, Mr Janjooa showed him documents which showed that Mr Miah had withdrawn almost £120,000 from 1864's bank account and paid it into his personal account. On 19 February 2011 a meeting between Mr Janjooa and Mr Miah took place at the offices of KBM which he witnessed, along with his brother Mr I Bhatti and an employee of KBM, Ms Marzena Cybula. He states that Mr Miah admitted the theft and offered to repay the funds and resign from the company. He also provides a schedule of cheques, from the 1864 account, which were made out to Mr Miah, made out to cash or relate to payments for his gym membership. There is also a mysterious payment into the account of 1864 on 22 April 2009 of £10,000 which is thought to have been made by Mr Miah's sister. The schedule amounts to £119, 726.46. Copies of the cheques to cash and to Mr Miah were provided and show the following, lower figure:

Date	Payee	Amount £
19/2/09	Cash	10,000
26/2/09	Cash	10,000
5/3/09	Cash	9,000
17/3/09	Cash	10,000
27/3/09	Cash	10,000
18/9/09	Suhel Miah	15,000
21/9/09	Suhel Miah	15,000
28/9/09	Suhel Miah	15,000
1/2/10	Suhel Miah	5,264.33
TOTAL		99,264.33

12) The fourth witness statement, dated 21 April 2011, is by Mohammed Ibrar Bhatti, an employee of KBM. He confirms that a meeting took place at the offices of KBM on 19 February 2011 and that Mr Miah was under no duress. He states that he was present at the meeting as a witness and heard Mr Miah admit to taking funds from 1864 for his personal gain and offering to repay the monies and resign from the company if the police were not involved.

13) The fifth witness statement, dated 21 April 2011, is by Manzene Cybula an employee of KBM. She confirms that a meeting was held at the offices of KBM on 19 February 2011, attended by Mr Miah, Mr Janjooa and witnessed by Mr I Bhatti and Mr A Bhatti. She was not in the meeting but saw the parties arrive and was asked to type a letter of resignation for Mr Miah. She states that she heard no threats of violence against Mr Miah and he did not seem under duress.

#### **Mr MIAH'S EVIDENCE IN REPLY**

14) Mr Miah filed a further witness statement, dated 22 December 2011. He repeats his comments of earlier that he was forced to resign from 1864 and that Mr Janjooa has acted illegally. He alleges that criminal action is being pursued against Mr Janjooa and the accountants. He states that 1864 is being dissolved. He repeats his claim to have thought up the mark and claims that it was agreed that the mark would remain his personal property, but claims that he cannot prove any of this as he cannot access the premises where the paperwork and his laptop are stored. He provides a history of the company where he accepts that he could not obtain the finances required to set the company up and lease premises and so he approached Mr Janjooa to join the company. He disputes Mr Janjooa's claims regarding who really ran 1864 stating that he (Mr Miah) was the driving force.

15) He claims that he came up with the mark as he once met a Jilly Kanzier when working for LA Fitness in London and thought the surname interesting and teamed it with the name Kate after Kate Moss to form an English name. He provides details of a marketing company he appointed to develop the mark and also the name of a person who he states formed the website of 1864. Neither are backed up by independent evidence. He also provides details of a court case against 1864 by Louboutin regarding infringement of an earlier trade mark.

16) In describing the proceedings for infringement he makes the following statements:

“34. The allegations were concerning a certain type of shoe that I designed and was selling. This shoe had a red sole, which Louboutin alleged was very similar to their trade mark and hence alleged trade mark infringement and passing off against the Applicant. Since it was understandable the angle that Louboutin was taking, my thoughts were to protect the most important asset of the business, which was the trade mark. Therefore, whilst discussions were ongoing I assigned the Trade mark to my name as the Trade Mark was not subject of the proceedings. I did not see this as an issue, as I understand that usually I would need to pay market value for the trade mark, however, it should have been licensed to the company in the first place and not assigned. During the proceedings, Mr Janjooa was very difficult to get hold of as he was not interested in the Applicant no longer as he considered that the Applicant would be liquidated without a doubt.

35. It was then when I realised that something as important as the trade mark should have been registered in my personal name, with an exclusive licence being granted to the Applicant.

36. The proceedings were eventually settled. I did not think to assign the trade mark back to the applicant, as it was safer in my personal name, exactly where it should have initially stayed had I received appropriate legal advice at the time of registration.”

17) Mr Miah denies the allegations of theft and states that the accountants often lost documents and that the cash withdrawals were to pay Mr Janjooa. He states that on the 19 February 2010 he was taken from the shop to the offices of the accountants, arriving at approximately 9.30pm. He states that he was held against his will and forced to resign as a director and transfer his shares to Mr Janjooa.

### **APPLICANT’S ADDITIONAL EVIDENCE**

18) The applicant filed two witness statements. The first, dated 6 January 2012, is by Mr Janjooa who has already provided evidence in this case. Mr Janjooa states that the concern over the credit history of Mr Miah was such that Mr Miah had to resign as a director of 1864 before the company could obtain a bank account. Once the account was open Mr Miah was re-appointed. This is shown in the papers he provides at exhibit KJ2, pages 1 & 2. These show Mr Miah resigning on 18 July 2003 and being appointed on 10 September 2003. Mr Janjooa states that the £12,000 deposit for the premises occupied by 1864 and paid from Emporium Shoes was never repaid as suggested by Mr Miah, and he challenges him to provide evidence from the bank to show such a payment. Mr Janjooa states that the laptop referred to by Mr Miah as having details of the creation of the mark was purchased by him on 16 February 2008 and given to Mr Miah, and so cannot contain the details claimed. He provides a receipt for the item at pages 3-4 of exhibit KJ2.

19) Mr Janjooa states that in his earlier statement he did not refer to the issue with Christian Louboutin as he did not believe that it was relevant to the instant proceedings. However, as Mr Miah raised the issue, Mr Janjooa believes that he should respond. He states that he discussed the letter from Louboutin’s solicitors and whilst it was a setback it was not critical as they simply conceded to the complaint and made a financial payment. Mr Janjooa states that whilst discussing this matter with Mr Miah, no mention was made of the assignment of the trade mark in suit. He states that the matter was left with Mr Miah’s sister, Rehana Khanam at Central Law Practice to send a letter to Louboutin indicating that the offending shoes had been withdrawn from sale. He states that the matter was then transferred to SFS legal who sent invoices to Ms Khanam at the premises of 1864; see exhibit KJ2 pages 10-12. The matter was eventually settled with a payment of £2,500 to Louboutin’s solicitors (KJ2: pages 15-16).

20) Mr Janjooa states that he never asked Mr Miah to draw large sums of cash from 1864 accounts for his use as Mr Miah alleges. He also states that

1864 is not in dissolution. He states that the theft of cash by Mr Miah and his promise to repay led to the accounts being filed late. When Companies House threatened to strike off 1864, Mr Bhatti wrote to them explaining the situation and 1864 remains upon the Companies Register.

21) The second witness statement, dated 6 January 2012, is by Ralph Wehrle a solicitor working for Briffa solicitors. He describes how he contacted LA Fitness in Kentish Town London where Mr Miah stated that he met Jilly Kanzier. The company informed him that no-one of that name had worked there. He also searched Google, Twitter, Facebook and the electoral roll (from 2002) for the name using a variety of spellings etc but found no reference to Jilly Kanzier.

### **MR MIAH'S ADDITIONAL EVIDENCE**

22) Mr Miah provided another witness statement which is unsigned and undated but was received on the morning of the hearing. At the hearing it was agreed to allow this evidence into the proceedings, although the applicant had not had time to study it or check its veracity. Mr Miah provides a copy of an e-mail from Ms Eve Sukhnandan the Divisional Human Resources Business Partner for LA Fitness. She confirms that Jilly Kanzier worked for the company between 11 September 2000 and 1 April 2002.

### **CROSS EXAMINATION**

#### **Ms Cybula**

23) As she did not attend to be examined upon her evidence, little or no weight can be attached to her statements.

#### **Mr Wehrle**

24) Given the third witness statement of Mr Miah, Mr Wehrle's evidence is of little value, although as one might expect he was completely credible.

#### **Mr Tutton**

25) Mr Tutton was a totally credible witness who stated his evidence very clearly and was able to flesh out parts with pithy comments and memories which simply added to the overall impression of honesty. Mr Tutton is not an employee of 1864 but works as a business consultant for them as and when required. He has been involved with the company from its inception and indeed negotiated the leases for the premises occupied by 1864. He described the relationship between Mr Janjooa and Mr Miah as "almost like father and son". He also stated that "They appeared to have a good informal working relationship, yes; apart from with the finances, when Mr Janjooa would always have the final say on anything like that". He described how during a meeting with Mr Janjooa and Mr Miah he enquired where the idea for the mark had come from. He states that he was informed that the two men had sat down together and brainstormed and the brand had emerged from the

meeting. Mr Hutton confirmed that he had registered the trade mark simply by sending in a completed form to the Registry, he did not carry out any searches prior to this.

### **Mr Afzaal Bhatti**

26) Mr Bhatti was a very measured and thoughtful witness who weighed his answers carefully before speaking. I found him credible even though he admitted to failing in certain of his duties as a Chartered Accountant. He accepted that his company had been seeking answers regarding large amounts of cash withdrawn by Mr Miah from the company but had received no answers prior to the meeting in February 2010. He accepted that once he became aware that monies had been stolen he should have informed the authorities, however he did not as the matter was amicably resolved between the two directors of the company at the February meeting. No doubt he believed that if it came to light it could be explained away as a temporary unauthorised loan that Mr Miah agreed, according to the minutes of the meeting, to repay. He confirmed that at the meeting Mr Miah admitted stealing the monies and agreed to resign his directorship, transfer his shares to Mr Janjooa and repay the approximately £70,000 that he had stolen to buy a house in return for Mr Janjooa not reporting the matter to the police. He also described Mr Janjooa as the 85% share holder and Mr Miah as the 15% shareholder. He accepted that having Mr Miah's thumb print as well as a signature upon Mr Miah's letter of resignation was unusual but given the scale of the theft, the circumstances were unusual. He was also aware that Mr Janjooa and Mr Miah had purchased a property together in Dubai as it arose during the February meeting, but he was not aware of whether it was paid for in cash. This property was not mentioned in any of the written evidence. No questions were put to him regarding whether Mr Miah was under duress at the meeting and he did not mention, and was not asked, whether Mr Janjooa and Mr Miah were accompanied when they arrived at the premises.

### **Mr Ibrar Bhatti**

27) In the important details of the meeting such as Mr Miah admitting that he stole the monies, agreeing to repay the stolen monies, resigning and transferring his shares, Mr Bhatti was credible and solid. However, he contradicted his brother when stating that asking for a thumb print in addition to a signature was normal practice. It might have been the fact that the question was posed as being "in the circumstances" so that he might have been thinking of similar instances where the company dealt with thieves, that a thumb print was standard practice as they could not then argue that the signature was a fake. However, it did cast some doubt on his evidence and that of his brother. Mr Bhatti was not asked if Mr Janjooa and Mr Miah were accompanied when they arrived or whether Mr Miah appeared under duress. He described how he and his brother took notes whilst they were making conversation.

## Mr Janjooa

28) He is clearly an experienced business man, who is accustomed to working the system in order to benefit himself. An example of this was the fact that it emerged that whilst a Director of a company with a turnover of approximately £400,000 per annum he officially paid himself only £500 per month allowing him to claim tax credits for approximately three years. During this time he spent an average of 6 months of each year out of the country travelling in China and the East, presumably on expenses. It also emerged during questioning that he and Mr Miah purchased a property together in Dubai, each man paying £70,000 in cash. Whilst Mr Janjooa might be able to show that this money came from his earlier enterprises. Quite what HMRC would make of this I cannot say, but it is somewhat unusual to be able to pay such an amount in cash. It was interesting how, in moments of stress, his command of the English language would desert him, allowing him time to consider the best answer to give, presumably rather than the absolute truth. If I were asked for my opinion of him in layman's terms I would suggest that, in short, he is a slippery eel, who bends but does not necessarily break the rules. However, virtually all the issues that caused this impression were outside the main issue of the relationship with Mr Miah, whether there was an agreement regarding the trade mark and whether monies were stolen. The allegation that Mr Janjooa got Mr Miah to take out cash on his behalf is, to my mind, not credible. Mr Janjooa might well have taken cash out of the company but he would never have done it in such an obvious manner which could hardly fail to be spotted had HMRC inspected the books. He would have ensured that he had a cover story, just as he never signed any paperwork at the company and so always had deniability. Mr Miah had available to him an easy way of showing that he did not steal the money but merely obtained it for Mr Janjooa. He could have simply provided copies of his bank statement for the short period of time in question. Further, if this were a regular pattern of behaviour during their years in business together why was this not alleged and why were no details as to how the cash was paid to Mr Janjooa given. Nor was an explanation forthcoming as to why such large sums were needed in such a short space of time, other than that put forward by Mr Janjooa that Mr Miah was using the stolen money to purchase a property with his sister.

29) I note that Mr Janjooa did not hesitate to use money from his previous business, also a Limited company, to pay for the lease for premises occupied by 1864. He clearly views both as his businesses, and was content to use the former to assist the latter. It was not suggested that this is illegal, although perhaps more usual between companies in a group rather than those whose only connection was a shared director. Mr Janjooa was convincing on the creation of the trade mark in question recalling that he was with Mr Miah in Costa Coffee just across the road from Emporium Shoes in Camden High St. I do not attach much importance to the fact that an insurance company misspelt the company name. I speak with some considerable personal experience of companies misspelling my name even though I am very clear how to spell it myself. Similarly, the issue of the schedule of monies unaccounted for which was dated after the February meeting was honed in

upon by Mr Lynch. Unfortunately, as this formed part of Mr Bhatti's evidence Mr Janjooa was unable to assist, other than to agree that it was perhaps merely the latest such schedule in a series produced as the investigation by the accountants proceeded. Mr Janjooa was unclear whether such a schedule was put before Mr Miah at the February meeting, but he was clear that Mr Miah was shown the cheques that he, Mr Miah, had written to himself and the slips paying into his, Mr Miah's, account and accused of stealing the sums involved. Mr Janjooa was entirely convincing in his dismissal of the proposition put to him that the legal action taken against the company by Louboutin threatened its existence. Mr Janjooa was adamant that whilst it suffered a financial hit, its survival was never in doubt. He seemed to find such an idea laughable, and given the damages eventually paid to Louboutin, he was correct.

### **Mr Miah**

30) I am aware of the illness that Mr Miah is combating and in considering his answers and demeanour I have made allowance for his physical discomfort and stress. However, even taking a very charitable view he was the least credible witness of those cross examined. He seemed to resent being questioned about his evidence bordering on the petulant at times. Like the curate's egg, the good bits were fatally tainted by the bad. His only explanation as to why he left out the Louboutin issue from his first witness statement was that he did not have legal advice. Yet this was the event which he claims caused him to assign the mark to himself and threatened the survival of the business. He had great difficulty in answering very simple questions which were put to him a number of times. Despite the question being explained to him very carefully he did not offer answers other than to repeat, almost parrot like, that the mark belonged to him. He was reminded that he had described the trade mark as "the most important asset of the business". Yet he was unable to state why, when he felt this was threatened by Louboutin that he would sign an assignment in November and yet wait until March before filing it. Nor could he explain how £10,000 that his sister was apparently lending him appeared in the bank account of 1864. He also contradicted parts of his evidence, such as the events leading up to the leasing of the premises in Leather Lane. He attempted to pass off his business failures prior to starting up 1864 as being temporary businesses as he only had short term leases. He could not explain why, if the business had been successful, he did not obtain another shop or why having leased one shop by himself he was unable to get a bank account just a couple of years later, when he had to resign as a director of 1864 for it to get a bank account. Mr Miah's version of events regarding the setting up of the company, the leasing of the premises and the creation of the trade mark contradicted not only Mr Janjooa's evidence but also that of Mr Tutton. In cross examination Mr Miah claimed to have informed Mr Tutton that he created the mark and of the agreement with Mr Janjooa that he could reclaim the mark at any time. Given this completely contradicts the evidence that was filed by Mr Tutton one has to wonder why it did not feature in Mr Miah's written evidence as it clearly should have been put to Mr Tutton in cross examination at the very least. Mr Miah did not accept the description of his relationship with Mr Janjooa as

“father and son” but accepted that he regarded Mr Janjoo as an “older brother”.

31) Mr Miah was unable to provide a satisfactory answer to the question that if he wanted to protect his business interests in the event of his death, as he claimed, then a verbal agreement would clearly have died with him. Nor could he answer why, his taking away the most important asset of the company would be in its best interests, something which as a director, he was supposed to abide by. Perhaps most damning was the complete failure to answer the question “Did you transfer £33,170 into your personal account in September 2009?” This question was posed five times and a yes or no answer sought, but Mr Miah refused to answer. Even when his own Counsel threw him a lifeline by stating that he could answer “I do not remember” he failed to answer. He also claims that his life was threatened by Mr Janjoo and Mr Bhatti when in the offices of KBM, as well as by an unidentified man accompanying Mr Janjoo, in the shop in Leather Lane.

32) That concludes my summary of the evidence.

## **DECISION**

33) Rectification of the register is provided for under Section 64 of the Trade Marks Act 1994. Section 64 reads as follows:

“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) ...

(5) ...”

34) Section 24 of the Trade Marks Act 1994 is also relevant. It reads:

“24.-(1) A registered trade mark is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property.

It is so transmissible either in connection with the goodwill of a business or independently.

(2) An assignment or other transmission of a registered trade mark may be partial, that is, limited so as to apply-

(a) in relation to some but not all of the goods or services for which the trade mark is registered, or

(b) in relation to use of the trade mark in a particular manner or a particular locality.

(3) 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 may be, a personal representative.

Except in Scotland, this requirement may be satisfied in a case where the assignor or personal representative is a body corporate by the affixing of its seal.

(4) The above provisions apply to assignment by way of security as in relation to any other assignment.

(5) A registered trade mark may be the subject of a charge (in Scotland, security) in the same way as other personal or moveable property.

(6) Nothing in this Act shall be construed as affecting the assignment or other transmission of an unregistered trade mark as part of the goodwill of a business.”

35) The applicant for rectification 1864 Ltd is seeking to reverse the assignment filed by Mr Miah. On behalf of Mr Miah, Ms McFarland contended that 1864 did not have *locus standi* on account of what she described as its “parlous financial state”. This appears to be based upon the notification by Companies House that 1864 would be struck off the Register for non-filing of accounts. The threat is a common one and has been stayed by Companies House after assurances by 1864 that the necessary paperwork would be filed. I see no reason why 1864 should be excluded from the instant case. Ms McFarland also sought to have the action struck out on the basis that 1864 does not come to the Tribunal with clean hands and refers to the allegations of kidnapping and threatening harm to Mr Miah. Whilst I accept that these allegations have been set before the police I also accept that these

allegations are vehemently denied by Mr Janjooa. I note that despite the very serious nature of the alleged crimes no action has yet been taken by the police despite the passing of approximately two years. I therefore decline to strike out the action on these grounds.

36) Ms McFarland also contends:

“10. The present case it seems that the App is claiming to have sufficient interest despite the claims set out by Mr Miah that from the outset, it was always made clear to Mr Janjooa as the co-director and co-shareholder of the company, and therefore was clear to the App company that the mark was the creation of Mr Miah and he was to retain entitlement to it.

11. In the premise, in order to get over the first preliminary hurdle under S.64(1) the App will have to show that Mr Miah’s testimony in this regard can be wholly disregarded. This is, we submit, an insurmountable hurdle for the App to overcome.”

37) I fundamentally disagree with this contention. This action was brought following a request by Mr Miah to amend the register to reflect an assignment, so that the mark in suit was registered in his name and not the name of 1864 of which he was, at one time, a director. The Registry simply complied with this request without asking for any evidence. The originally registered owner of the trade mark in suit is seeking to overturn this amendment on the basis that Mr Miah had no right to make such an assignment, having already resigned as a director of the company (1864), or in the alternative, if the assignment were deemed to have been signed whilst he was a director of 1864 then the assignment breached the fiduciary duty that Mr Miah held to 1864. I must therefore weigh up all of the evidence and decide the matter on the balance of probabilities. I am fortified in my view by the opinion expressed by Ms Carboni acting as the Appointed Person in Case BL /O/112/09 (*TURBOCHIP*) where she said:

“40. To deal with this, I go back to the text of rule 35(1). (The rule has now been replaced by rule 45(1) of the Trade Marks Rules 2008, which is in identical terms.) This refers to an applicant for leave to intervene “claiming to have an interest in proceedings” under *inter alia* the rule relating to applications for rectification under section 64(1). The wording indicates that the “interest” concerned must be in the “proceedings” themselves. The rule is not a general invitation to anyone who claims to have an interest in the trade mark in issue to seek to participate in the proceedings.

41. The rectification proceedings concern the question of whether the alleged switch of exclusive licensing arrangements from CPS to SAS between the application and grant dates for the Mark means that CPS was wrongly recorded as registered proprietor and that SAS’s name and details may be substituted pursuant to the provisions of section 64(1). There are two possible outcomes: CPS remains as registered proprietor,

or SAS is substituted. I say nothing about which outcome appears most likely, since the matter is yet to be considered at first instance.

42. Having rejected the potential interest in the proceedings as assignee and beneficial owner of the Mark, the only other interest for which Turbochip UK argues is its earlier and better rights as inventor and user of the Turbochip trade marks. As Mr Elliott pointed out, this argument goes to the question of whether CPS was entitled to apply for the Mark in the first place, which is a quite different question from that of whether – having done so – it was a correctable error to record CPS rather than SAS as the registered proprietor.”

38) I have to determine which side’s evidence I find most compelling. I have had the benefit of all of the major witnesses having been cross examined, Indeed, Mr Miah even brought in Counsel experienced in criminal law, albeit the original choice, Mr Chand, withdrew the day prior to the hearing. However, Mr Miah’s case was not harmed as the replacement, Mr Lynch Q.C., displayed a remarkable knowledge of the case despite having less than 24 hours to prepare. Ms McFarland and Mr Lynch make a formidable duo and the forensic questioning of the applicant’s witnesses brought out some inconvenient truths, particularly from Mr Janjooa which cast doubts over his honesty. It also revealed inconsistencies in the Bhatti brothers’ testimony regarding thumb prints. However, despite throwing their client lifelines they could not prevent the damage that Mr Miah caused to his own case, in his refusal to answer the most basic of questions which inevitably leads one to conclude that the obvious answer is not one which he wished to admit to or deny when under oath. Mr Fernando, his usual eloquent self, simply shredded Mr Miah’s credibility.

39) I also have to take into account the clear inaccuracies in Mr Miah’s witness statements when compared to his evidence under oath. In his first witness statement, he contends “I alone set up a company called Eighteen Sixty Four Ltd in June 2003”. This was clearly untrue as Mr Miah effectively admitted, and when questioned about other events he states:

- “When we set up the company in 2003, between me and Mr Janjooa in 2003...”
- “When we formed the company in 2003, okay?”
- “If you look at my original statement that me and Mr Janjooa originated with before we set up the company in 2003...”
- “No, it was agreed when we set up the company Eighteen Sixty Four...”
- Mr Fernando: “He [Mr Janjooa] agreed in 2003 to set up a venture with you, did he not?”  
Mr Miah: “No, my client came with a brand from 2001 which I discussed with him. He was interested. That is when we called Mr Paul

Tutton and then we formed the company name Eighteen Sixty Four and I actually gave the company the name Eighteen Sixty Four.”

- Mr Fernando: “Now, the company was set up by Mr. Tutton acting on behalf of Mr. Janjooa, was it not?”  
Mr Miah: “No, I instructed Mr. Tutton.”  
Mr Fernando: “No, you met Mr. Tutton with Mr. Janjooa.”  
Mr Miah: “No, no, no, this is completely untrue. I got the contact number for Mr. Tutton from -- I think he is related to Paul Tutton. I called Paul Tutton up and he said he is no longer in the business of leasing and he introduced me to Paul Tutton. I met Paul Tutton first and then I spoke to him about the business, Eighteen Sixty Four. At that time, there was no discussion about the brand Kate Kanzier. It was only a discussion about formation of the company. I gave him the money, cash, £150 in cash, to Mr. Paul Tutton to form the formation of the company.”

40) At paragraph 12 of his first witness statement Mr Miah states “I acquired the commercial lease to the premises of 63 Leather Lane under my company name in June 2003 after I had established my company.” Yet in cross examination he stated:

- “No, once I saw the property we got the keys and Mr Janjooa was also interested in 63 Leather Lane. We discussed about this, but I could not get the lease under my name.”
- Mr Miah: “The original rent was for 18,450. We negotiated for 16,000.”  
Mr Fernando: “That was done by Mr Tutton.”  
Mr Miah: “Under my instruction, Mr Janjooa’s instruction.”

41) Much was made regarding the dates that individuals were appointed as directors and company secretary. From the various exchanges it seems to me that 1864 relied upon Mr Tutton. It could be that he did not read the form correctly, and that he made the mistake of assuming that a separate form was required to make someone a director as opposed to a company secretary. This is pure conjecture. What is clear is that Mr Miah was made a director with Mr Janjooa the company secretary, and shortly thereafter Mr Janjooa was appointed as a director. I also note that Mr Miah resigned as a director for a brief period of two months whilst the bank account was sorted out. This undermines Mr Miah’s claim to have been the man responsible for setting up the company and bringing others in, when he could not get a bank account for a company if he were a director of it. I also note that from the inception both men were shareholders in 1864.

42) During his evidence Mr Miah claims to have studied the fashion market and in particular the shoe market very closely. He stated that he read extensively from fashion magazines and yet the company was selling shoes with a red sole which, if he was au fait with fashion matters, he would have realised was the trade mark of Louboutin and ensured that his brand did not infringe. Therefore, the infringement action should not have come as such a shock as he claims.

43) Regarding the assignment, he claims to have signed the assignment to himself on Sunday 1 November 2009, but that he did not have time to post it prior to going abroad with Mr Janjooa. He returned to the UK in the second week of December, before flying out to China on 16<sup>th</sup> December. Mr Miah states that he returned to the UK on Christmas Day whilst Mr Janjooa did not return until 16 January 2010 before almost immediately flying out again to Dubai. Mr Miah states that he was very busy and only managed to post the form to Revomark, his trade mark agents, in early February. He could not explain why he would delay actioning the assignment given that the threat of legal action by Louboutin was still present, other than to say that he was busy.

44) Mr Miah comes across as a Walter Mitty type character who actually believes that he was the sole driving force behind everything that happened in the company. In his statements he claims responsibility for all events, setting up the company, renting the premises, coming up with the trade mark, designing the shoes etc etc. Yet the evidence of others, and indeed the paperwork fatally undermines his story. It is clear that the paperwork for setting up the company and appointing directors was done by Mr Tutton. Mr Tutton introduced them to a bank manager and a few years later renegotiated the lease. Mr Tutton was unequivocal that he was brought in by Mr Janjooa and at all times was working for both Mr Miah and Mr Janjooa, albeit with Mr Janjooa always having the final word on financial issues. During cross examination Mr Miah went from having, on paper, a reasonably cogent narrative, to having a narrative that was so full of holes and contradictions that it resembled a piece of Gruyere. He also failed to provide any answer to a number of questions that cast further doubt over his veracity and credibility. If I am to believe Mr Miah's version of events, then I have to believe that Mr Tutton and both Bhatti brothers have joined Mr Janjooa in a conspiracy against Mr Miah. Although Mr Janjooa is not the most credible witness I have ever seen, I do not believe that the three other men, all of whom are professionals and have only a business relationship with Mr Janjooa would be prepared to perjure themselves.

45) I will now turn to the issue of the assignment. I do not believe for one moment that Mr Miah signed this on 1 November 2009 but did not post it to his trade mark agent until early February 2010. However, I shall deal with it initially as though he is being truthful. As of 1 November 2009 Mr Miah was a director of Eighteen Sixty Four Limited and therefore owed a fiduciary duty to the company. A fact he accepts in his evidence when he states that he should have paid the market value for what was the company's most valuable asset. I will leave aside the question of whether this was further theft from the company. It has been contended by Ms McFarland in her written submissions that:

“Hereunder, we respectfully remind the learned hearing officer of our oral submissions during opening on 11<sup>th</sup>, when we stated that there can be no breach of duty as alleged by Apps' counsel, if **Miah** was acting in accordance with the earlier agreement and/or with the full consent and knowledge of the only other director and shareholder of the company i.e., **Janjooa**. We observe it was never put to **Miah** in XX that he had the requisite mens rea as per Apps'

authority *Dolphin –v- Simonet* – at para 96 “*knowingly had a conflict of interest*”. All the “fiduciary duty authorities” relied on by the Apps show that the **remedy** is not to set aside the transaction but to award compensation / account of profits or damages. See for example para 100 in *Dolphin –v- Simonet*. In the premises, even if there had been any such breach (which is denied) the remedy available to the Apps is financial, **not the** remedy of setting aside the assignment as they seek under this Application.”

46) This contention relies upon my accepting Mr Miah’s version of how the mark was created and whether there was an agreement between Mr Miah and Mr Janjooa as to the ownership of the mark resting with Mr Miah. I will deal first with the creation of the mark. I fully accept that Mr Miah knew a woman called Jilly Kanzier. I am fully prepared to accept that he felt that, with a minor change, the name would make a good trade mark. However, if this were the case why did he agree with the story told, in his presence, to Mr Tutton that the mark came from a meeting between the two directors over a cup of coffee. Mr Tutton was absolutely clear in his recall of this event. Could it be that when discussing the question of what trade mark to use, Mr Miah suggested that using part of Mr Janjooa’s wife’s name would be a good idea? Thus flattering the older partner, who Mr Miah admits was like an older brother, into agreeing to use the mark that Mr Miah had in mind all along. The story told to Mr Tutton at least seems consistent with the mark being registered in the name of the company in which both men held shares.

47) Turning now to the question of Mr Janjooa agreeing that the mark was the personal property of Mr Miah and that at any time he could take it away as his personal property, I find this very difficult to accept. Mr Janjooa is an experienced business man. I find it inconceivable that such a wily old bird would invest considerable amounts of time and money into building a business around a single trade mark when at any stage the plug could be pulled. I also take into account the actions of Mr Miah which raises more questions. If he had such an agreement, why did he not get Mr Janjooa to sign the assignment form? Why did he not sign the form himself, instead of asking Revomark to sign it? Why did he not ask Mr Tutton or KPM to process the paperwork, instead of making arrangement with Revomark? All of these actions appear to be the actions of someone doing something which they know to be underhanded. I have to determine whether I believe Mr Miah’s version of events or that given by Mr Janjooa. Overall I favour Mr Janjooa and find that there was no verbal agreement between the men, that the mark in suit was always the rightful property of the company which they jointly set up and which traded under the mark in suit.

48) Therefore, if Mr Miah did assign the mark to himself in November 2009 he did so in direct conflict with his fiduciary duty to the company of which he was a director. As such the assignment is null and void.

49) I must also consider the position as if Mr Miah assigned the mark to himself as of March 2010. He would have been fully aware that as of the 19 February 2010 he had resigned from the company. I will leave aside for a moment the issue of whether this was under duress. He knew that he was no longer a director and so had no right to assign the mark to himself and

certainly had no right to instruct Revomark to sign the TM16 assignment form on behalf of 1864. As to whether he resigned under duress, to a degree he did. Mr Miah had been exposed as a thief, who had cheated a man, who he stated he regarded as an elder brother out of a very substantial sum. If this were not the case then he surely would have found it easy to file his bank statements for 2009 and also to answer the question as to whether he paid £33,170 into his own bank account during the month of September 2009. Mr Miah admitted his crime to Mr Janjooa and the Bhatti brothers in the meeting in February 2010. Faced with the prospect of a criminal trial and probable jail sentence, he agreed to resign his directorship, transfer his shares and repay the monies stolen in return for a promise that the police would not be informed. Unsurprisingly, given the duplicity already displayed by Mr Miah someone deemed it advisable to get his thumb print on the documents. Whether there was some physical coercion involved is impossible to say, although not enough to need medical attention.

50) It has been contended that if Mr Miah were a liar and had committed the crimes of which he is accused, he would not have contacted the police. However, I note that he states that he only approached the police approximately one month after the alleged assault and kidnap and that he has not filed copies of his statement to the police so it is unclear quite what he told them. In the month following his resignation he would have been aware that the Registry was processing his assignment but did not think to inform the Registry of the circumstances, indeed it is my belief that he not only signed and filed the assignment during this time but also concocted the defence which he now relies upon.

51) The conclusion I reach is that if Mr Miah signed the assignment after 19 February 2010 albeit dating it retrospectively, he was acting unlawfully and the assignment is null and void.

50) Whether the assignment was signed in November 2009 or late February 2010 it was unlawful and therefore the register should not have been rectified. I am satisfied that the current entry in the register which shows Suhel Miah as the registered proprietor of trade mark No. 2450593 is incorrect and that it would be right to correct matters. In the exercise of the discretion conferred upon me by Section 64 of the Trade Marks Act 1994, I direct that the register be corrected; the name of Mr Miah shall be removed as proprietor and Eighteen Sixty Four Limited shall be substituted in its place. The effect of my decision is that the recordal of the change of ownership to Mr Miah shall be deemed never to have been made.

## **COSTS**

52) 1864 has been successful and as such it is entitled to a contribution towards its costs.

53) 1864 has requested an opportunity to make submissions on costs as this could not be covered at the hearing due to lack of time. I therefore give 1864 fourteen days from the date of this decision to make submissions on costs,

with Mr Miah being allowed an additional fourteen days to comment on the submissions of 1864. The appeal period will be set in the supplementary decision covering the issue of costs.

**Dated this 24<sup>th</sup> day of February 2012**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**