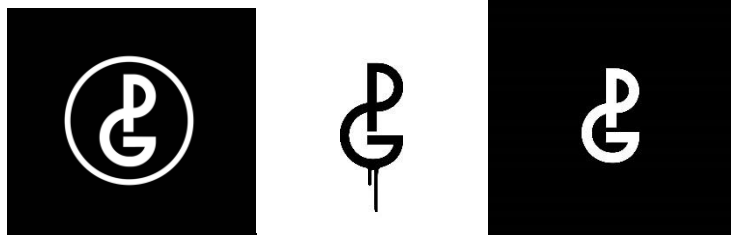


**BL O/1149/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION NOs. UK3507398 and  
UK3507412**

**IN THE NAME OF CHARLOTTE GEORGINA SKEENS  
FOR THE FOLLOWING TRADE MARKS**



**(series of 3)**

## **Parental Guidance**

**IN CLASS 25**

**AND**

**APPLICATIONS FOR RECTIFICATION**

**UNDER NOs. 84890 & 84891**

**BY MARVIN BAILEY**

1. The relevant details of the trade marks on the cover page of this decision are:

*UK3507398*

Filing date: 2 February 2020

Registration date: 19 February 2021

For class 25: Clothing

*UK3507412*

Filing date: 2 July 2020

Registration date: 9 October 2020

For class 25: Clothing

2. Applications to record a change of ownership filed on Forms TM16 for both marks were made on 23 March 2023. The applications were made by the currently recorded owner, Charlotte Georgina Skeens (“the proprietor”). The records were confirmed on 3 April 2023.

3. On 17 April 2023, an application to rectify the register was made on Form TM26R by Marvin Bailey (“the applicant”). The applicant stated that the proprietor had fraudulently transferred the trade marks into her ownership and forged Mr Bailey’s signature.

4. As the applications for rectification were made by a person other than the registered proprietor, it was necessary to serve the applications on the proprietor in accordance with rule 44(2) of the Trade Marks Rules 2008 (“the Rules”). Accordingly, on 2 May 2022 the Registry served the TM26R forms on the proprietor setting a deadline of 3 July 2023 to file submissions/evidence. The proprietor asked for an extension of time to file a response and subsequently filed an email together with evidence on 8 August 2023.

## **Evidence**

5. The applicant has made several evidence filings throughout this process. First was a letter from the applicant to the Registry (not a formal witness statement) dated 19 April 2023 together with pages from Companies House. A further letter was submitted also dated 19 April 2023 which detailed some of the alleged behaviour that had the proprietor had undertaken. The second evidence bundle includes screenshots of clothing designs and zips featuring some of the trade marks shown on the front page. There are also whatsapp extracts of discussions around design ideas. The evidence has been filed in order to prove ownership of the mark. I will not go into further detail about the evidence here for reasons that will become clear later in this decision.

6. The proprietor has filed evidence consisting of screenshots of WhatsApp message conversations purportedly with the applicant where he states to “put the logos trademarked in your name” and “u take the logo the trademark”[sic].

## **Decision**

7. Rectification of the register is provided for under section 64 of the Act. This states:

“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*

8. The applicant must have a sufficient interest to apply for rectification. The applicant was the former proprietor of the trade marks before the transfer of ownership was recorded. I therefore accept that the applicant has sufficient interest to bring the proceedings.

### *Is it an error capable of correction?*

9. Where an application is filed to record the assignment, the information provided on the Form is taken at face value. The registrar does not investigate or otherwise seek to establish the legality of the claim to change of ownership unless the recordal of change of ownership is challenged. When the ownership is challenged, it is incumbent on the proprietor to show that the contested marks were transferred to the proprietor under a valid assignment. Section 24(3) of the Act is as follows:

“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.”

10. When the proprietor filed the Form TM16, they ticked the box that indicated that an assignment had taken place. Therefore, on this basis, for the assignment to be effective, it must be in writing and signed by the assignor (or their representative).

11. The proprietor's argument appears to be reliant upon the whatsapp messages that were sent in her evidence which I have referenced in paragraph 6 above. These messages give the impression that the applicant gave permission to assign 'logos' or 'trademarks' into her name but there is no evidence any actual assignment was then subsequently signed.

12. As to whether a message from the messages themselves could form an assignment, I find that the messages are ambiguous and do not contain enough specific detail to form an accurate assignment (for example, details of the trademarks to be transferred). I note the applicant's representatives (who were appointed part way through proceedings) state in submissions that the messages are not in context, cannot be accurately dated and do not form an assignment and I am in agreement.

11. The Form TM16 is not a deed of assignment and the form itself carries a warning to parties completing it that it is not a substitute for a deed of assignment. Put simply, the Form TM16 is the notification to the Registry that an assignment has already taken place so that the Register may be updated. As I have been given no evidence that a proper assignment has taken place, I find that the trade marks cannot have properly changed ownership to the proprietor.

12. For the sake of completeness, I note that there are three other ways in which a transfer of ownership may take place which are noted on Form TM16. These are by 'court order', 'assent of personal representative' and 'company merger'. There is no court order that has been identified by the parties and they are both individuals so no company merger would apply. An assent of personal representative relates to transferring property after death and this is clearly also not applicable here.

13. One further matter that I wish to note is that there was an accusation that the proprietor forged the applicant's signature on the Form TM16. This was not the case. The proprietor had registered themselves as Mr Bailey's representative (when he was the previous proprietor of the mark). They then signed the Form TM16 as both the representative of Mr Bailey and as the new proprietor of the mark.

## **Conclusion**

14. As there is no evidence of a written assignment of the trademarks in question, the rectifications are allowed. The register is to be rectified to record Mr Bailey as the proprietor as was the position prior to the filing of the contested Form TM16.

## **Costs**

15. In relation to costs, the successful party is usually entitled to an award of costs. I note that for the most part in these proceedings, the applicant has been unrepresented. Where a party is represented, the Registrar usually awards costs on a scale published in the Tribunal Practice Notice 2/2016. As a matter of practice, litigants in person are asked to complete a costs proforma. The purpose of this is to ensure that the costs awarded do not exceed the amount spent on the proceedings. There is no right to be awarded the amount claimed. This is subject to an assessment of the reasonableness of the claim and must also take account of the Registrar's practice of awarding costs on a contributory, not compensatory, basis.

16. From reviewing the file, it appears that no costs proforma has been sent to the parties as yet. Therefore, I am reserving judgement on costs for this matter so that a costs proforma can be sent to the applicant along with this decision. I will allow the applicant 14 days from the date of this decision to submit a completed costs proforma for the work they carried out prior to the appointment of their representatives.

17. A supplementary costs decision will follow receipt of this proforma and the appeal period will be set within that decision.

**Dated this 4<sup>th</sup> day of November 2023**

**L Nicholas**

**For the Registrar**