**o/1195/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF THE FOLLOWING TRADE MARK REGISTRATION NO. UK00801346962:**


**IN CLASSES 3, 5, 35 AND 44**

**IN THE NAME OF CALEEL + HAYDEN LLC**

**AND**

**APPLICATION NO. 84901 TO RECTIFY THE REGISTER**

**BY BEAUTY BIOSCIENCES LLC**

## BACKGROUND AND PLEADINGS

1. On 18 July 2023, Beauty Biosciences LLC ("the applicant") applied to rectify the register of trade marks to remove the following services ("the contested services") from UK trade mark number 801346962 ("the contested IR"):

Class 44 Skin care salons; skin care salons featuring the use of skin care preparations, cosmetics and dietary supplements; skin care services; cosmetic skin care services, namely, skin analysis and consultation services rendered in connection therewith.

2. The contested IR has a filing date of 23 February 2017 and a registration date of 3 November 2017. It claims a priority date of 31 August 2016 from US trade mark number 87156719 for:

Class 3 Non-medicated body care products, namely, skin cleansing gels, body lotions, dusting powder; skin care products, namely, cleansing creams, bar soap, facial soaps, facial moisture and revitalizing masks, toners, face, body and hand moisturizers, skin care preparations, namely, lotions for controlling excessive oil of the skin and for absorbing oil in the skin, hand creams, cream, liquid and powder foundations, skin creams; glamour and beauty products, namely, eye shadow, eye defining pencils, eyebrow pencils, mascara, lipsticks, lipgloss, lip liner pencils, cheek colors, rouge, loose face powder; pressed face powder, facial blush, blemish concealers, skin concealers and camouflage skin concealers, and skin conditioners; non-medicated lip protector preparations; skin lighteners; beauty creams; non medicated skin care preparations; skin care preparations, namely, chemical peels for the skin; essential oils for aromatherapy use; bath salts; body creams; body oils; body scrubs; body washes; exfoliant creams for the skin; foundation; make-up removers; non-medicated skin care preparations; pre-moistened cosmetic wipes; skin care boosters, namely, concentrated non-medicated skin care preparations for treatment of a variety of skin conditions; skin cleansers; skin conditioners; non-

medicated skin creams; skin masques; skin moisturizers; body scrubs; sun block preparations; sun care lotions; sun screen preparations and non-medicated skin blemish preparations, non-medicated facial and eye serums; beauty serums.

Class 35 Retail store services and on-line retail store services featuring skin care preparations cosmetics and dietary supplements; retail store services and online retail store services and online retail store services in the field of skin care products; wholesale distributorship services in the field of cosmetics, body care products, skin care products, skin care preparations and candles; retail store and online services in the field of skin care products.

3. The contested IR was not applied for in the UK in the normal way. It is a comparable mark (IR), created in accordance with s. 54A and Schedule 2B ("the Schedule") of the Trade Marks Act 1994 ("the Act") from an international trade mark protected in the EU ("IR(EU)").

4. The applicant claims there was an error in the creation of the contested IR because within the first five years of the IR being registered, the specification of the US base application was limited to remove class 44, and hence under Article 6 of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ("the Madrid Protocol"), protection of the IR fell away for class 44. Accordingly, the applicant says that the EUIPO register "incorrectly shows the EU Designation as protected in class 44".

5. The applicant is represented by Beck Greener LLP and the proprietor (the owner of the contested mark) is represented by Murgitroyd & Company.

**EVIDENCE**

6. The applicant filed evidence from Mr Duncan Morgan who works for the applicant's professional representatives.

7. Mr Morgan's witness statement attached the following annexed evidence:

1. An extract from WIPO in relation to the International Registration ("the IR") 1346962, which has a registration date of "23.02.2017". Under the heading "Transaction History" it states that "cancellation effected for some of the goods and services at the request of an Office of origin in accordance with Article 6(4) of the Agreement or Article 6(4) of the Protocol: 2018/12 Gaz, 31.05.2018, US". It also states that "class 44 is deleted", with a date of recording of "16.05.2018".

2. A WIPO notification to the EUIPO titled "Restriction of Protection" which shows that International Registration Number 1346962 "class 44 is deleted" and the "other classes remain unchanged". I note that the "Office Reference Date of Notification" says "20180517" which I understand as meaning 17 May 2018.

3. An extract from EUIPO in relation to the IR(EU) 1346962. It shows that the mark is registered for the contested class 44 services. However, under the heading "correspondence", the fifth subject down clearly says "restrict" which is dated 31 May 2018.

8. Within his witness statement, Mr Morgan states that the UK registration derives from IR(EU) number 1346962, which is the EU designation of the IR. The IR is based on US application number 87156719, and within the first five years of the date of the IR, the US base application's specification was limited to remove class 44. Mr Morgan states that "WIPO notified the EUIPO of this restriction in a notice of 17 May 2018 which appears on the EUIPO's online file for the EU designation". I note that this is confirmed by the evidence above in the Restriction of Protection, under the Office Reference Date of Notification. However, the EUIPO did not record the deletion of Class 44 as the EU Register still shows that the mark is protected for the contested class 44 services. Mr Morgan states this error was "then copied across to the UK Register when the UK Registration was created pursuant to the Withdrawal Agreement".

9. Furthermore, I note that on 30 November 2023, Mr Morgan notified the Tribunal that a request was filed at the EUIPO to record the same correction against the IR(EU) and

the EUIPO has since updated their register to remove class 44 from the IR(EU)'s specification accordingly.

**DECISION**

10. The power to rectify the register is set out in section 64 of the Act:

> "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."

11. A party whose trade mark has been challenged on the basis of the contested mark clearly has sufficient interest to bring proceedings. In this case, the proprietor is relying

upon the contested mark to oppose the applicant's UK trade mark 3866564 under opposition number 440518.

12. The Agreement on the Withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community ("the Withdrawal Agreement") sets out at Article 56 the obligation on the UK to ensure continued protection of IR(EU)s after Brexit:

> "The United Kingdom shall take measures to ensure that natural or legal persons who have obtained protection before the end of the transition period for internationally registered trade marks or designs designating the Union pursuant to the Madrid system for the international registration of marks, or pursuant to the Hague system for the international deposit of industrial designs, enjoy protection in the United Kingdom for their trade marks or industrial designs in respect of those international registrations."

13. Part 1 of the Schedule to the Act provides as follows:

> "1.—(1) A trade mark which, immediately before IP completion day, is an international trade mark which is protected in the European Union in accordance with Article 189(2) of the European Union Trade Mark Regulation (an "existing IR(EU)") is to be treated on and after IP completion day as if an application had been made, and the trade mark had been registered, under this Act in respect of the same goods or services in respect of which the international trade mark is protected in the European Union.
>
> […]
>
> (4) A registered trade mark which comes into being by virtue of sub-paragraph (1) is referred to in this Act as a comparable trade mark (IR).
>
> (5) This Act applies to a comparable trade mark (IR) as it applies to other registered trade marks except as otherwise provided in this Schedule.

[…]

3.—(1) The registrar must as soon as reasonably practicable after IP completion day enter a comparable trade mark (IR) in the register.

(2) The particulars of the goods or services in respect of which the comparable trade mark (IR) is treated as if it had been registered must be taken from the English language version of the entry in the International Register for the corresponding (IR).

(3) Where on or after IP completion day the entry in the International Register containing the particulars referred to in sub-paragraph (2) is modified to correct an error pursuant to Rule 28, a person having a sufficient interest may apply to the registrar for rectification of the register by the substitution of the English language version of the entry for the corresponding (IR) in the International Register as modified.

(4) In this Schedule, the "corresponding (IR)", in relation to a comparable trade mark (IR), means the existing IR(EU) from which the comparable trade mark (IR) derives."

14. Article 6 of the Madrid Protocol concerns the ceasing of effect of basic applications and registrations. It reads:

"**Period of Validity of International Registration; Dependence and Independence of International Registration**

(1) Registration of a mark at the International Bureau is effected for ten years, with the possibility of renewal under the conditions specified in Article 7.

(2) Upon expiry of a period of five years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting therefrom, or of the basic registration, as the case may be, subject to the following provisions.

(3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation, in respect of all or some of the goods and services listed in the international registration. The same applies if

(i) an appeal against a decision refusing the effects of the basic application,

(ii) an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, or

(iii) an opposition to the basic application results, after the expiry of the five-year period, in a final decision of rejection, revocation, cancellation or invalidation, or ordering the withdrawal, of the basic application, or the registration resulting therefrom, or the basic registration, as the case may be, provided that such appeal, action or opposition had begun before the expiry of the said period. The same also applies if the basic application is withdrawn, or the registration resulting from the basic application or the basic registration is renounced, after the expiry of the five-year period, provided that, at the time of the withdrawal or renunciation, the said application or registration was the subject of a proceeding referred to in (i), (ii) or (iii) and that such proceeding had begun before the expiry of the said period.

(4) The Office of origin shall, as prescribed in the Regulations, notify the International Bureau of the facts and decisions relevant under paragraph (3), and the International Bureau shall, as prescribed in the Regulations, notify the interested parties and effect any publication accordingly. The Office of origin shall, where applicable, request the International Bureau to cancel, to the extent applicable, the international registration, and the International Bureau shall proceed accordingly."

15. The registration date of the IR is 23 February 2017. The specification of the US base application was restricted to remove class 44 on 16 May 2018.[1] The restriction of protection therefore took place within five years of the IR's registration date.

16. The evidence before me shows that the EUIPO had been notified of the restriction of protection on 17 May 2018; it appears to have recorded receipt of the restriction notice by 31 May 2018. However, the specification of the IR(EU) was not amended by the EUIPO before IP completion day. Had that happened, the contested IR would have been created without class 44.

17. Paragraph 1(1) of Part 1 of the Schedule requires an IR(EU) to be treated as if an application had been made and the trade mark registered under the Act "in respect of the same goods or services in respect of which the international trade mark is protected in the European Union". In this case, the comparable mark (IR) in the UK was created from, and mirrored, the EUIPO register. However, further details follow at paragraph 3 of Part 1 of the Schedule, which specifies that the details of the goods and services for which the comparable mark is to be treated as if it were registered under the Act, be taken from the International Register. Therefore the UKIPO has incorrectly taken and used the details of the IR(EU) from the EUIPO register to create the comparable mark (IR), rather than using the details of the IR from the International Register (WIPO).

18. Article 6(3) of the Madrid Protocol states that the protection resulting from an IR "may no longer be invoked" if the basic application or registration has lapsed, been renounced, rejected, revoked or otherwise cancelled. As highlighted by the evidence before me, under the transaction history of the WIPO database extract, it says: "cancellation effected for some of the goods and services at the request of an Office of origin in accordance with Article 6(4) of the Agreement or Article 6(4) of the Protocol: 2018/12 Gaz, 31.05.2018, US" and that "class 44 is deleted". Therefore, the protection resulting from the IR for the class 44 services could no longer be invoked from the date that the US base registration was limited. There was, at IP completion day, no

[1] As noted under the "Date of recording" found at paragraph 580 under the "Transaction History" of the mark on the WIPO database.

obligation under international law to protect the contested services. In turn, under Article 56 of the Withdrawal Agreement the proprietor was not entitled to continued protection in the UK for the contested services because, despite what the EU Register suggested, at IP completion day it had not "obtained protection" in the EU for those services.

19. There do not appear to be any provisions in the Schedule, or elsewhere in the Act, which allow for the possibility that the information used to create a comparable mark (IR) might have been inaccurate, such as in the present case where the incorrect details from the EUIPO register were used. There are, as a result, no specific remedies to correct such errors. Although paragraph 3(3) of the Schedule allows for the correction of an error, I do not understand this to include the ceasing of effect of a basic application or registration. The reference is to Rule 28 of the Regulations under the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks ("the Common Regulations"). This concerns corrections in the International Register. Guidance published by WIPO specifies the circumstances in which a correction may be effected.[2] It specifically excludes changes to the list of goods and services unless the error was made by the office of origin when presenting the documents to the International Bureau. There was no such mistake here. However, the Common Regulations were not intended to cover the creation of comparable marks, so the absence of a provision is not determinative.

20. The requirement that an IR(EU) be treated as if it were registered under the Act means that the provisions of section 64 apply to comparable marks (IR) as they do to a national mark. The incorrect use of the EUIPO's register details led to an error in the original entry of the contested mark in the UK register because it included services in respect of which the proprietor was not entitled to protection. The power of the registrar to correct errors or omissions in the register under section 64 is subject to the proviso "[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". The meaning of this restriction has received some attention in previous cases. In *Andreas Stihl AG & Co's Application*,

[2] *Guide to the International Registration of Marks under the Madrid Protocol,* paragraph 617.

O/379/00, Geoffrey Hobbs Q.C., sitting as the Appointed Person, considered the limits of s. 64 as follows (p.4 of the decision):

> "This Section is quite awkwardly worded. It permits rectification, but only as an exception to the general rule. The general rule is represented by the exclusion contained in the proviso to sub-section (1). That exclusion (of matters affecting the validity of the registration of a trade mark) is apparently intended to restrict the availability of rectification under sub-section (1) to errors and omissions of a kind which can properly be deemed never to have been made (unless otherwise directed) under sub-section (3). I infer that the general rule is intended to prevent circumvention of the unwaivable statutory requirements affecting the registration of a trade mark. These include the requirements of Section 38 to 40 of the Act. I think it is necessary, in order to ensure that the requirements of those sections are not circumvented, to interpret the reference to "matters affecting … validity" in the proviso to Section 64(1) quite broadly."

21. In the above case, the registry had advertised the trade mark for a specification which differed from that which had been agreed between the applicant and the registrar. The applicant applied for the register to be rectified in two respects. The first was that the published "mechanical hard operated hedge clippers" be corrected to read "mechanical and hand-operated hedge clippers". The second was the insertion of "high pressure and vacuum cleaners for industrial use", which had been omitted from the list of goods advertised. The first amendment was allowed but the second refused. Mr Hobbs concluded that the second correction related to an error affecting the validity of the registration and that section 64 could not apply because:

> "[…] the protection conferred by the Applicant's registration would be extended post-registration, by correction of the relevant omission, to goods in respect of which the trade mark has not been advertised for the purposes of opposition. According to my understanding of the purpose and effect of the exclusion contained in the proviso to Section 64(1), that is a matter affecting the validity of the registration by virtue of Sections 38 to 40 of the Act. I therefore agree with the hearing officer in thinking that the request for correction of the omission was not allowable under Section 64." (p. 5)

22. Although it was decided that section 64 did not apply because it concerned an error affecting the validity of the registration, the proposed correction raised an issue of validity because it would have added goods which had not been properly advertised for opposition purposes as required by the Act. Instead, the error was liable to correction under rule 74 of the Trade Marks Rules 2008 ("TMR") because that rule allowed the registrar to correct the irregularity in procedure by withdrawing and then re-advertising the trade mark for the correct list of goods and services.

23. The meaning of the proviso to section 64(1) was considered for a second time by Mr Hobbs, again as the Appointed Person, in *Ray Ennis v Alan Lovell (The Swinging Blue Jeans TM)*, O/148/14. This case involved a dispute between members of a band, in which Mr Ennis applied for rectification of the register on the grounds that the filing of the mark by Mr Lovell amounted to an act of misappropriation. Mr Hobbs concluded:

> "18. Sections 63 and 64 are all about the recordal of particular items of information in the Register. Section 64 enables the Registrar to change the Register by adding, altering of 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 him from adding, altering or removing information for the purpose of correcting any error or omission affecting the validity (which I take to mean the legality) of registering the trade mark to which the information relates. Since nothing can be done under Section 64 to correct such errors or omissions, 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."

24. In that case, section 64 did not apply because the objections were covered by section 3(6) and 5(4)(a) grounds which have application in invalidity proceedings because of section 47. The meaning of "validity" must have the same meaning at section 64 as it does elsewhere in the Act; the grounds for invalidity are set out exhaustively at section 47. The correction currently sought is not a correction which affects validity as covered by the grounds at section 47 (i.e. sections 3 and 5) and therefore does not concern matters which should properly be made by way of an application for invalidation. I therefore consider that the error is one capable of

correction under section 64 and that the specification should be amended to remove the contested services.

25. Further, section 64(5) reads, “The registrar may remove from the register matter appearing to him to have ceased to have effect”. There does not appear to be any requirement that an application be made by a third party before the registrar removes such material. The protection relating to the contested services had ceased to have effect by IP completion day because the contested class 44 services were removed from the US base registration on which the IR was dependent. Therefore, even if I am wrong that the error is one capable of correction under section 64(1), I would direct that the specification be corrected under section 64(5).

25. Alternatively, rule 74 TMR reads, “Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office”. In this case, as highlighted above, the UKIPO made the error of taking and using the details from the EUIPO register to create the comparable mark (IR). I consider that this is clearly an irregularity in procedure because the UKIPO should have taken and used the details of the IR from the International Register. This error is therefore also capable of correction, and I direct that the specification be corrected, under section 74.

**CONCLUSION**

27. The application for rectification has succeeded and the services listed at paragraph 1 above will, subject to appeal, be removed from the specification.

**COSTS**

28. The applicant has been successful and is entitled to an award of costs. There is no official fee associated with filing an application to rectify the register. I consider an award of £600 appropriate for filing the form TM26R and supporting evidence. I order Caleel + Hayden LLC to pay Beauty Biosciences LLC. This sum is to be paid within

21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19th day of December 2023**

**L FAYTER**

**For the Registrar**