

O-130-08

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2440671
IN THE NAME OF SEYEDEH M. MIRAHMADI (MRS)**

AND

**IN THE MATTER OF AN APPLICATION FOR RECTIFICATION NO. 83091
BY F. ILI RUATA S.P.A.**

TRADE MARKS ACT 1994
IN THE MATTER OF Registration No. 2440671
in the name of Seyedeh M. Mirahmadi (Mrs)

and

IN THE MATTER OF an application for rectification No. 83091
By F. Ili Ruata S.p.A.

BACKGROUND

1. On 6 December 2006, Seyedeh M. Mirahmadi (Mrs) ('the proprietor') applied for the following trade mark:

goccia d'oro

The trade mark was registered on 8 June 2007 under number 2440671, and stands in the name of Seyedeh M. Mirahmadi (Mrs) of 5 Glade Mews, Surrey, GU1 2FB. It is registered in respect of the following goods:

Class 29 Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats, olive oil.

2. On 20 November 2007, Venner Shipley LLP, acting on behalf of F. Ili Ruata S.p.A. ('the applicant'), filed a form TM26 (R) and accompanying Statement of Reasons seeking rectification of the register. This statement made reference to Sections 60(1) and 60(3)(b) of the Trade Marks Act 1994, and requested that the registered proprietor of registration number 2440671 be amended from Seyedeh M. Mirahmadi (Mrs) to F. Ili Ruata S.p.A.

3. On 7 January 2008 the Registrar issued a letter informing Mrs Seyedeh M Mirahmadi that an application for rectification of her registration had been received. The registered proprietor was provided with a six week period expiring on 18 February 2008 in which to submit a form TM8 and counterstatement.

4. On expiry of that period, the Registrar had not received any correspondence from Mrs Mirahmadi.

5. At the time of filing the application for rectification, F. Ili Ruata S.p.A. also filed an invalidation action against Mrs Mirahmadi. The Statement of Case which accompanied the invalidation action was broadly similar to that submitted in support of the rectification case, and the applicant's form TM26(1) was served on the registered proprietor in accordance with procedure. Although Mrs Mirahmadi did not file any defence in respect of the rectification action being determined in this decision, she *did* present a skeleton defence in response to the invalidation action.

6. This decision is solely concerned with the rectification action. Therefore, on the basis of the papers which have been presented to me, I only have submissions from

the applicant. Nevertheless, I am clearly aware of the statements made by Mrs Mirahmadi in her defence against the invalidation action, and find them to have some relevance to this decision – at least in terms of providing a more balanced context. In the paragraphs which follow, I may therefore make brief reference to facts and information which have been gleaned from Mrs Mirahmadi’s statement in defence of the invalidation.

7. Returning to the materials which *were* submitted specifically in respect of the rectification action, Venner Shipley LLP’s statement contained information which shed further light on the apparent relationship between the two relevant parties, and was accompanied by a copy of an exclusive selling and distribution licence between F. Ili Ruata (the applicant) and a company called Daria Ltd.

8. It appears that the applicant holds registrations for the mark “goccia d’oro” in Italy, Poland and Romania. The applicant has used this mark in respect of products “including edible oils and related products”, and has traded in the UK since before 2006. On 4 December 2006, the applicant entered into an exclusive twelve-month licence agreement with Daria Limited, wherein the aforementioned licensee had sale and distribution rights for the applicant’s products branded under the mark “goccia d’oro”. This licence, a copy of which was submitted with the form TM26(R), shows that the relevant signatories were Mr Luca Ruata of F. Ili Ruata S.p.A., and Mr Hossein Daryasary of Daria Limited.

9. Two days after this licence agreement was signed, on 6 December 2006, Mrs Seyedeh M Mirahmadi applied for a UK trade mark registration in respect of “goccia d’oro”.

10. At paragraph 4 of its Statement of Reasons, Venner Shipley LLP alleges that Mrs. Mirahmadi is the wife of Mr Hossein Daryasary. As the registered proprietor did not file any defence in response to the rectification action, nor dispute the claim in her formal written response to the invalidation action, I have no reason to doubt the truth of this claim. Venner Shipley LLP goes on to present its belief that Mrs Mirahmadi was acting on behalf of the licensee when she made the application.

11. Sections 60(1) and 60(3) (b) of the Trade Marks Act 1994 state the following:

“60.-(1) The following provisions apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Convention country.

(2) If the proprietor opposes the application...

(3) If the application (not being so opposed) is granted, the proprietor may-

(a) apply for a declaration...

(b) apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.

Based upon the facts of the case, I am aware that there is some distinction between the agent and the registered proprietor. Trade mark number 2440671 was applied for and registered in the name of Seyedeh M. Mirahmadi (Mrs), whilst the information supporting the application for rectification clearly shows the licensee to be Daria Limited. However, notwithstanding that fact, I have no reason to doubt the relationship between Daria Limited and Mrs Mirahmadi, and also note the proximity between the date on which the licence agreement was signed and the date on which the subsequent trade mark application was made. Taking into consideration all the facts of the case, I believe that Mrs Mirahmadi was acting on behalf of Daria Limited when she filed her trade mark application. I am therefore satisfied that she does constitute an “agent or representative of a person who is the proprietor of the mark in a Convention country” as referred to in Section 60(1).

12. If I am found to be wrong in reaching that conclusion, the fact remains that Mrs Mirahmadi still failed to submit any defence against the rectification action. Section 60(5) states the following:

“(5) Subsections (2), (3) and (4) do not apply if, or to the extent that, the agent or representative justifies his action.”

In the absence of any from TM8 and counterstatement, Mrs Mirahmadi has clearly failed to justify her action. I therefore direct that the name of the proprietor in respect of trade mark registration number 2440671 be amended. Consequently, the register will be rectified by the correction of the registered proprietor’s details to read:

**F. Ili Ruata S.p.A.
Ippodromo Del Roero, 107, 12040
Baldissero d’Alba
Italy**

13. Correction of these details will not affect the validity of the registration and I consider it right to exercise the Registrar’s discretion in this case.

14. I have already referred to the fact that F. Ili Ruata S.p.A. filed an invalidation action under Sections 47(1) and 47(2) on the same day that the rectification action was filed. As my decision has confirmed that trade mark application number 2440671 is now under the proprietorship of F. Ili Ruata S.p.A., the invalidation action has become redundant. I will therefore instruct the casework examiner to confirm via written correspondence that invalidation action number 83090 has been withdrawn.

Dated this day 6 of May 2008

**Nathan Abraham
For the Registrar
The Comptroller-General**