

TRADE MARKS ACT 1994

**IN THE MATTER OF
Registration No. 2342477
In the name of Dasema Trading Ltd
and application for rectification under
No. 82431 thereto by the
Department of Trade and Industry**

BACKGROUND



1. The trade mark  was applied for on 4 September 2003 in the name of ManNotIncluded.com Limited under number 2342477 and was registered on 9 July 2004 in respect of the following goods and services:

- Class 5: Human sperm for use by lesbian couples.
- Class 9: Mats for use with a computer mouse.
- Class 25: Articles of casual and leisure clothing, articles of outer clothing; articles of underclothing, knitted articles of clothing all for ladies.
- Class 44: Sperm-bank services for lesbian couples; counselling relating to fertility and sperm donation to lesbian couples.
- Class 45: Agency services for arranging the introduction of lesbian couples to sperm donors through an Internet based site.

2. On 14 November 2005, an application to amend the register to record a change of ownership of the trade mark was filed on Form TM16 by John Gonzalez, representing the old and the new proprietors. A date of 19 August 2004 was claimed by Mr Gonzalez as being the date which the new proprietor, Dasema Trading Limited, assumed ownership of the trade mark registration. The assignment was duly recorded in the register on 11 January 2006 and notice of it was published in the Trade Mark Journal, number 6619, on 3 February 2006. Thus the registration now stands in the name of Dasema Trading Limited.

3. On 21 February 2006, Michael Alun Hill, acting as an Investigations Officer with the Department of Trade and Industry Legal Services Directorate, filed an application to rectify the register, stating that the application for assignment was made without lawful authority.

4. As the application for rectification was made by a person other than the registered proprietor, it was necessary to serve the application on the registered proprietor in accordance with rule 34(2). This was done on 13 March 2006 to the address for service recorded on the register and it was stated in the accompanying letter that the registered proprietor would be allowed six weeks in which to file a Form TM8 and counterstatement. If none was filed, then any opposition to the application to rectification may be deemed withdrawn. The registered proprietor failed to respond and therefore the application for rectification has not been contested. Even though it is not contested, I must still be satisfied that the register does stand in error before I can allow any rectification.

EVIDENCE

5. In his witness statement of 20 February 2006, in lieu of a statement of case, Mr Hill said:

“In November 2005 I was requested to conduct a criminal investigation into certain allegations which had been made against a Mr John Emilio Gonzales, a former director of a company which traded as Man Not Included.com Limited, which entered into Creditors Voluntary Liquidation on 16 December 2004 with an estimated total deficiency of £267,880.08. The Insolvency Practitioners appointed jointly to deal with the liquidation were a Mr Andrew Andronikou and Ladislav Hornan of UHY Hacker Young, St Alphage House, 2 Fore Street, London EC2. I produce a copy of the Extraordinary Resolution to wind up the company, signed by Mr Gonzales, dated 16 December 2004, marked MAH/1.

During the course of my investigation, which is ongoing, I discovered that Man Not Included.com Limited filed an application with the Patent Office Trade Marks Registry on 4 September 2003 in respect of the Trade Mark ‘Man Not Included.com’. The application was filed on behalf of the company by Pitmans Solicitors of 47 Castle Street, Reading, Berkshire and purported to be signed by John Gonzales. The said Trade Mark was first advertised in the Trade Mark Journal number 6524 published on 26 March 2004, was registered on 9 July 2004 and that registration appeared in the Trade Mark Journal number 6542 published 6 August 2004. I produce a certified copy of the Registered Trade Mark ‘Man Not Included.com’ dated 4 January 2006 marked MAH/2, which clearly shows the proprietor of the said Trade Mark to be ‘Man Not Included.com Limited’.

When the company was Liquidated in December 2004, the existence of the Trade Mark was not shown within the summary of the company’s assets, as produced by Mr Gonzales and was not otherwise disclosed to the Liquidator, consequently it’s value could not be assessed or realised to the benefit of the creditors.

As a result of my continued enquiries with the Patent Office Trade Marks Registry, I discovered that an application had been made by Mr Gonzales, to assign the Trade Mark 'Man Not Included.com' to a company trading as Dasema Trading Limited, a company allegedly incorporated in Cyprus in May 2004. Whilst the application to assign the Trade Mark was filed on 14 November 2005, it was to be retrospective, with a date of 19 August 2004, some four months prior to the Liquidation of Man Not Included.com Limited. The application clearly shows Mr Gonzales having acknowledged himself to be a director a Man Not Included.com Limited, the then existing proprietor of the Trade Mark 'Man Not Included.com' and also a director of Dasema Trading Limited, the applicant for assignment. I produce a copy of the said application marked MAH/3.

Whilst my investigation continues in relation to other matters directly linked to the Trade Mark 'Man Not Included.com', I firmly believe from the available evidence, that the application made by Mr Gonzales, to assign the Trade Mark 'Man Not Included.com' to Dasema Trading Limited" is fraudulent. Mr Gonzales was not and could not have been a director of Man Not Included.com Limited at the time he made the application, since that company was in liquidation and as such, proprietorship of the Trade Mark passed to and remains with the liquidator as of 16 December 2004.

It is my view therefore, that there is an error in the Register of Trade Marks which should be rectified and I have submitted Form TM26R, a copy of which I produce marked MAH/4, to the Patent Office Trade Marks Registry with a view to securing that rectification. Furthermore, I do not believe that it would be in the interests of justice to make Mr Gonzales aware of the content of this, my statement, until such time as my investigation is complete and I believe that the Trade Mark should be protected in the interests of the creditors.

I produce a copy of a letter from the Joint Liquidator, Andrew Andronikou, dated 16 February 2006 in support of my application, marked MAH/5."

DECISION

6. Section 64 of the trade Marks Act 1994 deals with the rectification of the register. It reads:

"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.”

7. As a government official conducting a criminal investigation into allegations made against Mr Gonzalez and in view of the authority (MAH/5) bestowed upon him by the joint liquidators of the former registered proprietor, I consider that Mr Hill, on behalf of the Department of Trade and Industry, has sufficient interest to make the application for rectification. There appear to be no proceedings concerning the trade mark ongoing in the court.

8. The crux of the matter, from an analysis of the exhibits and the dates on which the winding up of ManNotIncluded.com Limited and the assignment occurred, is a request for rectification on the grounds that the trade mark was an asset of the company in liquidation and that Mr Gonzalez, its former director, had no possession of that company or of its assets as of the date when he made the application for assignment of the mark. For the sake of clarity, the dates are as follows:

- (i) the company was wound up on 16 December 2004
- (ii) the application to assign the trade mark was made on 14 November 2005 by Mr Gonzalez.

9. As the trade mark proprietor was the body corporate ManNotIncluded.com Limited and not Mr Gonzalez, it follows that the trade mark was the property of the company and not the personal property of Mr Gonzalez. The company passed into the control of the liquidators on 16 December 2004. Therefore, Mr Gonzalez neither owned nor controlled the company and its property after this date. The trade mark assignment was therefore made without authority. A request to record a change of ownership is made by filing a Form TM16, as Mr Gonzalez did. The information provided on the form is taken at face value and the registrar does not investigate or otherwise seek to establish the legality of the claim to change of ownership unless, as in this case, the recordal of the change of ownership, is subsequently challenged.

10. In view of the forgoing, I am prepared to accept that the register does stand in error and that it is right that the error be corrected. The error is that the assignment could not legally have been made. However, I do not agree that, as requested in exhibit MAH/5 but not explicitly on the TM26R, the register should be corrected to show the proprietor as being A. Andronikou, Joint Liquidator. A change such as that must be the consequence of a TM16 filed by whoever now owns or controls the trade

mark, which is a step further than the error which I must correct: that the TM16 filed on 14 November 2005 was invalid.

11. I therefore direct that the register be corrected; that the name of Dasema Trading Ltd shall be removed as proprietor and that ManNotIncluded.com Limited shall be substituted in its place. The effect of my decision is that the recordal of the change of ownership to Dasema Trading Ltd shall be deemed never to have been made.

Dated this 21st day of June 2006

**JC Pike
For the Registrar
The Comptroller-General**