

TRADE MARKS ACT 1994

**IN THE MATTER OF Registration No. 2285542
standing in the name of Coca CO1a Ltd**

and

**IN THE MATTER OF a request for a declaration
of invalidity thereto under No. 82289
by The Coca-Cola Company**

BACKGROUND

1. Trade mark No. 2285542 was applied for on 14 November 2001 by Coca CO1a Ltd, of Vine Street, Uxbridge UB8 1EX. The registration procedure was completed on 26 April 2002. The mark stands registered for a specification of goods reading:

“Non-alcoholic drinks; fruit drinks and fruit juices; all in Class 32.”

2. On 7 October 2005, The Coca-Cola Company applied for a declaration of invalidity against the above registration. The statement of case accompanying the application Form TM26(I) sets out the ground of action, under section 47(1)/section 3(6) of the Act, which is that the registered proprietor made the application in bad faith, asserting that there existed no such company as Coca CO1a Ltd at the time the trade mark application was made.

3. Attached to the statement of case are annexes which include details of the applicant’s earlier UK and Community trade mark registrations; details of the applicant’s UK licensed bottlers; a print-out of details of companies with similar names from Companies House; a print-out of a Post Office search for the registered proprietor’s postcode and a print-out of a Post Office search for the correct postcode for the registered proprietor’s address.

4. On 1 November 2005, a copy of the application for invalidation and the statement of case were sent to the registered proprietor’s professional representatives, Lawmark. The address used by the Trade Mark Registry was “Solent View Road, Cowes, Isle of Wight, PO31 8JZ. In the accompanying letter, it was stated that the registered proprietor would need to file a Form TM8 and counterstatement to defend the registration within 6 weeks from the date of this letter and then gave a date for receipt of 13 November 2005. It is clear that this was in error: the date specified should have been the 13 December 2005.

5. The consequences of failure to defend the registration were set out in the letter; namely, that the application for a declaration of invalidity could be granted whole or in part.

6. On 22 November 2005, the Registry wrote to both parties stating that the Form TM26(I) had been incorrectly served on 1 November 2005. It was re-served to the same address and a date of 3 January 2006 was set for receipt of Form TM8 and the counterstatement.

7. On 30 January 2006, the Registry wrote to the parties to inform them that as the registered proprietor had not filed a defence by the due date of 3 January 2006, the case would be decided on a prima facie basis by a Hearing Officer from the papers. A date of 13 March 2006 was set for the applicant to file any submissions, evidence or a request for an oral hearing. The letter to the registered proprietor was sent to the address that had been used in previous correspondence in these proceedings.

8. On 1 February 2006, Royal Mail returned to the Registry the letter sent on 30 January 2006 to Lawmark. Royal Mail had marked the envelope as “addressee unknown”. Upon inspection by Registry staff, it transpired that the address for Lawmark should have included the numeral “56”, so as to read “56 Solent View Road...”, which was the address recorded as the address for service on the Trade Mark Register. The Form TM26(I) was therefore served for a third time on 17 February and a date of 31 March 2006 was set for receipt of Form TM8 and the counterstatement to defend the registration.

9. No Form TM8 and counterstatement were received by the date set, 31 March 2006. It does not follow, however, that the uncontested nature of this action will automatically mean success for the applicant for the declaration of invalidity and failure for the registered proprietor. The onus in these circumstances is on the applicant to prove why it is that the registration should be declared invalid.

10. I am mindful of the *Firetrace* decision [2002] RPC 15, where the Hearing Officer stated:

“It is not sufficient to simply allege that a registration offends either Section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.”

11. The reason that the Hearing Officer arrived at his view is the statutory presumption of validity in section 72 of the Act which states:

“In all legal proceedings...the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transaction of it.”

12. With this in mind, on 27 April 2006, the Trade Mark Registry wrote to the applicant inviting the filing of any evidence or the making of any submission which it was felt would support the applicant’s case and, at least, establish a prima facie case. On 4 May 2006, the applicant provided a witness statement and 6 exhibits in support of its case. A hearing was not requested and this decision is, therefore, taken from the papers.

EVIDENCE

13. The applicant for invalidity filed evidence by Nicholas Christopher Alwyn Bolter of Howrey LLP, its professional representative in this matter. The evidence consists of a witness statement, dated 5 May 2006, and six exhibits. Exhibit NCAB-1 and 2 are copies of letters sent to the registered proprietor's representatives, Lawmark, by Howrey in March and August 2005, asking them to confirm that their client exists. The witness statement says that no reply was received to these letters and that the application for a declaration for invalidity was then made. It goes on to say that the applicant has licensed to a number of UK entities the right to manufacture and distribute their beverages using the applicant's registered trade marks. Details of these bottlers are given in Exhibit NCAB-3. Each of these companies has a registered office at Charter Place, Vine Street, Uxbridge, UB8 1EZ.

14. Exhibit NCAB-4 comprises print-outs from the registry of United Kingdom companies held at Companies House, showing lists of current, previous and dissolved company names in a search (I infer) for "coca". Mr Bolter asserts that these print-outs show that "there is not and has never been a United Kingdom registered company with the name Coca CO1a Limited or Coca Cola Limited."

15. Exhibit NCAB-5 is a print-out of a search performed on the Post Office website for the postcode "UB8 1EX", which is the postcode recorded on the Trade Mark Register for the registered proprietor of the trade mark in issue. The result of this search shows that this particular postcode is associated only with PricewaterhouseCoopers at The Atrium, 1 Harefield Road, Uxbridge.

16. Mr Bolter states that, apart from the postcode, the address given for the registered proprietor, Vine Street, Uxbridge, is that of a number of the applicant's licensed bottlers and that the correct postcode for this address is "UB8 1EZ". Exhibit NCAB-6 is a print-out of a Post Office website search for this postcode which shows that it is associated only with Charter Place, Uxbridge. Mr Bolter says in his witness statement that, whilst not shown in Exhibit NCAB-6, Charter Place is on Vine Street in Uxbridge.

17. Mr Bolter concludes his witness statement by claiming that the application for the trade mark was made in bad faith, giving six reasons why he considers that to be so. To my mind, the only points relevant to a pleading of section 3(6) are made at (b) and (d). These are:

"b. by use of the term "limited", the Proprietor purports to be a registered company. No such registered company exists in the United Kingdom. Use of "limited" in this way is an offence under section 34 of the Companies Act 1985;"

.....

d. the Proprietor purports to share an address with a number of TCCC's [the applicant] licensed bottlers, contrary to the fact;"

Mr Bolter cites the well-known passage describing bad faith from *Gromax*

Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367 and asserts that he considers the use of a name similar to the applicant's own name and the use of the applicant's licensed bottlers' address "suggests very strongly a dishonest purpose".

DECISION

18. Section 3(6) of the Act states:

"3.- (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

Section 47 of the Act states:

"47.- (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

....(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed."

32. - (1) An application for registration of a trade mark shall be made to the registrar.

(2) The application shall contain-

- (a) a request for registration of a trade mark,
- (b) the name and address of the applicant,
- (c) a statement of the goods or services in relation to which it is sought to register the trade mark, and
- (d) a representation of the trade mark.

(3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used.

19. Although not pleaded in the clearest of terms, it seems to me that what the applicant is asking me to do is to decide that the application for trade mark 2285542 was made in bad faith because the applicant named on the Form TM3 did not exist and therefore there was no proprietor of the mark who could have applied for the trade mark.

20. I do not take account of Exhibits NCAB-1 and NCAB-2 because non-response to the letters sent to Lawmark by the applicant's attorney does not constitute a sufficient reason to override section 72 of the Act. However, the remainder of the exhibits do, in conjunction with each other, form a picture, which to my mind, demonstrates that sufficient ground for invalidity exists. The postcode given is not that for the address given; the address given is not that of the registered proprietor, but is that for the applicant for invalidity; and the proprietor of the trade mark registration, purporting to be a UK limited company, is not recorded, as is the statutory requirement, in the

company register held at Companies House. The registered proprietor does not appear, on the face of it, to exist at all.

21. If the proprietor did not exist at the time it was entered on the trade mark application form, it could not have been capable of holding the property of a trade mark registration at the time the application was made. Against section 32(2)(b) of the Act, it must, therefore, have entered its name and address on Form TM3 fraudulently. Neither the applicant for the trade mark nor the address actually existed. If the proprietor/applicant for the trade mark did not exist, it could not have had a bona fide intention to use the mark when it signed the application form, as envisaged under section 32(3) of the Act. I therefore find that the applicant for invalidity's claim that the application for the trade mark was made in bad faith, under section 3(6) of the Act, succeeds.

CONCLUSION

22. I find that the trade mark was registered in breach of section 3(6) of the Trade Marks Act 1994 and under section 47(1), and I declare that the registration is invalid. In accordance with section 47(6) the registration shall be deemed never to have been made.

COSTS

23. The applicant has been successful and I order the registered proprietor to pay the applicant for invalidity £700. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of July 2006

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