

O-212-13

**TRADE MARKS ACT 1994
IN THE MATTER OF REGISTRATION NO. 2574985
IN THE NAME OF SCOTT CORNWALL LIMITED
FOR THE TRADE MARK**



**IN CLASS 03
AND
AN APPLICATION FOR RECTIFICATION OF THE REGISTER
UNDER NO. 84267
BY MEDICHEM INTERNATIONAL (MANUFACTURING) LIMITED**

Trade Marks Act 1994

In the matter of Registration No. 2574985

In the name of Scott Cornwall Limited

For the trade mark



In class 03

And

An application for rectification of the Register

Under No. 84267

By MediChem International (Manufacturing) Limited

Background

1. This application for rectification relates to a dispute over ownership of trade mark registration 2574985 in class 03 for hair care and cosmetic goods. The respective trade mark is displayed below:
2. The mark was applied for on 11 March 2011 by Scott Cornwall Limited (“the registered proprietor”). It was registered on 12 August 2011. On 9 January 2012, MediChem International (Manufacturing) Limited (“the applicant”) applied to rectify the register on the basis that the registration has been misappropriated by the registered proprietor and that the mark rightfully belongs to the applicant. As such, it wishes the register to be rectified to show it as the proprietor of record.
3. A decision was issued by the Trade Marks Tribunal on 29 August 2012 rejecting the application for rectification. The applicant appealed to the Appointed Person. Mr

Geoffrey Hobbs QC, issued a decision on 9 January 2013. In essence, his decision was that a procedural irregularity had occurred in that the main issue of the proceedings had not been considered, namely who commissioned and paid for the design of the SC logo? Mr Hobbs QC therefore remitted the case back to the Trade Marks Tribunal for fresh determination.

4. On 26 February 2013, I wrote to the parties indicating that, based on the claims made and the evidence filed, my initial assessment led me to the view that the matters relied upon in the application for rectification affected the validity of the registration of the trade mark and as such it was contrary to the proviso to s.64(1) of the Trade Marks Act 1994. The relevant part of this letter stated as follows:

“I note that the applicant’s case is predicated on the basis that, at the date of the application for registration, it was (at least) the beneficial owner of the copyright in the subject SC logo mark, and also the owner of the goodwill in a business carried on under that mark (amongst others). If I hold these claims to be well founded, they appear to indicate that the application for registration was contrary to s.5(4)(a) and/or 5(4)(b) of the Act. If that is so, my decision on the application for rectification will mean that the registration was at all times liable to be declared invalid under s.47(2)(b). If that is so, the application for rectification appears to be contrary to the proviso to s.64(1) of the Act, which states that:

“...an application for rectification may not be made in respect of a matter affecting the validity of the registration of the trade mark.”

5. I therefore invited both parties to make submissions on the admissibility of the application. The applicant for rectification responded and I have taken its comments into account. No response was forthcoming from the registered proprietor.

The relevant law

6. Section 64(1) of the Trade Marks Act 1994 states as follows:

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.

Section 47 is also relevant and states:

47. -

(2) The registration of a trade mark may be declared invalid on the ground-

(a)

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

7. I also bear in mind the guidance of the Appointed Person in *Commercial Power Solutions Limited v Turbochip (UK) Limited and Specialist Autosport Services Limited (BL O/112/09)* at paragraphs 42-44 which states:

“42. Having rejected the potential interest in the proceedings as assignee and beneficial owner of the Mark, the only other interest for which Turbochip UK argues is its earlier and better rights as inventor and user of the Turbochip trade marks. As Mr Elliott pointed out, this argument goes to the question of whether CPS was entitled to apply for the Mark in the first place, which is a quite different question from that of whether – having done so – it was a correctable error to record CPS rather than SAS as the registered proprietor.

43. While Turbochip UK would no doubt be keen to see its name and details substituted for those of CPS, it has not put forward any serious basis for a claim for rectification under section 64(1). Mr Gray openly conceded that it failed to apply for registered protection of the Turbochip trade marks, and there is no suggestion (akin to that made by SAS) that it stepped into the shoes of CPS after the application was made.

44. Accordingly, I agree with Mr Elliott’s submission that Turbochip UK would have to rely on another provision of the Act in order to pursue its claims. I also agree that an intervention application is not the right way to pursue them. The claims do not amount to an interest in the rectification proceedings. I therefore reject the fourth ground of appeal”.

8. Medichem’s reply to my letter of 26 February 2013 did not dispute that the proviso to s.64(1) applied. It indicated that the applicant was willing to submit an application for invalidation.
9. Bearing in mind all of the above, and as indicated in my aforementioned letter to the parties, I consider the application for rectification to be inadmissible as the matter affects the validity of the registered trade mark.
10. The application for rectification is therefore refused as it is contrary to s.64(1) of the Act.

COSTS

11. The costs in the original proceedings were set aside on appeal. Medichem achieved a measure of success on appeal, but the application was ill conceived from the outset. I therefore make no award of costs and direct that each party should bear its own costs.

Dated this 20th day of May 2013

**Allan James
For the Registrar**