

O-225-05

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 2277962
IN THE NAME OF THE LIGHT FINGERED COMPANY**

AND

**IN THE MATTER OF APPLICATION FOR A
DECLARATION OF INVALIDITY NO. 81890
THERE TO BY APPLICATION DES GAZ**

IN THE MATTER OF trade mark registration No. 2277962
in the name of The Light Fingered Company

AND

IN THE MATTER OF application for a Declaration of Invalidity
No. 81890 thereto by Application des Gaz

BACKGROUND

1. The trade marks F-LITE, F.LITE and F LITE (a series of three marks) were filed on 14 August 2001, have been registered since 26 July 2002 under number 2277962 and stand in the name of The Light Fingered Company, c/o Storage Unlimited. It is registered in respect of:

Class 11:

Torches and lights which are mountable to a persons body or clothing, including finger mountable illuminating devices.

2. On 15 October 2004, Application des Gaz filed an application for the declaration of invalidity of the registration. The action was filed on Forms TM26(I) together with the appropriate fee. The statement of grounds accompanying the application set out the ground of action, which are under sections 47(1) and 3(6) of the Act.

3. In the statement of grounds the applicant alleges that the trade marks were applied for in bad faith, the applicant claiming that the registered proprietor had no intention of using the marks; that there has been no use of the marks in relation to the goods covered by the registration; that the registered proprietor was not contactable, all mail sent being returned to sender, and appears to have ceased trading; that the registration is void ab initio for failure to provide a proper name and address of a person capable of holding the registration.

4. On 23 September 2004 a copy of the application for declaration of invalidation and the statement of grounds were sent to the address for service recorded on the register. The consequences of failure to defend the registrations were set out in the letter, namely that the applications for declaration of invalidity could be granted in whole or in part.

5. The registered proprietor did not file a counter-statement to defend his registrations.

6. It does not however follow that the uncontested nature of this action will automatically mean success for the applicant for declaration of invalidity and failure for the registered proprietor. The onus in these circumstances is on the applicant for the declaration of invalidity to make the case that the registration should be declared invalid.

7. I am mindful of the decision in the *Firetrace Case* (BL 0/278/01) 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.”

8. The reason that the Hearing Officer arrived at this view is the statutory presumption 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 transmission of it.”

9. With this in mind, on 21 December 2004, the Registrar wrote to the applicant’s representative inviting them to file any evidence or make any submission which he felt would support his client’s application to, at the least, establish a prima facie case. They were also invited to state whether they wished to be heard or would accept a decision from the papers filed.

10. On 28 January 2005 the applicant for invalidity provided evidence, with exhibits, to support the case the applicant alleged against the proprietor of the trade mark. There was no request for a hearing and the tenor of the letter was that a decision be taken from the papers filed.

11. The evidence and exhibits submitted consist of a witness statement by Alison Jane Cole, of Urquhart-Dykes and Lord LLP, dated 28 January 2005, and five exhibits. The witness statement first relates that this action has been brought following the citation of the registered mark against an international application (exhibit 1); that neither The Light Fingered Company nor its associated company Storage Unlimited are or were incorporated companies and as such no information exists at Companies House in relation to these; that a search of the internet for the company names was conducted using the Google search engine and the only relevant entry was for Storage Unlimited (exhibit 2); that a further search was carried out for the trade marks with the only references being in respect of Samsonite suitcases; that the telephone number listed on the internet proved to be a residential number in Maidstone unrelated to either of the companies, subsequently the telephone number on the internet was changed (exhibit 3); that telephone directories for the Tunbridge area were searched and no record of either company was found (exhibit 4); that from the address listed in the register there now traded a company Easistore Ltd. which, when contacted, stated that Storage Unlimited had ceased trading in July 2003, was unrelated to Easistore Ltd. and that they had no knowledge of an entity named The Light Fingered Company, the new telephone number for Storage Unlimited also proved to be Easistore Ltd. and they claimed to have acquired the number from Storage Unlimited when they ceased trading; that a search of databases of unlimited companies failed to produce any information on The Light Fingered Company but did find an entry for Storage Unlimited (exhibit 5); that the facsimile telephone number recorded in that report was contacted with a response from a recorded message that the number was not available; further enquiries indicated that it could not be conclusively proven that

incorporated bodies did not exist but the indications were that The Light Fingered Company had not traded.

- Exhibit 1 – a copy of a letter from the French agents, Germain & Maureau, dated 13 May 2004, to the Patent Office explaining that they have been unable to contact the registered proprietor of the mark in suit and the investigations they have undertaken.
- Exhibit 2 – a printout from the internet web site www.touchtunbridgewells.com, dated 16 June 2004, showing a company listed as Storage Unlimited at the address shown on the trade marks register, which shows the company categorised as providing storage services.
- Exhibit 3 – a printout from the internet web site www.touchtunbridgewells.com, dated 12 July 2004 showing a company listed as Storage Unlimited at the address shown on the trade marks register and with a different telephone number for contact.
- Exhibit 4 – copies of pages from the BT Tunbridge Wells business directory 2004/2005 with no entries for either company in the relevant sections of the alphabetical listing.
- Exhibit 5 – a copy of a “Non Ltd Report”, dated 8 July 2004, from an unaccredited source.

12. Acting on behalf of the Registrar and after a careful study of the papers before me I give this decision.

DECISION

13. The applicant claims that the registration should be declared invalid as per Section 47 of the Act on the basis of the provisions of Section 3(6). The relevant parts of the Act are as follows:

“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).

(2)

(3)

(4)

(5)

(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.”

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

14. Recent case law has indicated that bad faith is a serious allegation. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J stated at page 379:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

15. The exhibits provided by the applicant appear to demonstrate that at no time was a company registered under the name The Light Fingered Company and neither did an unincorporated body trade under that name; this has not been challenged by the registered proprietor. In my view, a prima facie case of bad faith is established because at the date the application for registration was filed, The Light Fingered Company was a not a legal entity and could therefore not claim proprietorship of the trade marks shown on the application form and the subject of the application for declaration of invalidity. The application for a declaration of invalidity made under sections 47(1) and 3(6) of the Act therefore succeeds.

16. Taking the above findings into account I declare the registered proprietor’s registration to be invalid. I direct that it be removed from the register and in accordance with Section 47(6) of the Act the registration is deemed never to have been made.

17. The applicant for invalidity has made no claim for costs and therefore I make no award in this case.

Dated this 4th day of August 2005

**Graham Attfield
For the Registrar
the Comptroller-General**