

O-333-04

TRADE MARKS ACT 1994

**IN THE MATTER OF AN INTERLOCUTORY HEARING HELD IN RELATION
TO OPPOSITION NO: 91540 BY DRINKSTOP LTD TO APPLICATION NO.
2289287 IN THE NAME OF MICHAELS FOODMARKET, MICHAELS
DRINKSTOP LTD & MICHAELS WHOLESALE LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF an interlocutory hearing
held in relation to Opposition no: 91540 by Drinkstop Ltd
to Application No. 2289287 in the name of Michaels Foodmarket,
Michaels Drinkstop Ltd & Michaels Wholesale Ltd**

BACKGROUND

1. On 4 January 2002, Michaels Foodmarket, Michaels Drinkstop Ltd and Michaels Wholesale Ltd, of Solihull, West Midlands, applied to register the following as a series of two marks:



2. Following examination, the application was subsequently accepted and published in Journal 6459 on 4 December 2002 for the following specification of services:

“The bringing together, for the benefit of others, of a variety of alcoholic beverages, crisps and lemonade, enabling customers to conveniently view and purchase those goods in a retail off licence store.”

I also note that the publication of the application carries the following two clauses:

“The applicants claim the colours blue, white, yellow and red as an element of the second mark in the series.”

AND

“Honest concurrent use with Registration Nos. 1197799 (5561,836), 2116125 (6166,2695) and others.”

3. On 4 March 2003, Laurence Shaw & Associates acting as agents for Drinkstop Ltd of Sutton Coldfield, filed opposition to the application for registration. In the statement of grounds which accompanied the notice of opposition, I note that the Opponent raises grounds of objection under section 5(2)(b), 5(4)(a), 32(2)(b) and section 3(6) of the Act. However, for the purposes of this decision, I need make no further mention of the grounds based on section 5 of the Act. The ground of opposition based on section 32(2)(b) and 3(6) are directly relevant and read as follows:

“5. The opposed application is deficient, ab initio. Section 32(2)(b) of the Trade Marks Act 1994 states that the application shall contain the name and address of the applicant. The applicant in respect of the opposed application is stated as “Michaels Foodmarket,

Michaels Drinkstop Ltd, Michaels Wholesale Ltd. It is not clear who the applicant is. "Michaels Foodmarket" is not a legal entity entitled to own property. It cannot be the proprietor of a trade mark application. In accordance with Chapter 3 of the Trade Marks Registry Work Manual, a trade mark application is personal property and to hold personal property an applicant must be capable of owning property in their own name, i.e. an applicant must be an individual or a legal person, for example a company or other corporate body. "Michaels Foodmarket" is neither an individual or corporate body such as a limited company or a business incorporated into a legal entity. Section 32(3) states that the application shall state that the 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. "Michaels Foodmarket", not being a legal entity, could not have made this statement. A non-existent applicant cannot have a bona fide intention to use nor can it use. The application was filed in bad faith. The application offends against Section 3(6) of the Trade Marks Act, 1994."

4. In an official letter dated 25 March 2003, the Trade Marks Registry served the notice of opposition on Jordans Limited who are the agents representing the Applicants for registration; they were allowed until 25 June 2003 to either file Form TM8 and counterstatement or to request cooling-off.

5. On 24 June 2003, the Applicants' agents filed Form TM8 and counterstatement. In response to the Opponent's allegations contained in paragraph 5 of their statement of grounds above, they said:

"5. The application does not offend against Section 3(6) of the Trade Marks Act 1994. The Joint Applicant "Michaels Foodmarket" is a partnership being a proper legal entity entitled to own property. In this regard the Applicant has filed form TM21 at the Trade Marks Registry requesting a change of name of the proprietor to "Mr Baldev Singh Sunner, Mr Tarlok Singh Sunner and Mr Jaskamel Singh Sunner trading as Michaels Foodmarket, Michaels Drinkstop Ltd, Michaels Wholesale Ltd". The Applicant has confirmed that there has been no change in the actual proprietorship of the application. A copy of the Form TM21 and covering letter to the Trade Marks Registry is attached at Annex B to this Counter-Statement."

6. On 1 July 2003, the Trade Mark Registry served the Form TM8 and counterstatement on the Opponent's agents; under the provisions of rule 13(7), a period expiring on 1 October 2003 was allowed for the filing of the Opponent's evidence-in-chief. The official letter to the Applicants' agent (also dated 1 July 2003), contained the following comment:

"I acknowledge receipt of the TM21 and confirmation of the change of the Applicant's name will follow shortly."

7. In response to the official letter of 1 July 2003, in a letter dated 4 July 2003, Laurence Shaw commented, inter alia, as follows:

“We submit that there are some issues, which need to be addressed before the proceedings continue. The counter-statement contains a copy of Form TM21 requesting a change to the name of the applicant, although at the date of writing it does not appear that the TM21 has been actioned by the Registry.

We submit that that request to change the details of the application as requested on Form TM21 be refused. There is no indication on the original Form TM3, copy enclosed to indicate that Michaels Drinkstop is a partnership or a legal entity of any kind. As stated in the Decision dated April 23, 2001 in Invalidity Action no. 12152, it is for an applicant to ensure that his application is in order when filed and complies with Section 32 of the Act, which states that the application shall contain the name and address of the applicant and according to Section 33 the date of filing shall be the date on which the documents containing everything required by Section 32(2) are furnished to the Registrar by the applicant.

We submit that at the date of filing the application did not meet the requirements of Section 32 of the Act, because the correct name of the applicant was not supplied and there was no indication about the legal status of “Michael Drinkstop”. Even if the Registrar allows the change, which we submit she should not, the date of filing should be amended to reflect the date on which the documents containing the information required by Section 32(2) are furnished to the Registrar.

We submit that the application is deficient ab initio and for practical purposes a nullity. According to Chapter 3 of the Trade Marks Registry Work Manual. Section 4.1(b), the name of the applicant must be the correct legal name and not a trading name or style. According to Section 6 of the same Chapter, a partnership may apply in its own name if it is a corporate body or the partners may be named. We submit that because of these deficiencies in the application, a filing date should not have been accorded.”

8. On 31 July 2003, the Trade Marks Registry wrote to Jordans noting that a Form TM21 had been filed to change the name of the Applicants. The Trade Marks Registry asked five questions; these were as follows:

“i) It is not clear whether the 3 individuals named on the TM21 are trading merely as the first applicant (Michaels Foodmarket) or all three applicants (Michaels Foodmarket, Michaels Drinkstop Ltd, Michaels Wholesale Ltd). The latter circumstances of three individuals trading as a partnership and also as two separate legal entities would not appear to make sense, however, I would be grateful for your clarification on this point.

ii) In your counterstatement you say that Michaels Foodmarket is a partnership. Can you confirm the nature of the partnership e.g. is it a partnership constituted by written agreement or is it a partnership at will?

iii) If the partnership has been constituted by written agreement are there any provisions relating to ownership of property rights, particularly in the circumstances of a change of composition of the partnership.

iv) Do you have any evidence to establish that the three individuals you now name constituted the partnership at the time of the filing of the application?

v) It would appear that the request you make is not strictly a change of name but is more akin to request to correct an error that took place when the application was filed. Do you have any information as to how this error occurred – why was the application filed in the manner it was rather than the manner you propose changing to.”

The Applicants were allowed a period of one month in which to respond to these questions.

9. In a letter dated 27 August 2003, Jordans responded to these questions in the following terms:

“(i) The three individuals named on the TM21 are trading merely as the first applicant (Michaels Foodmarket) and not as the other two applicants, Michaels Drinkstop Ltd and Michaels Wholesale Ltd which, as you state, are separate legal entities.

(ii) The partnership is at will and there is no written agreement.

(iii) As the partnership is at will there are no provisions relating to property rights.

(iv) Please find enclosed a letter from the applicant’s accountants, Doshi & Co, which confirms that the three individuals, Mr Baldev Singh Sunner, Mr Tarlock Singh Sunner and Mr Jaskamel Singh Sunner are the current partners. We can also confirm that they were the partners at the time of the application.

(v) The application was filed in the manner submitted on the instructions of the client who is a director of Michaels Drinkstop Ltd, Michaels Wholesale Ltd and a partner in Michaels Foodmarket. It appears that, when filing, the client referred to all the applicants as “their companies”, and it was not appreciated that one of the companies was a partnership. However, the amendment to the joint applicant’s name does not alter the fact that before, at the time of, and after the application the partnership existed in the form amended on the Form TM21 and that the legal status of that applicant has remained the same at all times.

It is argued therefore that the identification of the partners names does not change the status of the legal position of the applicants at the time of filing and the joint applicants were and still are entitled to hold property.”

I note that the letter from Doshi & Co dated 19 August 2003 attached to Jordan’s letter reads as follows:

“We act as Accountants to Michael’s Foodmarket Partnership. They have been trading since 1969 and the three individuals, Mr Baldev Singh Sunner, Mr Tarlok Singh Sunner and Mr Jaskamel Singh are the current Partners.”

10. The Opponent's agents were given an opportunity to respond to this letter. Their comments, which were contained in their letter to the Trade Marks Registry dated 11 September 2003, were as follows:

“1. We maintain that the application is deficient, ab initio, on the basis that there was no indication on the Form TM3 of the legal status or identity of the applicant called Michaels Foodmarket.

2. According to Section 32(2)(b) of the Trade Marks Act, 1994, an essential requirement in submitting an application is that the name and address of the applicant be supplied. According to page 5 of Chapter 3 of the Trade Marks Registry Work Manual, copy enclosed, the name of the applicant **must be the correct legal name and not a trading name or style**; Michaels Foodmarket is not the correct legal name of one of the applicants and on this basis the application is deficient.

3. It is the applicant's responsibility to ensure that the essential requirements for filing are provided - page 7 Chapter 3 of the Trade Marks Registry Works Manual, copy enclosed.

4. Furthermore, we submit that the applicants' claim that MICHAELS FOODMARKET is a partnership at will has not been substantiated. The application was accepted based on evidence of use. The evidence filed was in the form of a Statutory Declaration in the name of Mr Jaskamel Singh Sunner. In his Declaration dated May 29, 2002, copy page enclosed, Mr Sunner states that he is the **Company Secretary/Director** of Michaels Foodmarket. However, Michaels Foodmarket Ltd, the company, did not exist at the date of the application and so the application is invalid, ab initio.

5. Furthermore, we submit that this puts the admissibility of the Statutory Declaration into question and acceptance of the mark based on the evidence filed should be withdrawn.

6. In the counter-statement the applicant has filed a Form TM21 requesting in paragraph 5 a change of name of the proprietor to Mr Baldev Singh Sunner, Mr Tarlok Singh Sunner and Mr Jaskamel Singh Sunner trading as Michaels Foodmarket, Michaels Drinkstop Ltd, Michaels Wholesale Ltd. We submit that the applicant has not changed its name because the applicant or one of the applicants named on the Form TM3, ie. Michaels Foodmarket, was never defined as a legal entity, does not exist as a legal entity and cannot change its name. We submit that a change of name can only be processed when a defined legal entity changes its name; MICHAELS FOODMARKET is not a legal entity, per se.

7. According to page 5 of Chapter 3 of the Trade Marks Registry Work Manual, copy enclosed, if the filing requirements have not been met the filing date will be the date on which the office receives the documents which put the application in order.

8. If it is the case, which we do not concede, that filing the Form TM21 requesting a “change of name” completes the filing requirements, we submit that the date that the Form TM21 was filed, i.e. 24 June 2003, is the filing date.

9. In the above circumstances, acceptance of the application should be withdrawn and the application be submitted for re-examination.

10. The applicant has provided no evidence that at the date of application Mr Baldev Singh Sunner, Mr Tarlok Singh Sunner and Mr Jaskamel Singh Sunner constituted a partnership at will. The applicants' agents simply state that the three individuals are the current partners and that they were the partners at the time of the application. We submit that this is not evidence.

11. We note that in the applicants' agents submissions of August 27, 2003, it is stated that "The application was filed in the manner submitted on the instructions of the client who is a director of Michaels Drinkstop Ltd, Michaels Wholesale Ltd and a partner in Michaels Foodmarket". We reiterate that it is for an applicant to ensure that his application is in order when filed and complies with the requirements of Section 32 of the Act. The application was not in order when filed, and is deficient, *ab initio*."

11. In an official letter dated 29 September 2003, I note that the Trade Marks Registry suspended the period for the filing of the Opponent's evidence-in-chief until the matter of the Applicants' name was resolved. I deal with the consequences of this action in paragraph 31 of this decision.

12. In an official letter dated 18 November 2003, the Trade Marks Registry responded to the parties in, *inter alia*, the following terms:

"Having considered the comments by both parties, I am, in principle, prepared to action the Form TM21 filed by the applicant. I say "in principle" because before doing so I must be satisfied that at the time of filing the application that "Michaels Foodmarket" was trading as a partnership at will and that it consisted of the three named individuals identified on the Form TM21. To this end, I consider that further evidence is required to establish this point. All that has been filed thus far is a statement from the applicant's representative (at point iv of their letter) claiming that they were the partners at the time of application.

If additional evidence is filed then I will issue a further letter to both parties detailing my preliminary decision. Clearly, the opponent will be given an opportunity to be heard in the event that my preliminary decision is against them."

The Applicants' agents were allowed a period of one month from the date of the above letter to file any evidence they considered appropriate.

13. In a letter dated 17 December 2003, Jordans responded. They did so in the following terms:

"In response to your request for evidence to establish that MICHAELS FOODMARKET was trading as a partnership at will and consisted of the three named individuals identified on the Form TM21 at the time of the application, I now enclose a faxed Witness Statement signed by Doshi & Co. This states that the three individuals, Mr

Baldev Singh Sunner, Mr Tarlock Singh Sunner and Mr Jaskamel Singh Sunner were partners in the undertaking at the time of filing application no. 2289287 in Class 35.”

Attached to the letter was a Witness Statement dated 15 December 2003. It reads as follows:

“1. We Doshi & Co, 1st Floor, Windsor House, 1270 London Road, Norbury, London SW16 4DH, are accountants for MICHAELS FOODMARKET, MICHAELS DRINKSTOP LIMITED and MICHAELS WHOLESALE LIMITED. We are authorised by MICHAELS FOODMARKET, MICHAELS DRINKSTOP LIMITED and MICHAELS WHOLESALE LIMITED to make this Statement on their behalf. The information contained within this Statement is from our own knowledge or from the records of the Companies named above to which we have access.

2. MICHAELS FOODMARKET has been trading since 1969 and the three individuals, Mr Baldev Singh Sunner, Mr Tarlock Singh Sunner and Mr Jaskamel Singh Sunner have been partners in that undertaking since January 2002 and were partners at the date of application of trade mark application No. 2289287 in Class 35.

3. The facts in this Witness Statement are true.”

14. In an official letter to the parties dated 13 February 2004, the Trade Marks Registry commented thus:

“Having considered all the information and evidence put forward, it is the registrar’s preliminary view that the amendment you seek should be allowed. In answer to the objections raised by the opponent against this course of action, I would say that the allowance of your request is based on the provisions contained within Section 39(2) of the Act. Section 39(2) expressly permits the correction of the applicant’s name and address; corrections are distinct from straight forward changes of name and must therefore envisage that the name filed is erroneous, otherwise there would be nothing to correct. From the evidence put forward it is clear that there has been no actual change of proprietorship, the correction merely regularises the formal name of the applicant as it stands on the form of application and how it will stand, if the mark succeeds in registration, on the register.”

A period of one month was allowed for the Opponent to request a hearing; this period was subsequently extended to 20 March 2004.

15. In a letter dated 22 March 2004, Laurence Shaw & Associates requested a hearing. They also provided the following comments:

“1. The applicant has never requested amendment of a clerical error, only a change of name.

2. On November 18, 2003, the Registrar requested further evidence, to be satisfied that at the time of filing the application Michaels Foodmarket was trading as a partnership at

will and that it consisted of the three individuals identified on the Form TM21. The evidence submitted consists of a Witness Statement in the name of Doshi & Co. We submit that the Witness Statement is inadmissible. According to our understanding a Witness Statement must be signed by an individual who can be cross examined and must be expressed in the first person. Furthermore, a Witness Statement must contain a statement that the witness believes that the facts stated in it are true.

We further submit that the applicant has had since June 2003 in which to deal with this matter and yet it has still not been resolved. In the circumstances, we request that an award of costs be made at this stage.”

THE INTERLOCUTORY HEARING

16. On 20 May 2004, an interlocutory hearing took place before me to consider the Applicants’ request. At the hearing, Mr Bill Tennant of Jordans represented the Applicant for registration; the Opponent was represented by Mrs Anne Roome of Laurence Shaw & Associates.

THE SKELETON ARGUMENTS

17. For the most part, the respective parties skeleton arguments contained a rehearsal of the arguments already provided in correspondence. However, as they were both relatively brief and contained some points of clarification, and for the sake of completeness, I have reproduced them below in full.

The Applicants’ skeleton argument

“1. The Applicant contends that the application does not offend against Sec. 3(6) of the Act. Section 32 Provisions have been met by the Applicant and the Registry have accepted this. “Michaels Foodmarket” is part of the Applicant’s name and the partners existed before, at the time of, and after the application was filed.

2. Form TM21 submitted by the Applicant merely regularised the position and confirmed that there had been no change in the Applicant’s legal status.

3. PAN 2/04 accepts that applications can be made in the partnership name; the Applicant has simply regularised the position of the Applicant by including the partners’ names.

4. We submit that the Witness Statement submitted in the name of Doshi & Co. is acceptable and this has been confirmed by its acceptance by the Registrar.

5. In summary, therefore, we do not believe that the Opponent has a justified case and further submit that the interlocutory hearing is unnecessary in the light of the Registrar’s decision and accepted practice.

6. The Applicant therefore requests that an award of costs be made in respect of attendance and preparation for the hearing.”

The Opponent's skeleton argument

“1. The Hearing is in respect of the Registrar's preliminary decision to allow the amendment of the name of the applicant under Section 39(2) of the Trade Marks Act, 1994, in the official letter of February 13, 2004. The Opponent submits that if such an amendment is allowed that the date of the application be amended to the date on which all the information required by Section 33 of the Act was provided.

2. The application was filed on January 4, 2002, in the name of “Michaels Foodmarket, Michaels Drinkstop Ltd, Michaels Wholesale Ltd (3 Applicants)”. Michaels Foodmarket per se does not exist as a legal entity.

3. Section 32 sets out the basic requirements of an application in order for it to achieve a filing date. It reads as follows:

4. 32(1) An application for registration of a trade mark shall be made to the registrar.

32(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

5. Section 33 of the Act states that the date of filing of an application for registration of a trade mark is the date on which documents containing everything required by Section 32(2) are furnished to the registrar.

6. It is the responsibility of the applicant to ensure that the application form is completed correctly.

7. The application was accepted based on evidence of use. The evidence of use was filed in the form of a Statutory Declaration in the name of Mr Jaskamel Sing Sunner who declared on May 29, 2002, that he is a Company Secretary/Director of Michaels Foodmarket and throughout the Declaration he refers to his companies. On this basis one would conclude that Michaels Foodmarket is a registered company. No such company exists.

8. On June 24, 2003 the applicants filed a TM21 requesting that the name of the applicant be amended to Mr Baldev Singh Sunner, Mr Tarlock Singh Sunner and Mr Jaskamel Singh Sunner, trading as Michaels Foodmarket, Michaels Drinkstop Ltd, Michaels Wholesale Ltd.

9. Still the identity of the applicants was uncertain. The official action of July 31, 2003 queried the identity of the applicants and requested evidence.

10. On August 27, 2003, the applicants stated that the three individuals are trading as the first applicant, Michaels Foodmarket, a partnership at will.

11. Evidence of existence of partnership at will at date of application requested by official action of November 18, 2003. On December 17, 2003, the applicants filed a faxed Witness Statement in the name of Doshi & Co. The Witness Statement is not acceptable, because it is not in the first person. The Statement has been accepted by the Registrar as evidence on February 13, 2004.

12. We submit that if any amendment be allowed under Section 39(2) of the Act, then the date of the application be amended to the date on which all the information concerning the name of the applicants is supplied to the Registrar. (Decision no. 0-048-04 dated February 3, 2004 in Opposition no. 80556)."

THE DECISION FOLLOWING THE INTERLOCUTORY HEARING

18. My decision at the hearing was communicated to the parties in a letter dated 21 May 2004, the relevant portion of which is reproduced below:

"Having considered the parties skeleton arguments together with the oral submissions at the Hearing, my decision was to confirm the Trade Marks Registry's Preliminary View contained in the Official letter of 13 February 2004, and in so doing, to allow the Applicants (under the provisions of Section 39(2) of the Trade Marks Act 1994) to correct the name of the first Applicant Michaels Foodmarket to include a reference to its status as a Partnership.

I explained that I would allow Mr Tennant a period of **one month** (to run concurrently with the period allowed to request written grounds), to file a revised Witness Statement from Doshi & Co on the basis discussed at the Hearing, and also to consider whether, given the guidance provided in Practice Amendment Notice 2/04, he wishes to file an alternative version of the Form TM21. Having heard submissions, I made no order as to costs.

This letter does not contain a full statement of reasons for my decision. If either party wishes to appeal the decision they should file a Form TM5 requesting a statement of reasons, together with the required fee (£100) **within one month of the date of this letter.** If at the conclusion of this period no request is filed, I will, as indicated at the Hearing, arrange for the Trade Marks Registry to strike out paragraphs (5) of both the Statement of Grounds and Counterstatement and a new period of three months for the filing of the Opponents' evidence-in-chief will be set."

19. In response to my letter mentioned above, in a letter dated 18 June 2004, Jordans commented:

“As requested at the Hearing, a revised Witness Statement from Doshi & Co is now forwarded to you and has been completed as agreed at the Hearing. An amended version of the form TM21, to comply and regularise the situation in accordance with Practice Amendment Notice 2/04 is also submitted.”

The Witness Statement referred to above and dated 17 June 2004, reads as follows:

“1. I, Shilpa Doshi, am the Sole Proprietor in Doshi & Co, 1st Floor, Windsor House, 1270 London Road, Norbury, SW16 4DH. I am an accountant for MICHAELS FOODMARKET, MICHAELS DRINKSTOP LIMITED and MICHAELS WHOLESALE LTD. I am authorised by MICHAELS FOODMARKET, MICHAELS DRINKSTOP LIMITED and MICHAELS WHOLESALE LIMITED to make this statement on their behalf. The information contained within this Statement is from my own knowledge or from the records of the Companies names above to which I have access.

2. MICHAELS FOODMARKET has been trading since 1969 and the three individuals, Mr Baldev Singh Sunner, Mr Tarlock Singh Sunner and Mr Jaskamal Singh Sunner have been partners in that undertaking since January 2002 and were partners at the date of application of Trade Mark application no. 2289287 in Class 35.

3. The facts in this Witness Statement are true.”

I note that this Witness Statement contains Mr Doshi’s personal signature. The re-filed Form TM21 (at paragraph 4) has been re-worded as follows:

“ Mr Baldev Singh Sunner, Mr Tarlok Singh Sunner and Mr Jaskamel Singh Sunner Trading as Michaels Foodmarket (a partnership), Michaels Drinkstop Ltd, Michaels Wholesale Ltd.”

20. In a letter dated 21 June 2004, Laurence Shaw & Associates on behalf of the Opponent filed Form TM5 requesting a written statement of the grounds of my decision. I give this decision below.

GROUND OF DECISION

21. The sections of the Trade Marks Act 1994 which are relevant to my decision in these proceedings are reproduced below.

“**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.

(4) The application shall be subject to the payment of the application fee and such class fees as may be appropriate.

33. - (1) The date of filing of an application for registration of a trade mark is the date on which documents containing everything required by section 32(2) are furnished to the registrar by the applicant.

39. - (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

If the application has been published, the withdrawal or restriction shall also be published.

(2) In other respects, an application may be amended, at the request of the applicant, only by correcting-

(a) the name or address of the applicant,

(b) errors of wording or of copying, or

(c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

(3) Provision shall be made by rules for the publication of any amendment which affects the representation of the trade mark, or the goods or services covered by the application, and for the making of objections by any person claiming to be affected by it."

In these proceedings, I note that the Opponent has relied upon, inter alia, various comments appearing in Chapter 3 of the Trade Marks Registry Work Manual (published in August 2002) which relates to the filing of new trade mark applications. For their part, the Applicant relies upon, inter alia, the content of Practice Amendment Notice 2 of 2004 entitled; "Trade Marks owned by partnerships".

22. The sections of Chapter 3 which are relevant for present purposes read as follows:

"4. Preliminary check of the application form

Every application is checked to ensure that it meets the requirements for filing stated in the Act and Rules. Some requirements are essential in order to obtain a filing date, others are not essential for filing date purposes but must still be met before an application can be sent on to examination. If the requirements have been met, the filing date is the date of receipt of the application. If the filing requirements have not been met, the filing date will be the date on which the Office receives documents which put the application in order.

4.1(b) the name and address of the applicant

The name and address of the applicant (who becomes the “proprietor” once the mark is registered) must be supplied. The name of the applicant must be the correct legal name (particularly in the case of companies) and not a trading name or style.

5. Other queries or objections raised at new application stage.

.....; it is the responsibility of the applicant to ensure that the application form is completed correctly.

6. The applicant

A registered trade mark and an application for registration are both personal property (Sections 22 and 27 refer). To hold personal property an applicant must be capable of owning property in their own name. This means an applicant must be an individual or a legal person, for example, a company or other corporate body.

No investigation is made of an applicant’s entitlement to hold property in their own name, but there may be occasions when it is necessary to question whether an application is made in the name of a legal person. The following guidelines are used when considering whether it is necessary to question the legal standing of an applicant:

Partnerships

A partnership may apply in its own name if it is a corporate body or the partners may be named. Listing the names of the partners means that any subsequent change in that list is a change of ownership which must be recorded as an assignment (Form TM16 and appropriate fee). Note that, for operational purposes, we will record no more than four partners.”

23. Practice Amendment Notice 2 of 2004 reads as follows:

“Trade marks owned by partnerships

Background

It has long been Registry practice only to record partnerships as applicants or proprietors of trade marks if the partnership is a corporate body, or if some or all partners are listed. In a recent High Court case *SAXON TRADE MARK [2003] FSR 39*, Mr Justice Laddie

held that a group of musicians constituted a 'partnership at will' and that the name and goodwill were assets of the partnership rather than the personal property of the individual members of the group. It would seem to follow that an application to register the trade mark SAXON could have been made in the name of the partnership which owned the common law rights under that name. We have reviewed our practice in the light of this case.

New practice

In future we will allow partnerships (including 'partnerships at will') to be recorded as applicants for, or proprietors of, trade marks. If the applicant or assignee is a partnership, we will require that this be stated in the application, after the name of the partnership, for example, 'Boggles (a partnership)'.

It will be for applicants and their advisors to decide whether the names of the individual partners should also be included in the application. Where there is no agreement covering the ownership of the partnership's intellectual property assets, a change in the composition of the partnership may mean that the intellectual property rights of the original partnership may have to be assigned. Given that the name of the partnership may not change, such an assignment may be more straightforward if the composition of the partnerships is also recorded. Accordingly, where there is no relevant agreement it is advisable to include the names of the partners in any application to register or take assignment of a registered trade mark. Where they are included, the names of the partners should be listed immediately after that of the partnership, for example, 'Boggles, a partnership of John Doe, Tom Cobley and Mickey Finn'.

It is the responsibility of applicants and their legal advisors to ensure that an organisation named as applicant or proprietor in an application or assignment is capable of owning property and is recorded in an appropriate manner. Otherwise there is a risk that the application or assignment may not be valid. We do not intend to, as a matter of course, look behind applications to check the status of the applicant or assignee. We will ask for clarification where the name of the applicant or assignee creates an obvious doubt as to whether it can hold property. However, if the person filing the document confirms that the applicant or assignee has the necessary standing and is accurately described, this will usually be accepted.”

24. Sections 32 and 33 of the Trade Marks Act 1994 govern the manner in which new trade mark applications are filed. In the context of these proceedings, there is no dispute that when the application for registration was filed, it complied with the statutory requirements outlined in section 32(2) sub-paragraphs (a), (c) and (d). Equally there is no dispute that the second and third joint applicants i.e. Michaels Drinkstop Ltd and Michaels Wholesale Ltd are properly defined legal entities and as such are free from objection.

25. Similarly there is no dispute that the guidance contained in Chapter 3 of the Trade Marks Registry Work Manual is correct, save for the fact that the Trade Marks Registry's practice in relation to Partnerships was modified by Practice Amendment Notice 2 of 2004 following the

decision of Mr Justice Laddie in *Saxon Trade Mark* [2003] FSR 39. It is section 32(2) sub-paragraph (b) i.e. the name and address of the applicants which is at the heart of the dispute in these proceedings.

26. If one reviews the chronology of these proceedings, it is clear that the application for registration was originally filed on 4 January 2002 in the name of Michaels Foodmarket, Michaels Drinkstop Ltd and Michaels Wholesale Ltd because the Applicants' agents acted upon instructions from their client, who referred to all three applicants as "their companies". At the time of filing the application, it was not appreciated by the agents that one of the so called "companies" i.e. Michaels Foodmarket was in fact a partnership at will; this led to an error in filing. In response to this error, the Trade Marks Registry indicated that it was prepared "in principle" to action the Form TM21 and correct the Applicants' name if it could be established that Michaels Foodmarket was trading as a partnership at will and that at the time of filing the application it consisted of the three individuals mentioned.

27. In response to these questions the Applicants' agent filed the first Witness Statement of Doshi & Co dated 15 December 2003. Unfortunately this Witness Statement was incorrectly drafted and should not have been accepted by the Trade Marks Registry. At paragraph 7.1.1 of its own draft Law Section Manual, the Trade Marks Registry provides guidance on the form and content of Witness Statements referring specifically to the Civil Procedure Rules Volume 1, Part 32, Rule 3.8 and Practice Directions 32PD.17 to 32PD.23 inclusive. In particular I note that the draft manual says:

"A Witness Statement must be made by a person or persons, it cannot be made in the name of a company..."

28. Unaware of this procedural error, the Trade Marks Registry indicated in its letter to the parties dated 13 February 2004, that the request to amend the application should be allowed. The basis for this decision being that in the circumstances of these proceedings, correction of the Applicants' name was permissible under the provisions of Section 39(2)(a).

29 Section 39(2) generally and sub-paragraph (a) in particular, allow for an application to be amended at the request of the Applicants but only by correcting, inter alia, the name and address of the Applicants. In my view, subject at the time of the hearing to correction of the witness statement of Doshi & Co (which has now been filed and is acceptable), the approach the Trade Marks Registry adopted was correct. It has now been established that the entity Michaels Foodmarket was at the time of filing the application for registration a partnership at will comprising Mr Baldev Singh Sunner, Mr Tarlok Singh Sunner and Mr Jaskamel Singh Sunner; in addition, there has been no change of proprietorship of the application. The filing of the application in its original form i.e. in so far as Michaels Foodmarket was concerned, was the result of an error which occurred at the time of filing the application and resulted from a misunderstanding which occurred between the Applicant and their agents. In these circumstances, the error is one, in my view, which is correctable under the provision of Section 39(2)(a) of the Act.

30. Finally, I should mention here that both in correspondence and in their skeleton argument, the Opponent's agents comment on the wording of the Statutory Declaration filed by the Applicants during the ex parte prosecution of the application for registration. Whilst I note that Mr Jaskamel Singh Sunner referred to himself in his Declaration of 29 May 2002 as "Company Secretary/Director of Michaels Foodmarket, Michaels Drinkstop Ltd and Michaels Wholesale Ltd" and also referred to "my companies", this resulted from the initial error made when the application was filed and must, in my view, be considered in that context.

CONCLUSION & NEXT STEPS

31. In view of my findings above, I have concluded that:

- as a result of a misunderstanding between the Applicants and their agent, the application for registration filed on 4 January 2002 named Michaels Foodmarket without further qualification;
- it has now been established that at the date of filing the application for registration, Mr Baldev Singh Sunner, Mr Tarlok Singh Sunner and Mr Jaskamel Singh Sunner were trading as a partnership at will under the name Michaels Foodmarket;
- there has been no change in proprietorship of the application;
- the error which occurred at the time the application for registration was filed is correctable under the provisions of Section 39(2)(a) of the Trade Marks Act 1994;
- in the event of no appeal against this decision within the period allowed, the Trade Marks Registry should (i) action the Form TM21 mentioned above, (ii) strike-out paragraphs 5 of both the statement of grounds and counterstatement, and (iii) under the provisions of Rule 68(1)(b) i.e. "on the initiative of the registrar" set a new period of three months for the filing of the Opponent's evidence-in-chief.

Dated this 8th Day of November 2004

**C J BOWEN
For the Registrar
The Comptroller-General**