

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NOS 2140143A and B
OF THE TRADE MARKS :**

GOLF COURTS

AND



IN THE NAME OF JOHN DE VERE

**AND THE CONSOLIDATED APPLICATIONS FOR RECTIFICATION OF THE
REGISTER UNDER NOS 11445 AND 11446
BY FAREL BRADBURY**

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Background

1) On 10 February 2000 Farel Bradbury applied for the rectification of the register in respect of registration nos 2140143A and B. The trade marks are shown above. These registrations were applied for and stand in the name of John De Vere. They were applied for on 25 July 1997 and registered on 14 October 1998 in respect of the following goods and services in classes 16, 28, 35, 37, 41 and 42 respectively:

*golf related printed matter being score cards and booking forms
golf equipment and accessories; golf course equipment and accessories
business management of golf courses
golf course construction; golf course club house construction
management of golf courses
golf course design; golf course club house design*

Mr Bradbury requested that the register should be rectified to show him as the proprietor of these trade marks.

2) Decision numbers BL 0/342/01 and BL 0/343/01 were issued in respect of the applications for rectification. At an appeal hearing before the appointed person the decisions were set aside and the cases referred back to the registrar (decision BL 0/056/02). The appointed person stated that a preliminary hearing should be held in order for the issues to be clarified and directions given for the amendment of pleadings and the filing of further evidence.

3) A preliminary hearing was held on 19 March 2002. I was the hearing officer at that hearing. At that hearing it was agreed that the two actions should be consolidated. The following grounds for rectification were agreed:

- Under section 60 of the Trade Marks Act 1994. The registered proprietor being, or having been, the agent or representative of the applicant and the applicant being the proprietor of the trade marks in the following Convention countries: USA, Republic of Ireland, Australia, Japan, Spain, France, Austria, Germany and Italy.
 - In the alternative under section 64 of the Trade Marks Act 1994 the applicant being the proprietor of the trade marks and the registered proprietor being, or having been, his agent or representative, the registration in the name of the registered proprietor being an error.
 - The redress sought is that the applicant's name shall be substituted for that of the registered proprietor and an award of costs.
- 4) The registered proprietor denied the grounds for opposition and sought an award of costs.
- 5) Dates were set for the filing of further evidence by the parties. Both parties filed further evidence.
- 6) The matter came to be heard on 21 August 2002 when Mr Bradbury and Mr De Vere appeared before me. Neither had professional legal representation.

Decision

- 7) The grounds for rectification are under sections 60 and 64 of the Act.
- 8) Section 60 of the Act states:
- “60.-(1) The following provisions apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Convention country.
- (2) If the proprietor opposes the application, registration shall be refused.
- (3) If the application (not being so opposed) is granted, the proprietor may -
- (a) apply for a declaration of the invalidity of the registration, or
- (b) apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.
- (4) The proprietor may (notwithstanding the rights conferred by this Act in relation to a registered trade mark) by injunction restrain any use of the trade mark in the United Kingdom which is not authorised by him.

(5) Subsections (2), (3) and (4) do not apply if, or to the extent that, the agent or representative justifies his action.

(6) An application under subsection (3)(a) or (b) must be made within three years of the proprietor becoming aware of the registration; and no injunction shall be granted under subsection (4) in respect of a use in which the proprietor has acquiesced for a continuous period of three years or more.”

9) Section 55(1) of the Act defines a Convention country. It states:

“55. - (1) In this Act-

(a) “the Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20th 1883, as revised or amended from time to time, and

(b) a “Convention country” means a country, other than the United Kingdom, which is a party to that Convention.”

10) Section 64 of the Act states:

“(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.”

11) In his evidence Mr Bradbury spends some time dealing with the concept of GOLF COURTS and patent applications in relation to this concept. The issue before me relates to the ownership of the trade marks in suit, not a concept or patent. In my consideration of the evidence I will focus, therefore, upon the trade mark issue. I will, however, give a brief description of the concept, gleaned from a patent application that is to be found at page 280 of exhibit FB1 to the first affidavit of Mr Bradbury:

“A golf course for playing a game of 18 holes, comprises a small number of tees (1-8) and a small number of greens (A-D) arranged so that any of a plurality of different rounds of 18 holes may be played, with the lines of play (L) of the different holes in any selected round crossing each other. Thus, a game of golf can be played, fully comparable to that played on a conventional 18 hole golf course, but the course occupies substantially less land.”

12) The point of the concept is that a game of golf can be played on considerably less land than is required for conventional courses.

13) Mr Bradbury designed a compact golf course in 1988. He states that from 1991 onwards he has sought to “develop and to exploit commercially all forms of the intellectual property contained in the concept”. I have quoted this directly from the affidavit of Mr Bradbury as it is representative of a problem which I have experienced in dealing with this case. The vagueness of the use of the term intellectual property and in particular the lack of clarity in relation to trade mark use and ownership. Mr Bradbury met Mr De Vere in May 1992 and authorised him to negotiate business opportunities on his behalf.

14) The evidence shows that Mr Bradbury devised this type of golf and that Mr De Vere came along afterwards and wished to promote and develop this game. Mr Bradbury was using the term GOLF COURT from 1993, see page 10 of exhibit FB1 to his first affidavit. Reference to the term can be seen in many documents that Mr Bradbury has exhibited eg at pages 29a,, 32a, 34, 35a of exhibit FB1. The first document referred to is dated 22 January 1993. Exhibited to the statement of Mr De Vere is a statement by Terry Howard. In this statement Mr Howard states that at a meeting with Mr De Vere to discuss this new concept in golf course design the name GOLF COURTS was mentioned. This meeting took place in January 1993. Mr Bradbury has exhibited various documents in relation to the concept from prior to 1993. None of these use the term GOLF COURTS. The concept is referred to as HYDATUM GOLF. In the exhibits that Mr Bradbury has furnished GOLF COURT for the most part is not used in a trade mark sense – not as an indicator of origin - rather in a descriptive sense. The trade marks that Mr Bradbury appears to be using are HYDATUM and a crown device, the latter followed by the letters TM. I take the example of the letter exhibited at 59e of FB1. This emanates from 1996. At the top left hand sign of the letter head is an arrow device and the words “by HYDATUM DESIGN”. On the right hand side of the letter head is a crown device followed by letters TM. In the centre are the words GOLF COURTS in a slightly fancy script. Underneath this is the logo of GOLF COURTS INCORPORATED. In the letter

the term GOLF COURT is regularly used in what strikes me as a purely descriptive sense eg:

“An overview of the design factors for selecting the best golf court for any site.”

“To provide a fast design service, a computer generated Outline of each golf court is produced from a provisional.....”

“...only a guide to a future design and do not accurately portray the golf court.”

15) I do not believe that the average consumer would see the usage as being to indicate origin, ie trade mark usage. However, the GOLF COURTS INCORPORATED logo smacks very much of a trade mark and trade mark usage. GOLF COURTS INCORPORATED according to page 72b of exhibit FB1 is a company incorporated under the law of the British Virgin Islands.

16) Even in his affidavit Mr Bradbury uses GOLF COURTS in the manner of a descriptor rather than as a trade mark eg:

“On the 1st August 1996 I reached provisional agreement with John Sale, who wished to pursue his idea of three games playing in succession on a single (broadened) golf court..... Golf Courts Incorporated (GCInc), launched their golf court project.”

17) Also in his affidavit Mr Bradbury states:

“I produced on 22nd January 1993, for a small group of business people interested in developing this concept and other, unrelated, IPR of mine a memorandum in which I stipulated the term

GOLF COURT

was to be used for this project. It should be noted in this connection that the prefix “Hydatum”, subordinate in that memorandum, qualified the design source as for, example, in “*Gucci* SUN GLASSES”.

18) Mr Bradbury is stating that HYDATUM is the indicator of origin, the trade mark; GOLF COURT is on a par with sun glasses and so is simply a descriptor. Mr Bradbury’s own words advise that he was not using GOLF COURT as a trade mark or even conceiving of it as such. Reading the document that Mr Bradbury refers to, exhibited at pages 29a-c of FB1, the use of GOLF COURTS cannot be seen as representing trade mark use. As stated by Mr Bradbury in his Gucci example, HYDATUM is the trade mark.

19) There are many other examples that I could refer to. In the document exhibited at FB1 page 41 and dated 16 March 1994 all references are to HYDATUM GOLF. At FB1 page 56a et seq is a document which would seem to emanate from July 1995. This document refers to “Range, Social or Party Golf” and uses the term GOLF COURT throughout in a non-trade mark context.

20) In his affidavit Mr Bradbury states that Golf Courts Incorporated launched their golf court project in Dublin on 17 December 1996. He states that he attended the event and that he was granted shares in the company. Mr Bradbury states that he had an agreement with Golf Courts Incorporated and that his agreement with them clearly includes “trade marks extant, latent or proceeding as defined intellectual property”. I am at a loss to understand what a “latent” trade mark is or can be. The brochures exhibited at JDV2-6 of the statement of Mr De Vere of 16 July 2002 show the use of a GOLF COURTS logo. There is no indication that this logo is other than the property of the producer of the brochures, which depending on date are variously Golf Courts International Limited, Golf Courts Incorporated and Compac Golf Ltd. In the brochures exhibited at JDV2 and 3 Mr Bradbury is identified as the deviser of the concept but he is not identified as the owner of the trade mark GOLF COURT in any form. In various documents furnished by Mr Bradbury reference is made in proposed agreements to the intellectual property rights eg pages 72b and c of FB1. Here the intellectual property is defined in the following terms:

“All and any intellectual property including design (registered or unregistered), copyright (written and electronic), patents, trade marks extant, latent or proceeding from future developments, design activities or business arrangements.”

21) There is no clear definition of the intellectual property rights. There is no identification, for instance, of one specific trade mark. The wording is so vague as to make the definition effectively valueless. I have read through all the various agreements and can find no clear identification of GOLF COURTS as a trade mark of Mr Bradbury. At the hearing I asked Mr Bradbury if he could identify anywhere in the proposed agreements he exhibited where GOLF COURTS was identified as a trade mark. He was unable to do so. The impression that I have formed is that Mr Bradbury saw GOLF COURTS as a trade mark, and in his view his trade mark, only in hindsight; after his relationship with Mr De Vere had ended and the latter was continuing to be involved in marketing and developing the concept that Mr Bradbury had come up with. Of course, this does not preclude GOLF COURTS having been used by Mr Bradbury as a trade mark without conscious intention. This, however, is certainly not the conclusion that I reach based upon the evidence before me.

22) Mr Bradbury refers in his affidavit to Golf Courts Incorporated as having been licensed to use the trade mark(s). He does not specify what this trade mark or these trade marks are. I can find nothing in the agreement which supports the claim that the trade marks in suit were subject to any license agreement. The agreements which Mr Bradbury has adduced into the proceedings revolve very much around the marketing of the concept behind GOLF COURT. The undertakings that have used GOLF COURTS in a trade mark context are those with which Mr De Vere has been involved and none of which were under the control of Mr Bradbury. Such use can be seen in the brochures exhibited at JDV2-6. It is not clear who coined the phrase GOLF COURTS. The statement of Mr Howard is not clear in relation to this. In his witness statement of 17 May 2002 Mr Bradbury refers to his coining the term GOLF COURT, this is unsubstantiated by

evidence. In the end I am not convinced that the issue of who first coined the phrase is particularly relevant, especially as it is unproven. In the context of these proceedings what is important is who was using GOLF COURTS in a trade mark context. It is clear to me that the first persons to use GOLF COURTS in a trade mark context was the company Golf Courts International Limited who used the words as part of their logo in the brochure exhibited at JDV2. Mr Bradbury states that Golf Courts International, which I have assumed is one and the same, was a company that was formed and the title of the company was his trade name. However, there is no evidence to show that this was a trade name of Mr Bradbury. His statement does tell me however that the GOLF COURTS trade mark was being used by a separate legal entity.

23) Mr Bradbury refers in his affidavit to his having continued to exploit the golf court concept. This is not the same as having rights to the trade mark or having used the trade mark GOLF COURTS. He refers to two domain names that he owns both incorporating the word GOLFCOURTS. However, he states that he was the proprietor of these from September 1998, over a year after the filing of the registrations in suit. This does not show first use of GOLF COURTS as a trade mark by Mr Bradbury. It is also to be noted that Mr Bradbury has not supplied substantiation of this claim. There are no documents exhibited in relation to this and no web pages to show the nature of the Internet use; or indeed if there has been any actual use on the Internet. It could be that he has registered the names but has not set up a web site.

Section 60

24) To benefit from the provisions of section 60 Mr Bradbury must have made his applications for rectification within three years of becoming aware of the registrations. The applications were made within three years of the dates of registration. This element of the requirement is, therefore, satisfied.

25) Mr Bradbury has to establish that he was the owner of a trade mark in a Paris Convention country. There is nothing in the Convention that states that the ownership has to be of a registered trade mark. However, where the claim is based on a non-registered trade mark an applicant will have to overcome two hurdles. Firstly he will have to furnish the relevant law of the country, both codified and by authority (if relevant) and then he will have to establish through evidence that inside the parameters of that law he would be considered to be the owner of the trade mark. At the hearing Mr Bradbury clearly believed that he had satisfied both these requirements. Both I and the registered proprietor need to know the parameters in which any evidence has to be considered. At the preliminary hearing I emphasised the difficulties that this would encompass. In my letter subsequent to the hearing I stated the following:

“I advised Mr Bradbury that I was of the view that, in relation to his claim to be a proprietor of the trade marks in a Convention country, as well as adducing factual evidence to his specific claim he would also have to adduce into evidence the relevant governing law, statute and/or case law, in order to establish that he would be considered, according to the domestic legislation of the country, to be the

proprietor of the trade mark. If such evidence was not in English it would need to be translated into English in order to be considered in relation to these proceedings.”

26) Mr Bradbury relies upon his being the owner of the unregistered trade mark GOLF COURTS in Ireland. Mr Bradbury has not supplied any of the relevant law governing the issue of ownership of a non-registered trade mark in Ireland. He has supplied two letters from Cruickshank & Co, who are intellectual property agents in Dublin. The letters simply give an opinion based upon limited documentation supplied by Mr Bradbury. These letters represent an opinion based upon partial knowledge of the facts of the case. They do not represent a basis for me or the registered proprietor to consider the issues within the parameters of the relevant law.

27) Having failed to set out the parameters of the relevant law of Ireland in relation to ownership of a non-registered trade mark the application for rectification under section 60 must be dismissed.

28) For the sake of completeness I will go on to consider the actual evidence that Mr Bradbury has furnished in relation to his claim to ownership of GOLF COURTS as a trade mark in Ireland.

29) In relation to the issue of ownership in Ireland Mr Bradbury refers to the documents exhibited at pages 51a-c, 62a-b, 72a-j of FB1. I can find nothing therein to support the claim to rights in the trade mark GOLF COURTS. There is no reference to a specific trade mark. Mr Bradbury also refers to documents exhibited at pages 74a-b of FB1 and pages 12-14 of FBA1. This brochure indicates that Mr Bradbury was the deviser of the concept but certainly does not indicate that he is the owner of the trade mark GOLF COURTS. The page produced at 74B states:

“The Golf Court concept, design and system of play is protected by worldwide copyrights and patents all of which are held by Farel Bradbury and licensed to Golf Courts.”

There is no mention of the trade mark GOLF COURTS, the acknowledgement relates to copyright and patent right. The fact that the rubric refers to the company Golf Courts is an acknowledgement of this being at the least a trading name of the company; so, counter to the claim of Mr Bradbury is indicative of GOLF COURTS being seen as a trade mark of someone other than himself.

30) The press cuttings exhibited at pages 12 to 14 do not further Mr Bradbury’s case either. Again it identifies him as the deviser of the concept, a very different matter from showing either directly or indicatively that he is the owner of the trade mark GOLF COURTS. Mr Bradbury also refers to a video tape he furnished. The video tape shows use of the GOLF COURTS logo. The two items upon it, a recording from Sky News and a Japanese news programme again do not go to the issue of trade mark ownership. All they do is demonstrate is that Mr Bradbury was the innovator of the concept. I can find

nothing in the evidence that indicates that Mr Bradbury would have been seen as the owner of the trade mark GOLF COURTS in Ireland. (The evidence of use of the trade mark in Ireland is also so limited that it is a moot point that there could be any claim to the existence of a non-registered trade mark in this jurisdiction. Of course, without having legal authorities before me I cannot even judge what the Irish courts would consider to constitute proof of the existence of a non-registered trade mark.) It is also to be noted that Mr De Vere at JDV7 has given evidence to show that the launch in Ireland was at the behest of Golf Courts Ltd and that all the expenses were covered by this company. Consequently it would be this company that would be seen as supplying the services and goods, not Mr Bradbury.

31) The applicant has failed to establish that he is the proprietor of a trade mark in a Convention country and so this ground of rectification must fall.

32) Mr Bradbury has made various comments about what section 60 should or should not cover. He has also in his evidence referred to protection under Article 8 of the Paris Convention of trade names. Section 60 requires ownership of a trade mark, not a trade name, in a Convention country. Section 55 of the Act specifically excludes the United Kingdom from the definition of a Convention country. That is the law and that is what I have to apply. However, I would note that the exclusion of the United Kingdom is perfectly in keeping with the purpose of the Convention, which is to protect the legitimate rights of foreign enterprises and militate against their suffering prejudice because of their foreign status. United Kingdom enterprises have recourse to protection by other means; such as those parts of the Act which protect unregistered rights and refuse applications or registrations made in bad faith. Rectification under section 60 is an exceptional measure the parameters of which cover the position of a foreign enterprise which finds that its United Kingdom agent has usurped its trade mark rights. This is certainly not the case in these proceedings.

Section 64

33) Mr Bradbury believes that he is the rightful owner of the trade marks in suit. He has furnished evidence in relation to his position in relation to the trade marks in suit. I consider that this is enough to establish that Mr Bradbury has a sufficient interest in the matter as per section 64(1) of the Act. He is not a mere busy-body.

34) The question before me is whether the recording of the name of Mr De Vere as the proprietor can be defined as being an error, clearly it is not an omission. It is to be noted that the Act refers to the error being in the register. This is important. There is nothing to suggest that Mr De Vere made an error when he made the applications. He clearly wished to register the trade marks, there was no aberration or slip of the pen. His denial of the claims of Mr Bradbury show that he does not consider that he committed an error. That he does not consider that he committed an error when making the applications and that he considers that he is the rightful owner of the trade marks does not mean that there might not be an error on the register. If Mr De Vere is not the owner of the trade marks there is an error on the register and section 64 could apply. This is not, however, simply

a matter of Mr De Vere's ownership but also of Mr Bradbury's claim to ownership. The redress that Mr Bradbury seeks is that the trade marks are transferred to his ownership. Also I cannot leave the trade marks in ownership limbo. If I decided that they were not in the ownership of Mr De Vere I would have to decide in whose ownership they should rest. In dealing with the issues under section 60 I have dealt with the various claims of Mr Bradbury and have considered his claims to ownership both within and outside the United Kingdom. Therefore, I will not reiterate what I have already; much of it is as relevant to section 64 as section 60.

35) Morritt LJ in *AL BASSAM Trade Mark* [1995] RPC 511 at page 522 held the following.

“In my view it is plain that the proprietor is he who satisfies the principles of the common law to which I have referred. Accordingly in the case of a used mark, as in this case, the owner or proprietor is he who first used it in relation to goods for the purpose indicated in the definition of trade mark contained in section 68 which I have already quoted.”

This was a case decided under the 1938 Act, however, the 1994 Act does not raise any issues that put this test into question. The GOLF COURTS trade marks have been used for golf related activities. I find nothing in the evidence to suggest that Mr Bradbury was the first person to use GOLF COURTS as an indicator of origin. Indeed the evidence indicates the very opposite. Various enterprises with which Mr De Vere, and sometimes Mr Bradbury, has been associated have used, and first used, GOLF COURTS in a trade mark context; the most recent being Compac Golf Ltd. The evidence is not clear as to whether these enterprises might have a greater claim to ownership than Mr De Vere. It is not something that I can decide upon from what is before me. It could be for instance that there is an arrangement between Compac Golf Ltd and Mr De Vere in relation to the ownership of the trade marks. I cannot speculate. From the evidence before me I can draw the conclusion that Mr Bradbury has not proved his ownership of the trade marks and in such circumstances I do not consider that the status quo in relation to ownership should be disturbed. It is for Mr Bradbury to prove his case and he has not done so.

36) According to Morritt LJ in *Al Bassam* it is only in the case of an unused mark that the person who has the best right to use it is the designer or inventor. So even if Mr Bradbury had coined the phrase GOLF COURTS this would not alter the decision as the trade mark has been used.

37) The claim for rectification under section 64 of the Act is rejected.

38) The registered proprietor having been unsuccessful he is entitled to a contribution to his costs. In deciding upon the sum to be paid I have taken into account that the two sets of proceedings were only consolidated at a late stage. However, I do not think that this put an undue extra burden upon the registered proprietor. I order the applicant to pay the registered proprietor the sum of £1,000. 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 29 day of August 2002

**D.W.Landau
For the Registrar
the Comptroller-General**