

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION  
UNDER NO 84152 BY S C JOHNSON & SON INC  
TO RECTIFY THE REGISTER IN RESPECT OF REGISTRATION  
NO 2468686 IN THE NAME OF QUEST COTTON PRODUCTS LIMITED

## Background

1. On 5 October 2007 Neale Robinson on behalf of Just What You Need Limited (“Just”) made an application under No 2468686 for the trade mark re:refresh. The application subsequently completed its registration process on 2 May 2008.
2. On 6 April 2011 Mr Robinson filed a Form TM16. The form sought to record a change of ownership of a number of registrations, however, for the purposes of this decision it is sufficient to note that the form included a request to record a change of ownership of registration no 2468686 into the name of Quest Cotton Products Limited (“Quest”). The form indicated that a change of ownership took place on 1 April 2011. The requested change was subsequently recorded on the Trade Marks Register.
3. On 23 August 2011, S C Johnson & Son Inc (“Johnson”) filed a Form TM26(R) seeking to rectify the register. The application claims that the recordal of a change of ownership of the registration from Just to Quest is void because, at the time of making the request, Just was no longer the lawful owner of the registration and therefore was not legally entitled to assign it.
4. The application for rectification explains that on 31 August 2010, Just assigned the registration to Kelly Pioneer Group, LLC (“Kelly”). Later that same day, Kelly further assigned the registration to S C Johnson & Son, Inc. These assignments having taken place on 31 August 2010 therefore pre-dated the purported assignment from Just to Quest.
5. A copy of the application for rectification was sent by the registrar on 1 September 2011 to Quest, it being the recorded owner of the registration. The letter was sent by Royal Mail to the recorded address for service and allowed a period of two months, expiring 1 November 2011, for Quest to submit evidence or submissions if it wished to contest the application. No response to that letter has been received nor has the letter been returned to the registrar marked as undelivered.

## Decision

6. Rectification of the register is provided for under section 64 of the Act. This states:

**“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.

(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.”

7. As the subject of the application for rectification relates to Johnson’s request to be recorded as the registered proprietor of the registration following assignment of the mark to it, I am satisfied it has a sufficient interest under the provision of section 63(1) of the Act and that this is not a matter which affects the validity of the registration itself. I have no information that there are any proceedings concerning the trade mark pending in the court nor do I consider this is a matter that should be referred to the court,

8. Whilst no evidence has been filed by either party in the course of these proceedings, I have reviewed all papers on file. In doing so, I note that the Form TM16 filed on 6 April 2011 which requested the recordal of a change of ownership from Just to Quest was not supported by any formal evidence of any assignment having taken place between the two entities. In contrast, there is material on file which was submitted in August 2011 which supports the claim made by Johnson . This material takes the form of copies of signed assignment documents. They show that on 31 August 2010, Just assigned the registration to Kelly. Other material in the form of copies of relevant, signed assignment documents shows that, on the same day, Kelly further assigned the registration to Johnson. These assignments from Just to Kelly and on to Johnson, therefore pre-date the purported assignment from Just to Quest.

9. I am therefore satisfied that Just was not the legal owner of the registration when it purported to have assigned it to Quest as it had already assigned it to Kelly and that therefore the information provided on the Form TM16 it filed on 6 April 2011 was inaccurate. As I indicated earlier in this decision, Quest has not contested the application by Johnson. Quest has made no claim that there was a valid assignment of the mark from Just to itself at any date and most particularly on 1 April 2011. Neither does it dispute that its recordal as registered proprietor, as a result of any purported assignment, is void.

10. I therefore determine that Johnson’s application to rectify the register succeeds and that:

1: The recordal on the register of an assignment of the registration from Just What you Need Limited to Quest Cotton Products Limited is declared null and void and deemed never to have taken place;

2: The register shall be amended in the first instance so as to show the registered proprietor as Just What You Need Limited;

3: The assignment of the registration from Just What You Need Limited to Kelly Pioneer Group, LLC with an effective date of 31 August 2010 shall then be recorded on the register;

4: The assignment of the registration from Kelly Pioneer Group, LLC to S C Johnson and Son, Inc, again with an effective date of 31 August 2010 shall then be recorded on the register.

11. The effect of my decision is that the registration will stand in the name of S C Johnson & Son, Inc.

### **Costs**

12. Whilst S C Johnson & Son, Inc has succeeded, it made no claim for costs in its initial application for rectification nor has it subsequently done so. Even if it had made such a request, I note that all that has been filed in these proceedings is the Form TM26(R) accompanied by a single page making up a statement of the reasons for the application, reasons which were not complex. The Form TM26(R) does not attract a fee. Whilst I have referred to material in the form of copies of assignment documents as supporting the claims made in the application itself, this material was filed prior to the application for rectification itself being filed. In the circumstances, I make no award of costs.

**Dated this 2<sup>nd</sup> day of December 2011**

**Ann Corbett  
For the Registrar  
The Comptroller-General**