

O-457-14

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2524114
IN THE NAME OF ASHLEY THOMAS
FOR THE TRADE MARK**

BISH BASH BOSH

IN CLASS 25

AND

**AN APPLICATION FOR
RECTIFICATION OF THE REGISTER
UNDER NO. 84733
BY GEORGE EBENEZER**

Background and pleadings

1. Trade Mark registration number 2524114 for the mark BISH BASH BOSH currently stands in the name of Ashley Thomas. The application for registration was originally filed on 19 August 2009 by Bashy Holdings Ltd and completed its registration process on 27 November 2009, still owned by Bashy Holdings Ltd. The register of trade marks records that the registration was assigned to Ashley Thomas, in full, on 12 September 2011.

2. An application for rectification of the register under section 64 of the Trade Marks Act 1994 (“the Act”) was made by George Ebenezer on 3 February 2014. The application was made on statutory form TM26(R). The form was completed and the statement of truth was signed by Mr Ebenezer. He said this in the box requesting details of the error or omission to be corrected on the register:

“I have enclosed a copy of the assignment agreement signed by Ashley Thomas on 11/10/11. As a director of Bashy Holdings Ltd I can confirm Ashley Thomas was acting without authority.”

A copy of an assignment agreement was attached to the form TM26(R).

3. The application was served upon Mr Thomas, who was invited to submit evidence or submissions, with reference to rule 44(2)(b) of the Trade Mark Rules 2008:

“**44.**—(1) An application for rectification of an error or omission in the register under section 64(1) shall be made on Form TM26(R) together with:

(a) a statement of the grounds on which the application is made; and

(b) any evidence to support those grounds.

(2) Where any application is made under paragraph (1) by a person other than the proprietor of the registered trade mark the registrar—

(a) shall send a copy of the application and the statement, together with any evidence filed, to the proprietor; and

(b) may give such direction with regard to the filing of subsequent evidence and upon such terms as the registrar thinks fit.”

4. Both parties are self-represented. Only Mr Thomas filed evidence. The parties were given a choice as to whether they wished a decision to be made from the papers on file, without a hearing, or whether they wished to be heard. Mr Ebenezer did not reply, but Mr Thomas wrote to the Registry to say that he chose for the decision to be made from the papers.

5. Rectification of the register is provided for under section 64 of the Trade Marks Act 1994 (“the Act”):

“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.”

Evidence

6. Mr Ebenezer filed no evidence. He attached to his application for rectification, which contained a statement of truth which he personally signed, a copy of an assignment document between the current and previous proprietors. The Registry requested that Mr Ebenezer put this document into correct evidential format, i.e. file it under cover of a witness statement. Mr Ebenezer did not do that. As will be seen from my summary of Mr Thomas' evidence, there is no dispute that Mr Thomas signed the assignment document. I will therefore take the assignment document, into account. It is reproduced below:

ASSIGNMENT AGREEMENT

MADE AND ENTERED INTO BY AND BETWEEN:

Bashy Holdings Ltd of Music Block (F), Ealing Film Studios, Ealing Green, London, W5 5EP
(the "Assignor")

and

Ashley Thomas of 58 Lantern Close, Wembley, London, HA0 2JT
(the "Assignee")

WHEREAS the Assignor is the proprietor of the following trade mark:

United Kingdom

- 2524114 BISH BASH BOSH in class 25

AND WHEREAS the parties hereto have agreed to the assignment of the above mentioned trademark to the Assignee.

NOW THEREFORE THESE PRESENT WITNESS:

The Assignor hereby assigns with full title guarantee all of its right, title and interest in the Trade Mark, including all statutory and common-law rights attaching thereto, to the Assignee absolutely together with all rights to sue for damages and other remedies in respect of past infringements, passing-off or any other cause of action arising in relation thereto.

For the avoidance of doubt, the Trade Mark (and the related goodwill thereto) is assigned by the Assignor to the Assignee pursuant to this Assignment Agreement.

The Assignment will be taken to be effective as from 12 September 2011.

The Assignor warrants to the Assignee and confirms that the Trademark is owned by the Assignor and that the exercise by the Assignee of these will not infringe the rights of any third party.

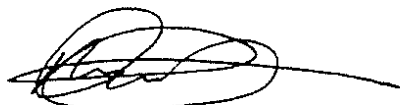
The Assignor warrants to the Assignee and confirms that it has not granted or assigned rights of any nature under the Trade Mark or Domain Name to any third party whatsoever in any part of the world.

The Assignor confirms that the Assignee or their legal representative is authorised to sign on behalf of the Assignor all forms and documents that are required by the UK-IPO to record this assignment at that Registry.

This Assignment shall be governed by English law in every particular including formation and the parties agree to submit to the exclusive jurisdiction of the courts of England and Wales.

THUS DONE and SIGNED at UK this 11th day of October 2011.

For and on behalf of Assignor:



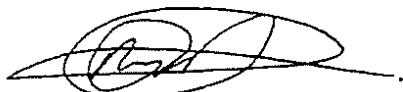
Bashy Holdings Ltd

Full Name of Signatory: Ashley Thomas

Position: Director

THUS DONE and SIGNED at UK this 11th day of October 2011.

For and on behalf of Assignee:



Full Name: Ashley Thomas

7. Part of Mr Thomas' evidence was not admitted by the Registry as it contained 'without prejudice' material. I summarise here the remainder of his evidence, given in his witness statement of 16 July 2014.

- Mr Thomas is a recording artist who has performed under the aliases Bashy and Bish Bash Bosh since 1999. He states that he has acquired goodwill under both of these names, prior to his involvement with George Ebenezer and an individual named Desmond George.
- Mr Thomas is a director of Bish Bash Bosh Limited and was a director of Bashy Holdings Ltd "until Notice of Appointment of Liquidator in Winding Up by the Court." He states that the facts in his witness statement come from his personal knowledge.

- Mr Thomas was advised by his former managers, Mr Ebenezer and Mr George of GGI Enterprises Limited, to start a company with them called Bashy Holdings Ltd, in 2008. All three were directors.
- Mr Thomas states: “While I was seeking through Lawyers and chartered accountants, to see the company accounts I was illegally removed on 02/09/11.” Exhibit A consists of email correspondence between Mr Thomas, Mr Thomas’ accountant (Daniel Fethers of OJK Ltd), and an officer at Companies House. One of the emails is from Mr Thomas to Companies House giving details of the dispute within the company. Mr Thomas was concerned about monies going into the company account which then mysteriously disappeared. He investigated with his personal accountant, “which has alarmed GGI”. The email records that Mr George had become aggressive and had tried to intimidate Mr Thomas away from the office and that, in August (2011), Mr George said that Mr Thomas would not have any access to accounts. Mr Thomas continued his working relationship with Mr Ebenezer in order to keep the company running, but he says that Mr George and Mr Ebenezer devised a plan to terminate him as a director of Bashy Holdings Ltd.
- Further emails from Companies House give details of how Mr Thomas could go about re-appointing himself as a director and confirm that the company is in dispute. Mr Thomas re-instated himself as a director on 11 October 2011.
- A bank statement is shown from Bashy Holdings Ltd, dated 12 January 2012, which shows that on 25 October 2011, there was an automated pay-in from ‘Adidas’ of £8,500; and that, on 27 October 2011, this same amount was withdrawn by GGI Enterprises Ltd. Mr Thomas states that he believes that Adidas sought to recover this money and to wind up the company after Mr Ebenezer and Mr George refused to return the money.
- Mr Thomas states that he and the management of the company (presumably Mr Ebenezer and Mr George) agreed to cease the current arrangement which would result in the closure of the company. This took place at a meeting on Saturday 10 September 2011. The effective date of assignment to Mr Thomas, according to the assignment document attached to Mr Ebenezer’s application, was two days later (on the Monday). Mr Thomas states: “It was further agreed that I would pay for the trade mark by paying for the cost of its registration, which I was told equalled a sum of Five Hundred Pounds Sterling.” Mr Thomas states that he was told he could assign this himself. He states he paid cash to Mr Ebenezer, and there was no receipt.
- Mr Thomas states: “It was determined mutually that the management would have no further purpose for the Trademark once management of the Artist ceased, as the Mark (Bish BASH Bosh) is directly associated with myself (Bashy), acquired good will previous to Bashy Holdings and is sold as part of my merchandise.”

- Mr Thomas states that he had advice from a firm of trade mark attorneys, Revomark, about how to assign the mark (a letter from Revomark, dated 12 September 2011, is exhibited, advising about signatures, dates and the attorney's fee).
- Mr Thomas questions why Mr Ebenezer has waited two years to file the application for rectification, after he himself had resigned as a director. Exhibit E is a "Current Appointments Report" from the Companies House website for the company Bashy Holdings Ltd, which shows its status, as of 11 April 2014, to be in compulsory liquidation. The only director shown on the report is Mr Thomas. Mr George's appointment was terminated on 9 May 2012, and Mr Ebenezer's appointments as director and secretary were terminated on 20 June 2012. The court issued a winding up order on 20 June 2012, with the petition date being 26 April 2012.
- The company is in liquidation. Mr Thomas states that liquidators are currently seeking all assets of the company including the trade mark or the sum paid for the trade mark, which he states is £500. Mr Thomas states that as the sum was paid to Mr Ebenezer, Mr Ebenezer would like to claim the trade mark to avoid paying the value of the trade mark to the liquidators. This is a reference to Mr Ebenezer's application for rectification and Mr Thomas' perception of the motive for the application.

8. Following the filing of Mr Thomas' evidence, Mr Ebenezer was given the opportunity to reply to it, but no response was filed.

9. There are a number of other documents on the Registry file. I give details here:

- A letter of appointment by the Secretary of State, in the Preston District Registry, of Mr P Sargent of Begbies Traynor (Central) LLP as liquidator of Bashy Holdings Ltd, with effect from 11 July 2012.
- A letter to the Intellectual Property Office ("IPO"), dated 26 February 2014 from Mr Sargent, enclosing the aforementioned letter of appointment. He also enclosed a copy of a letter from the Registrar to Mr Ebenezer, dated 17 February 2014, notifying the latter that his application had been served upon Mr Thomas. Mr Sargent says: "I believe the Trade Mark "BishBashBosh" was originally the property of the Company in liquidation and I shall be obliged if you will let me have details of the history of the creation and transfer of the trade mark between various owners". The letter was copied to Christine Harris, of 'Birchall Blackburn'.
- A letter from Birchall Blackburn Law, dated 14 May 2014, which says that the firm acts on behalf of Mr Sargent, the liquidator. The letter asks for a copy of the application for rectification and confirmation of the position of the trade mark registration.
- A letter from Birchall Blackburn Law, dated 3 June 2014, objecting to the transfer into the name of George Ebenezer, as he has no rights to the trade mark. The letter says that if there is to be any rectification, it should be to put

the trade mark into the name of Bashy Holdings Ltd. The letter asks to be kept informed as to developments as the liquidator “has an interest in this matter”.

- A letter from Birchall Blackburn Law, dated 27 August 2014, expressing concern that the assignment agreement was signed by Ashley Thomas on behalf of both the company and himself. The letter goes on to say that the trade mark should really belong to the company, Bashy Holdings Ltd, but gives no further details as to why the writer believes that to be the case. The letter ends with confirmation that the liquidator objects to any transfer into the name of George Ebenezer.

Decision

10. It is helpful to produce a timetable of events relating to the trade mark and these proceedings.

Activity/event	Date
Removal of Ashley Thomas as director	2 September 2011
Meeting between directors	10 September 2011
Effective date of assignment	12 September 2011
Ashley Thomas re-instated as director	11 October 2011
Date assignment agreement signed by Ashley Thomas	11 October 2011
Date Form TM16 filed at Trade Mark Registry recording Ashley Thomas as owner	11 October 2011
Petition to wind up company	26 April 2012
Removal of Desmond George as director	9 May 2012
Removal of George Ebenezer as director and secretary	20 June 2012
Winding up order	20 June 2012
Liquidator appointed	11 July 2012
Application for rectification filed by Mr George	3 February 2014

11. There are only two parties to the proceedings: Mr Thomas and Mr Ebenezer. Neither Mr Sargent, the liquidator, nor Birchall Blackburn Law are parties to this rectification. They have not made the application for rectification. They have not

asked for leave to intervene under rule 45 of the Trade Marks Rules 2008. The letters on file are not evidence and Mr Thomas has not seen them, so he has not been able to refute the writer's belief that the trade mark should, if there is any rectification, go back to Bashy Holdings Ltd. The letters do not say why it is the writer's belief that the mark should, if there is any rectification, belong to Bashy Holdings Ltd. The only clear statement is that there should be no transfer to George Ebenezer because he is not entitled to the mark. Given the non-party status of the letters from the liquidator and his representatives and the lack of legal and factual explanation for what the writers say, they can carry no weight in these proceedings.

12. Section 64 (1) of the Act states that any person having a sufficient interest may apply for the rectification of an error or omission in the register. On the date on which he made the application, 3 February 2014, Mr Ebenezer had not been a director of Bashy Holdings Ltd for 20 months. He has not explained what his interest is in the proceedings or the mark. He is not a beneficial owner. He is not a director. He has filed no evidence at all. I find that George Ebenezer, as of 3 February 2014, did not have sufficient interest to apply for the rectification of an error or omission in the register in relation to trade mark registration 2524114.

13. Mr Ebenezer is not explicit in asking for specific relief in his application for rectification. All he says is that Ashley Thomas was acting without authority when he signed the assignment agreement on 11 October 2011. He does not say that he should have the trade mark. He does not say that the mark should revert to Bashy Holdings Ltd. These are the only two types of relief that I can envisage he might have asked for. I infer that he has not asked for himself to be the owner because he knows that he is not entitled to the registration. Mr Ebenezer does not make it clear what relief he is seeking.

14. Strictly speaking, my finding that George Ebenezer is not entitled to bring these proceedings because he does not have sufficient interest is the end of the matter. However, in case I am wrong, I will go on to determine the application for rectification assuming that the relief sought is that the mark returns to Bashy Holdings Ltd. There is no reason to believe that Mr Ebenezer thinks he should own the mark, so I will not pursue that avenue.

15. There is no question in these proceedings of omissions; the claim can only be that an error has taken place. The claimed error is that the change in ownership of the trade mark should not have been recorded by the IPO. Mr Thomas filed a form TM16 recording the assignment at the IPO on 11 October 2011. A form TM16 is not proof of a valid assignment. The form includes the following note: "This form is not a substitute for the assignment document or other proof of the transaction". Although no documentation is required to be filed with the TM16, the provisions of section 24(3) of the Act still apply:

"An assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative."

16. Mr Thomas signed the assignment agreement on 11 October 2011 and filed the TM16 on the same day. According to the Companies House report of 11 April 2014,

he was appointed as a director of Bashy Holdings Ltd on 17 August 2011. The report states he has had two appointments. Mr Thomas states he was illegally removed as a director on 2 September 2011. He states that he was reappointed as a director on 11 October 2011. This is the very same day on which he signed the assignment agreement. He did not sign it before that, presumably because he recognised his status did not permit him to sign it until he was re-instated as a director. On the date on which Mr Thomas signed the assignment document transferring the mark to him, he was a director of Bashy Holdings Ltd. Mr Ebenezer's allegation in his application for rectification that Mr Thomas was acting without authority when he signed the assignment agreement on 11 October 2011 is therefore wrong.

17. Was Mr Thomas entitled to transfer the mark to himself, as of 12 September 2012 (the effective date of assignment)? I think that he was, for the following reasons. He has given evidence that there was a falling out between the three directors and that a meeting was held on 10 September 2011, a Saturday, at which it was agreed that the company would be closed and that he could buy the trade mark for £500, which he states he did. The assignment agreement records that he took ownership on 12 September 2011, which was the first business day after that meeting took place. The assignment took place some 7 months before a petition was lodged to wind up the company. Bashy Holdings Ltd was not in liquidation as of 12 September 2011, or as of 11 October 2011. On those dates, the trade mark was an asset of Bashy Holdings Ltd which could be sold by Bashy Holdings Ltd and bought by Mr Thomas. No error has taken place and there is no error to correct.

18. It is true that I have only Mr Thomas' evidence. There has been no challenge to his evidence. Not only has there been no challenge, Mr Ebenezer has been entirely silent since Mr Thomas filed his evidence. He has filed no evidence, no written submissions and has not replied to the letter from the registry giving him a choice as to how he wishes the decision to be taken. There is nothing incredible about Mr Thomas' version of events and he has provided exhibits with corroborative content and dates to match his narrative. His evidence must be accepted as true because it is credible and has not been contradicted. The application for rectification of the register fails.

Outcome

19. The application for rectification of the register fails.

Costs

20. Mr Thomas has been successful and is entitled to a contribution towards his costs. The Registrar normally awards costs according to the published scale in Tribunal Practice Notice 4/2007. It is appropriate to award half of what would have been awarded had Mr Thomas had legal representation. Mr Thomas is entitled to an amount for the consideration of the application for rectification and for compiling his evidence. I will reduce the scale award in relation to considering the application for rectification because it was so brief. Therefore, the amount I will award to Mr Thomas is as follows:

Considering application for rectification:	£50
Filing evidence:	£250
Total:	£300

21. I order George Ebenezer to pay Ashley Thomas the sum of £300 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

Dated this 24th day of October 2014

**Judi Pike
For the Registrar,
the Comptroller-General**