

**BL O/681/22**

**TRADE MARKS ACT 1994.**

**TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008.**

**IN THE MATTER OF:**

**INVALIDITY APPLICATION No. 503859**

**IN THE NAME OF TRADEIX LTD**

**AND INTERNATIONAL REGISTRATION (UK) No. WO1541304**

**IN THE NAME OF NEW HOLLAND VENTURES PTY LTD**

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**DECISION**

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**Abbreviations**

1. In this Decision:

**“the Madrid Protocol”** refers to the Protocol relating to the Madrid Agreement concerning the International Registration of Trade Marks, adopted at Madrid on 27 June 1989

**“the International Bureau”** refers to the International Bureau of the World Intellectual Property Organization (WIPO) as the body responsible for administering the system for international registration of trade marks under the Madrid Protocol

**“the International Registration Order”** refers to The Trade Marks (International Registration) Order 2008 made under Section 54 of the Trade Marks Act 1994

## **Summary**

2. New Holland Ventures Pty Ltd (“the Proprietor”) appeals under Section 76 of the Trade Marks Act 1994 against a Decision of the Registrar of Trade Marks dated 29 March 2022 declaring its International Registration (UK) No. WO1541304 invalid and directing that it be removed from the Register of Trade Marks and deemed never to have been made. The Decision was made under Rule 41(6) of the Trade Marks Rules 2008 for default by the Proprietor in filing a defence to Invalidity Application No. 503859 filed by Tradeix Ltd (“the Applicant”) on 18 May 2021. The Appeal is brought (with evidence in support) on the basis that the Hearing Officer who made the Decision on behalf of the Registrar “**was not fully aware of all the facts and circumstances surrounding the case**” and mistakenly thought that he could and should exercise the power conferred by Rule 41(6) on the basis that he did. On the basis that the Invalidity Application was not validly served out of the jurisdiction by posting it to the Proprietor’s registered office address in Australia, the Appeal is allowed and the Hearing Officer’s Decision and Order are set aside. The Applicant’s claim for invalidity is remitted to the Registrar for further processing in accordance with the provisions of the 1994 Act and the 2008 Rules on the basis that the procedural irregularity with regard to service of the Invalidity Application under Rule 41(5) was rectified in May 2022.

## **Background**

3. International Trade Mark No. WO1541304 **MARCO POLO** was registered by the International Bureau as of 19 June 2020 with Madrid Protocol designations for protection in CN, EM, GB, SG, US in respect of a wide range of financial services in Class 36.
4. The name of the holder was recorded as: **New Holland Ventures Pty Ltd**. Its address was recorded as: **Level 9, 636 St Kilda Road, Melbourne VIC 3004 (AU)** (this was its registered office, located at the offices of its accountants Koustas & Co. Pty Ltd). The name and address of the holder’s appointed representative was recorded as: **Rotstein Commercial Lawyers, L5, 552 Lonsdale Street, Melbourne VIC 3000 (AU)**.

5. In para. 4 of a Witness Statement provided for the purposes of the present proceedings by Upekha Suweni Wedage (the lawyer at Rotstein Commercial Lawyers who dealt with the filing) it is confirmed that the representative's telephone number and email address were provided in the International Application, with email specified as the 'dedicated communication channel' (Rule 9(4)(a) of the Madrid Protocol Regulations and applicable Administrative Instructions).
6. Except where expressly provided otherwise, any invitation, notification or other communication addressed by the International Bureau to the appointed representative shall have the same effect as if it had been addressed to the holder of the international registration and any communication from the appointed representative shall have the same effect as if it had been addressed to the International Bureau by the proprietor (Rule 3(5)(b) of the Madrid Protocol Regulations).
7. The Proprietor's request for extension of the protection of its International Registration No. WO151304 to the United Kingdom proceeded under the International Registration Order. It is confirmed in Article 3 and Schedule 1, Part 2 of that Order that Rules 11 and 12 of the Trade Marks Rules 2008 apply to such requests for extension of protection with the exclusion of Rule 12(4)(a).

#### **Rule 11 of the 2008 Rules: Address for Service**

8. Rule 11(1) provides as follows: “ **(1) For the purposes of any proceedings under the Act or these Rules, an address for service shall be filed by — (a) an applicant for the registration of a trade mark; (b) any person who opposes the registration of a trade mark in opposition proceedings; (c) any person who applies for revocation, a declaration of invalidity or rectification under the Act; (d) the proprietor of the registered trade mark who opposes such an application; (e) a proprietor of a comparable trade mark (EU) who sends a derogation notice to the registrar under rule 43A.**”
9. These provisions operate to establish a regime in which all persons of the kind identified must file an “**address for service**” to be used “**for the purposes of any proceedings**

**under the Act or these Rules”** involving situations of the kind specified at (a) to (e). The **“address for service”** requirement is locked into all five of those situations.

10. In the context of *inter partes* proceedings:
  - (i) situations (a) and (b) combine to ensure that an applicant for registration of a trade mark and a person who opposes the registration of a trade mark must each have filed an **“address for service”** in order to enable service of documents to be effected **“for the purposes of any [opposition] proceedings under the Act or these Rules”**;
  - (ii) situations (c) and (d) likewise combine to ensure that a person who applies for revocation, a declaration of invalidity or rectification and the proprietor of the registered trade mark who opposes such an application must each have filed an **“address for service”** in order to enable service of documents to be effected **“for the purposes of any [revocation, invalidity or rectification] proceedings under the Act or these Rules”**.
11. Being the proprietor of a registered trade mark carries with it an obligation to file an **“address for service”** in the particular circumstances identified in situations (d) (**“the proprietor ... who opposes such an application”**) and (e) (**“the proprietor of a comparable trade mark (EU) who sends a derogation notice to the registrar”**).
12. Outside those situations, the filing of an **“address for service”** by the proprietor of a registered trade mark appears to be optional in accordance with Rule 11(2), which provides that: **“The proprietor of a registered trade mark, or any person who has registered an interest in a registered trade mark, may file an address for service on Form TM33 or, in the case of an assignment of registered trade mark, on Form TM16.”**
13. Rule 11(2) notably does not treat the filing of an **“address for service”** as optional for a person in situation (a): **“an applicant for the registration of a trade mark”**. That aligns with the proposition that applicants for registration are required to file an

**“address for service”** on the basis that the process of examining an application for acceptability under the **“registration procedure”** set out in Sections 37 to 41 of the 1994 Act falls to be regarded as a **“proceeding”** within the scope of the expression **“any proceedings under this Act or these Rules”** as used in the opening words of Rule 11(1).

14. As further support for that proposition I refer, by way of illustration, to:

- (i) Section 66(1) of the 1994 Act and Rule 3(1) of the 2008 Rules, which provide for the use of forms prescribed by the Registrar **“for any purpose relating to the registration of a trade mark or any other proceedings before him under this Act”**. Prescribed Form TM3 (Application to register a trade mark) calls for applicants for registration to provide details of an address which meets the **“address for service”** requirements.
- (ii) The UK Intellectual Property Office Guidance on “Address for Service for Intellectual Property Rights” published on 23 November 2020 in which it is stated **“You need an address in the UK, Gibraltar or the Channel Islands before we consider your application. ... New applications: If you file an application for a patent, a trade mark or a design at the IPO you must have an address for service in the UK, Gibraltar or the Channel Islands.”**
- (iii) The Manual of Trade Marks Practice, International Examination Guide (last updated January 2021) which in relation to requests for protection of International Registrations in the United Kingdom cross-refers in Section 2.4 under the heading **“Appointing a UK, Channel Islands or Gibraltar representative”** to the **“address for service”** Guidance noted in (ii) above.
- (iv) Sections 2.49 and 2.50 of Chapter 2 of the Formalities Manual (online version: published 31 March 2017, updated 29 June 2022) in which the practice of the UK IPO relating to a “Request for grant of a patent (Form 1)” under the corresponding provisions of Rule 103 of the Patents Rules 2007 is stated to be: **“Every application filed after the 1<sup>st</sup> January 2021 must include an address**

for service, which must be in the UK, Gibraltar or the Channel Islands (r.103) in this part of the form. This address will be treated for all purposes as the address of the person making the application ... and all communications must be sent to the applicant at or c/o this address” and if a non-compliant address is provided “a suitable paragraph requesting compliance with r.103 within 2 months should be added to the first official letter issued.”

(v) Rule 63(1) of the 2008 Rules which specifies that “**the registrar shall, before taking any decision on any matter under the Act or these Rules which is or may be adverse to any party to any proceedings, give that party an opportunity to be heard.**” This requirement is routinely applied to decision taking in the course of “**proceedings**” involving the examination of applications for registration.

(vi) Section 76(1) of the Act and Rule 73(1)(a) of the 2008 Rules, which confirm that decisions (including acts of the Registrar in the exercise of a discretion vested in him by or under the Act) in “**proceedings**” involving only an applicant for registration can be (as they not infrequently are) challenged by way of appeal to an Appointed Person.

15. I see no reason to doubt that the process of examining an application for registration of a trade mark (or request for extension of protection under the International Registration Order) is a “**proceeding**” under the “**registration procedure**” set out in Sections 37 to 41 of the 1994 Act to which the “**address for service**” requirement in Rule 11(1)(a) applies.

#### **Rule 12 of the 2008 Rules: Enforcement**

16. For the purposes of enforcement, Rule 12 (1) provides as follows: “**(1) Where — (a) a person has failed to file an address for service under rule 11(1); and (b) the registrar has sufficient information enabling the registrar to contact that person, the registrar shall direct that person to file an address for service**”.

17. Rule 12(2) provides as follows: **“(2) Where a direction has been given under paragraph (1), the person directed shall, before the end of the period of one month beginning immediately after the date of the direction, file an address for service.”**
18. Rule 12(3) provides that: **“Paragraph (4) applies where — (a) a direction was given under paragraph (1) and the period prescribed by paragraph (2) has expired; or (b) the registrar had insufficient information to give a direction under paragraph (1), and the person has failed to provide an address for service.”** Rule 12(4) provides: **“(a) in the case of an application for registration of a trade mark, the application shall be treated as withdrawn; ...”**.
19. It is not clear to me why Rule 12(4)(a) is excluded in relation to requests for extension of protection to the United Kingdom by Article 3 and Schedule 1, Part 2 of the International Registration Order. I infer that there may be a question as to the competence of the United Kingdom to act autonomously of the International Bureau under the Madrid Protocol in the manner envisaged by Rule 12(4)(a).
20. Be that as it may, the Madrid Protocol falls to be interpreted and applied consistently with the provisions of the Paris Convention for the Protection of Industrial Property of March 20, 1883 as last revised at Stockholm on July 14, 1967 and amended on September 28, 1979. The Paris Convention provides generally in Article 6(1) that **“The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation”** and provides specifically in Article 2(3) that **“The provisions of the laws of each of the countries of the Union relating to judicial and administrative procedure and to jurisdiction, and to the designation of an address for service or the appointment of an agent, which may be required by the laws on industrial property are expressly reserved.”**
21. I do not think it can be doubted that Rules 11 and 12 of the 2008 Rules operate within the area of judicial and administrative procedure and jurisdiction reserved to the United Kingdom under the Paris Convention. The exclusion of Rule 12(4)(a) does not, in my view, have the effect of eliminating or relaxing the **“address for service”** requirements

imposed by Rule 11(1)(a) and Rule 12(1) in relation to requests for extension of protection under the International Registration Order.

### **UKIPO examination of International Registration (UK) No. WO151304**

22. During the pendency of the Proprietor's request for extension of protection to the United Kingdom, Rule 11(4) specified that: **“An address for for service under this Rule shall be an address in the United Kingdom, an EEA state or the Channel Islands.”** The Patents, Trade Marks and Designs ( Address for Service) (Amendment) (EU Exit) Rules 2020 removed the words **“an EEA state”** and replaced them with the word **“Gibraltar”** with effect from 01 January 2021.
23. The Proprietor did not provide the Registrar with a Rule 11(4) **“address for service”**. The information provided in International Trade Mark Application No. WO1541304 was sufficient to enable the Registrar to contact the Proprietor. That information could have been used by the Registrar to issue a direction under Rule 12(1) requiring the Proprietor to file such an **“address for service”** within the period of one month prescribed by Rule 12(2). However, no Rule 12 direction was sent to the Proprietor or its appointed representative either directly or indirectly via the International Bureau.
24. The Registrar proceeded to accept the request for extension of protection on 31 December 2020. In the Register entries relating to the resulting International Registration (UK) No. WO1541304, the name and address of the “Holder” and the name and address of its appointed “WIPO representative” were carried over from the International Trade Mark Application and recorded as those identified in para. [4] above.
25. On 05 January 2021, the Registrar confirmed in an official letter sent to the International Bureau under the heading **“Statement of grant of Protection – Rule 18 ter(1)”** that: “I have completed all actions on this case. The international registration is protected in the United Kingdom and has rights equivalent to those of a registered trade mark.” Expressed in terms of Rule 18 *ter*(1) of the Madrid Protocol Regulations, this letter provided the International Bureau with confirmation to the effect that **“all procedures**

**before [the UKIPO] have been completed and there is no ground for [the UKIPO] to refuse protection**". The International Bureau forwarded the confirmation to the Proprietor by email via its appointed representative, Rotstein Commercial Lawyers, on or about 07 January 2021.

26. At the hearing before me I was told that the expectation of the Australian lawyers was that they would continue to receive correspondence emanating from the UKIPO in relation to the Proprietor's International Registration (UK) and that it would come to them via email as the 'dedicated communication channel' (Transcript p.4 and pp. 43, 44). I do not find it particularly surprising that they expected that to be the case: the Proprietor had neither filed nor been directed by the Registrar to file a Rule 11(4) **"address for service"** under the 2008 Rules; moreover it had received — by email from the International Bureau — a 'Statement of grant of Protection' emanating from the Registrar under Rule 18 *ter*(1) of the Madrid Protocol Regulations confirming that all procedures before the UKIPO had been satisfactorily completed.
27. However, the Madrid Protocol Regulations do not govern the way in which these matters are dealt with in the United Kingdom under the 1994 Act and the 2008 Rules. The prevailing view (albeit subject to criticism and pressure for modernisation) is that an email address does not, as such, qualify for recognition as an **"address for service"** because it does not, as such, designate any particular premises at which papers intended for a particular person can with confidence be physically delivered c.f. Axnoller Events Ltd v Brake [2022] EWHC 1162 (Ch) at paras [16] to [19] (HHJ Paul Matthews sitting as a Judge of the High Court). Rule 79(1) provides for the use of email by the Registrar in the following terms: **"The delivery using electronic communications to any person by the registrar of any document is deemed to be effected, unless the registrar has otherwise specified, by transmitting an electronic communication containing the document to an address provided or made available to the registrar by that person as an address for the receipt of electronic communications; ..."**. This supplements without altering the requirements of Rules 11 and 12 relating to the filing of a Rule 11(4) **"address for service"**.

### **Invalidity Application No. 503859**

28. In a Form TM26(I) and Statement of Grounds filed on 18 May 2021, the Applicant applied to the Registrar for a declaration to the effect that the Proprietor's International Registration (UK) No. WO1541304 was invalidly registered for conflict with the rights to which it (the Applicant) was entitled under Sections 5(1) and / or 5(2)(a) of the Trade Marks Act 1994 as proprietor of the earlier trade mark **MARCO POLO** registered in the United Kingdom under number 917998423 with effect from 11 December 2018 for a wide range of financial services in Class 36.
29. The Registrar was required by Rule 41(5) of the 2008 Rules to **“send a copy of Form TM26(I) and the statement of grounds on which the application is made to the proprietor”**. Doing so would set in train the process specified in Rule 41(6): **“The proprietor shall, within two months of the date on which a copy of Form TM26(I) and the statement was sent by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid.”**
30. The time limit of two months prescribed by Rule 41(6) is both rigid and jurisdictional. It operates rigidly as a result of the barrier to the granting of an extension created by the 2008 Rules: the Registrar is expressly prevented by Rule 77(6) and Schedule 1 from treating it as a *“flexible time limit”*. It operates jurisdictionally as a result of the barrier to the filing of a defence created by Rule 41(6). If the proprietor of the registration in issue fails to comply with the deadline, his right to oppose the invalidity application is timed-out. At that point, the invalidity application stands undefended and the registration **“shall ... be declared invalid”** unless the Registrar counteracts that by issuing a decision which **“otherwise directs”** as to what the result of the failure to comply with the time limit should be. There is a significant disciplinary dimension and none the less so because there is also a curative dimension to the exercise of the discretion available to the Registrar under Rule 41(6) (**“may treat the proprietor as not opposing the application”**): TESCON Trade Mark BL O/240/20 (17 April 2020) at paras. [43], [44]. The discretion is generally not exercised in favour of the proprietor

of the contested registration in the absence of ‘extenuating circumstances’ or ‘compelling reasons’ for doing so: Permanent Secretary v John & Pascalis Ltd (HALLOUMI Trade Mark) [2018] EWHC 3226 (Ch) at paras. [34] to [41] (Arnold J).

**Service of the Invalidity Application: official letter of 26 May 2021**

31. The Registrar took steps to comply with the requirement for service contained in Rule 41(5) by sending a copy of the Invalidity Application to the Proprietor by registered post under cover of an official letter dated 26 May 2021. The letter was sent to the Proprietor at its registered office address in Melbourne, that being the address recorded in the UK Register for the “Holder” of International Registration (UK) No. WO1541304. It was not copied to the Proprietor’s “WIPO representative”, recorded in the UK Register as Rotstein Commercial Lawyers at the Melbourne address for correspondence identified in para. [4] above. It is not clear from the information available to me whether and, if so, when the letter was actually delivered by Australia Post to the Proprietor’s registered office address: see paras. [72] and [73] below.

32. The letter contained a paragraph stating:

The holder of the International Registration must provide us with an address for correspondence in the United Kingdom (which for the purposes of the Act includes the Isle of Man, the Channel Islands and Gibraltar) on a form TM33 ‘Appointment or change of agent or contact address’ ... within this two month period.

33. This correctly recognised that the Invalidity Application was being sent by way of service to an address which the Registrar was not in a position to treat as an address for service **“for the purposes of any proceedings under the Act or these Rules”** pursuant to the requirements of Rule 11.

34. Sending a letter to the Proprietor at its registered office address and / or its appointed representative’s address would have been permissible under Rule 12(1) on the basis that **“the registrar has sufficient information enabling the registrar to contact that person”** via those addresses in order to **“direct that person to file an address for**

**service**” for the particular purpose of securing compliance with the filing requirement imposed by Rule 11(1)(d) on the proprietor of a registered trade mark **“who opposes”** an application for a declaration of invalidity.

35. However, the Registrar was not able at the date of the official letter to treat the Proprietor as a person **“who opposes”** the application for invalidity for the purposes of Rule 11(1)(d). The Proprietor was not aware of the filing of the Applicant’s claim for invalidity; it had adopted no position in relation to it; and it was not required to do so unless and until it had been duly served with the Form TM26(I) and Statement of Grounds under Rule 41(5): see, by analogy, YA II PN Ltd v Frontera Resources Ltd [2021] EWHC 1380 (Comm) at para. [56] (Butcher J) citing and applying Dubai Financial Group LLC v National Private Air Transport Services [2016] EWCA Civ 71 where McCombe LJ (with whom Treacy LJ agreed) said at paras. [40] to [42]:

**“ ... the time for acknowledgment of service had not expired, because none had ever become applicable. This, to my mind, is not ‘playing technical games’ ... It is merely applying the principle that due process should be followed. If a defendant has never become under a valid obligation to acknowledge service, either as specified by the rules or by order of the court, I do not see how it can be said that a judgment can be entered against him in default of such acknowledgment. He is simply not in default at all. Our system of law has always taken pride in ensuring that even the apparently unmeritorious only have judgment entered against them once found to be liable by trial, by summary judgment or when they have failed to meet the express procedural requirements of a clearly defined obligation to take a procedural step which has been drawn to their attention. ...”**

36. It appears to me that for lack of a Rule 11(4) **“address for service”** the Registrar needed to adopt a procedure for notification of the claim for invalidity which catered for two possible outcomes:

- (i) failure by the Proprietor to comply with a Rule 12(1) direction to provide a Rule 11(4) **“address for service”**, thereby leaving in place proceedings for a declaration of invalidity with respect to which **“the proprietor shall be deemed to have withdrawn from the proceedings”** : Rule 12(4)(d);

- (ii) compliance by the Proprietor with a Rule 12(1) direction to provide a Rule 11(4) “**address for service**”, thereby putting in place an address to which the Form TM26(I) and Statement of Grounds could be sent as required by Rule 41(5).

The direction I have quoted in para. [32] above was framed in terms which were not adequate to achieve that result.

### **Questions as to service**

37. The decision to effect service of the Invalidity Application on the Proprietor in Australia under cover of the official letter of 26 May 2021 raised questions as to:
- (i) the applicability (or otherwise) of Section 7 of the Interpretation Act 1978 to the service of an invalidity application by the Registrar under Rule 41(5) of the 2008 Rules;
  - (ii) the permissibility (or otherwise) of using an address which does not comply with the requirements of Rule 11(4) of the 2008 Rules as an address for service of an invalidity application by the Registrar under Rule 41(5); and
  - (iii) the necessity (or otherwise) for the requirements of Rules 11 and 12 of the 2008 Rules to be completed prior to service of an invalidity application by the Registrar under Rule 41(5).
38. These questions need to be addressed because they affect the jurisdiction of the tribunal in the first instance and on appeal to proceed to a determination at the ‘second stage’ of the specified procedure i.e. under Rule 41(6): did the Registrar have the power (which the parties could not by act or omission confer upon him) to proceed in the way that he did at the ‘first stage’ of the specified procedure i.e. under Rule 41(5)? Mr Mark King, Deputy Director (Tribunal), provided a written statement of position on behalf of the Registrar. The Proprietor and the Applicant were able on the basis of that statement to take account of the Registrar’s position in the presentation of their respective cases at

the hearing before me. The Applicant largely agreed and the Proprietor largely disagreed with the position adopted by the Registrar,

**Question (i)**

39. It is (in my view, correctly) not disputed that Section 7 of the Interpretation Act 1978 applies to the service of invalidity applications by post under Rule 41(5).
40. The Registrar noted that Rule 10(4) of the Trade Marks Rules 2000 was removed in 2006 because it was considered that Section 7 provided the necessary authority for the postal service of documents. Rule 10(4) provided that: **“Anything sent to any applicant, opponent, intervener, or registered proprietor at his address for service shall be deemed to be properly sent; and the registrar may, where no address for service is filed, treat as the address for service of the person concerned his trade or business address in the United Kingdom, if any.”** I think it is important to emphasise that this Rule (the provisions of which are traceable back through successive iterations to Rules 13(4) and (5) of the Trade Marks and Service Marks Rules 1986) did not purport to authorise the Registrar to effect service of any proceedings out of the jurisdiction.
41. Section 7 of the 1978 Act states: **“Where an Act authorises any document to be served by post (whether the expression ‘serve’ or the expression ‘give’ or ‘send’ or any other expression is used) then, unless the contrary intention appears, the service is deemed to be effected by properly addressing, pre-paying and posting a letter containing the document and, unless the contrary is proved, to have been effected at the time at which the letter would be delivered in the ordinary course of post.”**
42. Service takes place in accordance with the provisions of Section 7 at the time when the document concerned is deemed (unless the contrary is proved) to have been physically delivered to the address to which it was sent. As explained by the Court of Appeal in Anixter Ltd v Secretary of State for Transport [2020] EWCA Civ 43 at paras. [71] to [74] per Lewison LJ:

[71] Section 7 thus provides for two things: (a) how service by post is effected and (b) when service takes place. As to the latter, service takes place when the letter is delivered; and there is a rebuttable presumption that delivery takes place in the ordinary course of post. Of course, where a letter is sent by the recorded delivery service, there will be a signed receipt (as there was in this case). In *Tadema Holdings Ltd v. Ferguson* (1999) 32 HLR 866, 873 Peter Gibson LJ said (in a case relating to service of a notice under the Housing Act 1988):

“‘Serve’ is an ordinary English word connoting the delivery of a document to a particular person.”

[72] The Supreme Court approved this observation in *UKI (Kingsway) Ltd v. Westminster City Council* [2018] UKSC 67, [2019] 1 WLR 104. In *Freetown Ltd v. Assethold Ltd* [2012] EWCA Civ 1657, [2013] 1 WLR 701 this court considered section 7 in detail. The issue in the case was whether service was effected at the time of posting or at the time of receipt. The court held that service was effected at the time of receipt. There was no further requirement that the document served should come to the attention of the person who would deal with it. As Rix LJ put it at [40]:

“... section 7 is there to make it completely plain that, whether the expression used is “serve”, “give”, “send” or anything else, the concept of receipt remains the dominant concept, albeit there is a deemed receipt subject to proof otherwise.”

[73] He observed further at [45]:

“As for registered post, the advantage of this method of post is that (i) the day of posting will be recorded, (ii) the fact (and date) of delivery will be recorded, and (iii) if the letter cannot be delivered, it will be returned and the sender will be informed. Thus, if the letter goes astray or the addressee cannot be found, the sender will know, and ought to know more or less

**promptly, that that is so ... The same will be true of recorded delivery.”**

**[74] In my judgment where Parliament chooses a word in a statute which has a clear and consistent meaning in law, it must be taken to have adopted that meaning. The point is all the stronger where the term is itself defined by statute.**

43. The Section 7 presumption (that service was effected at the time the posted document would have been received in the ordinary course of the post) is, in terms, rebuttable. The burden of rebutting it is on the addressee of the letter (in this case: the Proprietor). However, the presumption only operates if the letter containing the document to be served has been **“properly addressed, pre-paid and posted”**. And the burden of proving compliance with that condition is on the sender of the document (in this case: the Registrar): Freetown Ltd v Assethold Ltd [2012] EWCA Civ 1657 at para. [37] per Rix LJ.
44. When Section 7 applies to a provision authorising service by post, it does so by supplementing without altering the requirements for service imposed by the legislation which contains the authorising provision. That is amply demonstrated by the reasoning and decision of the Court of Appeal in Freetown at paras. [36] to [43] as to the conformity of Section 7 with the **“Service of notices etc.”** provisions of Section 15 of the Party Wall etc. Act 1996.
45. Rule 41(5) of the 2008 Rules was made in the exercise of the rule-making power conferred by Section 78(2)(c) of the 1994 Act **“as to the service of documents”**. Section 7 serves to determine when a **“properly addressed”** invalidity application can be taken to have been served by post in accordance with the requirements of Rule 41(5). It does not serve to determine whether the letter containing the invalidity application was **“properly addressed”** in accordance with the requirements of Rule 41(5) in the first place. It is not, in itself, determinative of the answers to Questions (ii) or (iii) in the present case.

## Question (ii)

46. The Registrar maintains that:

There is nothing in Rules 11 or 12 (or any other Rule) which prevents the Registrar from serving an application for invalidity at the address of the proprietor as recorded in the International Register, where no UK address for service has yet been provided. Rule 12(1)(b) recognises that the Registrar may have to contact the proprietor at a different address to obtain an address for service, but it does not limit the Registrar's ability to serve documents at the proprietor's address in other circumstances where no address for service is available. In this respect, it is noted that it is well established that the Registrar has the power to regulate his own proceedings where the Rules are silent.

47. I do not accept these submissions for the following reasons.

48. The Registrar must act within the scope of the powers conferred upon him by the 1994 Act and the 2008 Rules. In doing so, he has an interstitial power to regulate procedure before him in a way that neither creates a substantial jurisdiction where none exists, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon him: Permanent Secretary v John & Pascal Ltd (HALLOUMI Trade Mark) (above) at para. [28] (Arnold J) citing Pharmedica GmbH's Trade Mark Application (FRISKIES Trade Mark) [2000] RPC 536 at p. 541 (Pumfrey J). For present purposes, that concept is reducible to the proposition that the Registrar can effect service of invalidity proceedings on a trade mark proprietor at an address outside the jurisdiction if, on a systematic interpretation of the legislative framework in which it is located, Rule 41(5) empowers him to do so; but otherwise not.

49. Rules 11 and 12 of the 2008 Rules are designed to ensure that a Rule 11(4) “**address for service**” is put in place “**for the purposes of any proceedings under the Act or these Rules**” involving persons of the kind identified in situations of the kind specified in Rule 11(1)(a) – (e). Rule 12(1)(b) helps the Registrar to achieve that result by enabling him to send an official notification to an address which is not a Rule 11(4) “**address for service**” for the particular purpose of securing compliance with the requirement for the filing of a Rule 11(4) “**address for service**”.

50. These Rules are the most recent in a line of legislative provisions stretching back to the last quarter of the nineteenth century. Requirements for the filing of an **“address for service”** were added by amendment in 1888 to what then became the Patents, Designs and Trade Marks Acts 1883 to 1888: **“Where an applicant for registration of a trade mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given”**: Section 62(6); and **“Where the opponent is out of the United Kingdom he shall give the comptroller an address for service in the United Kingdom”**: Section 69(6).
51. Rule 9 of the Trade Marks Rules 1906 made under the Trade Marks Act 1905 provided for every applicant for registration, opponent to registration and proprietor of a registered trade mark who did not reside or carry on business in the United Kingdom to give an address for service in the United Kingdom — if so required — **“and such address may be treated as the actual address of such applicant, opponent or ... proprietor for all purposes ...”**. Rule 13 of the Trade Marks Rules 1938 contained somewhat broader provisions to the same general effect as Rule 9 of the 1906 Rules.
52. The **“address for service”** requirements were expressed in mandatory terms in Rule 13 of the Trade Marks and Service Marks Rules 1986: **“(1) An applicant, opponent, agent, registered proprietor or registered user who does not reside or carry on business within the United Kingdom shall file an address for service within the United Kingdom. ... (4) In any case in which no address for service is filed, the Registrar shall treat as the address for service of the person concerned his trade or business address in the United Kingdom, if any. (5) Anything sent to any person at any address filed by him, or treated as by the Registrar, as his address for service shall be deemed to be properly sent. ...”**. However, there were no real sanctions for non-compliance.
53. Rule 10 of the Trade Marks Rules 1994 re-structured the **“address for service”** requirements and backed them up with sanctions for failure to comply with enforcement notices issued by the Registrar. The regime established by that Rule has been carried

forward (with adjustments) through successive versions of the Trade Marks Rules down to the present. It substantially expanded the breadth of the obligation to provide an **“address for service”** by no longer confining it to situations where the person concerned **“does not reside or carry on business in the United Kingdom”**.

54. I consider that the way in which the **“address for service”** requirements evolved over the period of 120 years preceding the commencement of the 2008 Rules supports the view that the requirements now set out in Rules 11 and 12 are designed to be binding and exhaustive **“as to the service of documents”** (per Section 78(2)(c) of the 1994 Act) **“for the purposes of any proceedings under the Act or these Rules”** (per Rule 11(1) of the 2008 Rules).
55. In Masri v Consolidated Contractors International SAL (No.4) [2009] UKHL 43 the House of Lords considered the scope and effect of the general words of CPR 71.2: **“(1) A judgment creditor may apply for an order requiring — (a) a judgment debtor; or (b) if a judgment debtor is a company or other corporation, an officer of that body, to attend court to provide information about — (i) the judgment debtor’s means; or (ii) any other matter about which information is needed to enforce a judgment or order.”**
56. The House unanimously decided for the reasons given in the Opinion of Lord Mance that the language of the Rule did not empower the Court to order a foreign director of a foreign company (Consolidated Contractors International SAL) to attend for examination in aid of the enforcement of a judgment debt amounting to US\$ 64m established by judgments on liability and quantum which the judgment creditor (Mr Masri) had obtained in proceedings he had brought against the company in the Commercial Court in London.
57. The subject matter of the request for examination was a judgment debt situated in England and the relevant Rule did not expressly exclude requests for examination of foreign directors of foreign judgment debtor companies. It was nonetheless determined that the making of orders of the kind requested was not within the legislative grasp or intendment of the Rule (para. [26]) having regard to the presumption against extra-

territoriality which applied to the interpretation of it (para. [16]) i.e. **“Unless the contrary intention appears ... an enactment applies to all persons and matters within the territory to which it extends, but not to any other persons or matters”** (para. 10). I note, in particular, that this conclusion was reinforced by consideration of the position relating to service out of the jurisdiction (para. [27]) as to which: **“It has long been established that service out of the jurisdiction requires express authorisation either by statute or in the Rules”** (para. [32]).

58. The well-established principle of statutory interpretation reflected in the presumption against extra-territoriality was recently considered in R (on the application of KBR, Inc v Director of the Serious Fraud Office [2021] UKSC 2 where Lord Lloyd-Jones JSC (delivering the unanimous Judgment of the Supreme Court) observed:

**[29] An intention on the part of Parliament to give extra-territorial effect to a statutory provision may also be implied, inter alia, from the scheme, context and subject matter of the legislation. (See, for example, Bilta (UK) Ltd v Nazir (No. 2) [2015] UKSC 23; [2016] AC 1, paras 212 – 213 per Lord Toulson and Lord Hodge.) ...**

**[31] ... It is clear that an intention to give a statute extra-territorial effect may be implied if the purpose of the legislation could not effectually be achieved without such effect (Cox v Ergo Versicherung AG [2014] UKSC 22; [2014] AC 1379, para. 29 per Lord Sumption). ...**

**[32] The question whether such a purposive reading is capable of rebutting the presumption against extra-territorial application will depend on the provisions purpose and context of the particular statute. It also requires consideration of the legislative history of the statute and whether Parliament can be taken to have intended that the purpose of the legislation be achieved by other means ...**

59. On applying the approach to interpretation envisaged by the House of Lords in Masri and the Supreme Court in KBR, Inc, I consider that Rule 41(5) does not by reason of the generality of the words in which it is expressed empower the Registrar to effect service of invalidity proceedings outside the jurisdiction. More specifically, from the perspective identified in para. [32] of KBR, Inc I take it to be the intended effect of the

legislation that service be “**achieved by other means**” i.e. in conformity with the requirements of the “**address for service**” Rules. And, so far as I am aware, the Registrar does not have any procedures in place for monitoring and complying with the requirements of The Hague Convention on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters (15 November 1965) or those of any other arrangements which have been made at the international level for the service abroad of such documents.

### **Question (iii)**

60. The Registrar submitted that it is not necessary to seek an address for service before serving an application for invalidation under Rule 41(5):

Serving a form TM26(1) gives the proprietor the opportunity of *joining* the proceedings and providing an address for service for future communications with the Registrar and the applicant, including the filing of evidence. Contrast this with the wording of Rule 11(1)(d) and 12(4)(d) which refer to the need for an address for service where the proprietor *opposes* the application for invalidation, and the consequence of failing to provide such an address being that the proprietor will be deemed to have withdrawn from the proceedings. This is consistent with an address for service being required before a Form TM8 and counterstatement can be accepted.

Moreover, the application of rr.11 and 12 as a necessary precondition of serving an application under r.41(5) could create a procedural dead end cul-de-sac. If the proprietor fails to provide an address for service and is deemed to have withdrawn from the proceedings then there would be no basis for the Registrar to then serve the TM26(1) on the proprietor. However, being deemed to have withdrawn from the proceedings may not be the same as the consequence set out in r.41(6) which also directs that “... *registration of the mark shall, unless the registrar otherwise directs, be declared invalid*”. Rule 42 opens the door for the filing of evidence only where a TM8 is filed. This could leave the registrar with an undefended application, but no admissions and no evidence on which to make a decision.

Further, given that following Brexit there are now more UK trade marks owned by overseas proprietors than by UK-based proprietors, this situation could place a major new resource burden on the Registrar at a time when resources are already

stretched. It is appreciated that this may be unavoidable if this were necessarily to achieve a fair result. However, it is submitted that this is not necessary.

Firstly, r.43 provides a remedy where an application for invalidation is sent to the proprietor's address, but is not received, and this is spotted within 6 months of the date of a default decision. Secondly, requiring an overseas proprietor to file an address for service in order to obtain a copy of the application could result in (A) a decision being taken on the application without the proprietor ever having sight of it, and (B) the proprietor having to invest in a UK address for service simply to find out whether it is worth defending the application.

If the answer to these points is that in the absence of the requested UK address for service the registrar could then serve the application at the proprietor's address, nothing will have been achieved by applying rr.11 and 12 first.

61. I agree that **'serving'** the application for a declaration of invalidity gives the trade mark proprietor the opportunity to join the proceedings commenced by the filing of the relevant Form TM26(I) and Statement of Grounds. For the reasons I have given above, I do not agree that **'service'** can be validly effected if and while there is no Rule 11(4) **"address for service"** in place **"for the purposes of any proceedings under the Act or these Rules"**.
62. It is important to keep in mind that valid service of process is necessary in order to satisfy the due notice requirements of Article 6(1) ECHR and the common law right to a fair trial. Which is why: **"... service of a claim form can be distinguished from other procedural steps. It performs a special function: it is the act by which the defendant is subjected to the court's jurisdiction. ... reliance on non-compliant service is not one of the instances of opportunism deprecated by the courts ... The need for particular care in effecting valid service ... is self-evident."** : R (on the application of The Good Law Project) v The Secretary of State for Health and Social Care [2022] EWCA Civ 355 at para. [41] per Carr LJ.
63. The concerns identified by the Registrar appear to me to be facets of the legislatively prescribed **"address for service"** requirements he is obliged to uphold and, so far as I can see, has no power to disapply. The Rules do not require overseas proprietors to file

a Rule 11(4) “**address for service**” in order to obtain a copy of the invalidity application, rather they require them to do so in order to enable the Registrar to provide them formally by way of service with a copy of the invalidity application at a Rule 11(4) “**address for service**” with clear directions as to what they must then do if they wish to oppose it.

64. Rule 43 does (within limits) enable an order for invalidity to be set aside by the Registrar if it was made on the basis of an invalidity application that appears not to have been received. It does not provide the Registrar with a justification for not “**properly addressing**” such applications to registered proprietors by way of service at a Rule 11(4) “**address for service**” in the first place.
65. I do not accept that the Registrar is powerless to proceed with an invalidity application in circumstances of the kind which existed in this case. If a Rule 11(4) “**address for service**” has not been provided during the “**registration procedure**” pursuant to the provisions of Rule 11(1)(a) and Rule 12(1), the Registrar may, as it seems to me, exercise the powers conferred upon him by Rules 12(1), 62(1) and 63 to initiate a process of notification which caters for the two possible outcomes noted in para. [36] above.
66. Rule 62(1) provides that: “ **... the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may — (a) require a document, information or evidence to be filed within such period as the registrar may specify; ...**”. Rule 63 further provides that: “**When the registrar gives directions under any provision of these Rules, the registrar may — (a) make them subject to conditions; and (b) specify the consequences of failure to comply with the directions or a condition.**”
67. In my view, there is room under these Rules for the Registrar to send a letter: informing the proprietor of a registered trade mark of the invalidity application which has been commenced in respect of it; directing the proprietor to notify the Registrar in writing whether the invalidity application is opposed and, if so, directing the proprietor under Rule 12(1) to provide a Rule 11(4) “**address for service**” for the purposes of the further

conduct of the invalidity proceedings under Rule 11(1)(d) and Rule 41; and comprehensively specifying the consequences of failure to comply with the directions thus given.

68. The direction in the official letter of 26 May 2021 which I have quoted in para. [32] above was, as I have already said, framed in terms that were not adequate to achieve that result.

#### **Conclusion: official letter of 26 May 2021**

69. The Proprietor's registered office in Melbourne was not an "address for service" to which the official letter of 26 May 2021 could have been "properly addressed". Even if it was delivered, the Invalidity Application it contained was not validly served by post at that address for the purposes of Rule 41(5) of the 2008 Rules.

#### **Default Notice: official letter of 12 August 2021**

70. In the absence of any response to the official letter of 26 May 2021, the Registrar sent the Proprietor a further letter by registered post dated 12 August 2021 containing a Default Notice in the following terms:

The official letter dated 26 May 2021 informed you that if you wished to continue with your international registration you should file TM8 and counterstatement on or before 26 July 2021.

As no TM8 and counterstatement have been filed within the time period set, Rule 41(6) applies. Rule 41(6) states that: '... registration of the mark shall, unless the registrar otherwise directs, be declared invalid.'

The registry is minded to treat the holder as not opposing the application for invalidation and declare the registration as invalid as no defence has been filed within the prescribed period.

If you disagree with the preliminary view you **must** provide full written reasons and request a hearing on, or before, **09 September 2021**. This **must** be accompanied by a Witness Statement setting out the reasons as to why the TM8 and counterstatement are being filed outside the prescribed period.

If no response is received, the registry will proceed to issue an undefended decision on the issue of failure to comply with the Rules governing the filing of a defence.

71. The letter was sent to the Proprietor at its registered office address in Melbourne. As with the letter of 26 May 2021, it was not copied to the Proprietor's "WIPO representative", Rotstein Commercial Lawyers.
72. With regard to proof of delivery, the Registry informed me in the run up to the hearing of the present Appeal that: no failed delivery notices were received on the file; according to Royal Mail the official letter of 26 May 2021 was delivered on 09 June 2001 to Melbourne where Australia Post delivered it, but the information relating to delivery is no longer available as it has been archived; information relating to delivery of the official letter of 12 August 2021 would be forwarded to me when a response was received (however no information as to that has since been provided). No 'signed for' record of delivery has been produced for either letter.
73. Sanyin Geljic (Taxation Principal of Koustas & Co. Pty Ltd) has confirmed in a Witness Statement filed on behalf of the Proprietor that there is no record of any correspondence from the UKIPO having been received at the Proprietor's registered office address in Melbourne prior to 26 April 2022 (when the Decision issued by the Registrar on 29 March 2022 arrived by post: see below). This is attributed to the office having been shut as a result of Coronavirus lockdowns with Government mandated 'work from home' arrangements in place for much of the calendar year 2021: **"It is also possible that some mail was misplaced and lost during this period"** (para. 4).

**Conclusion: official letter of 12 August 2021**

74. The Proprietor's registered office in Melbourne was not an **"address for service"** to which the official letter of 12 August 2021 could have been **"properly addressed"**. Even if it was delivered, the Default Notice it contained was not validly served by post at that address for the purposes of Rule 41(6) of the 2008 Rules.

### **Declaration of Invalidity: 29 March 2022**

75. On 29 March 2022, Mr Raoul Colombo acting on behalf of the Registrar of Trade Marks issued a Decision under Rule 41(6) declaring International Registration (UK) No. WO1541304 invalid and directing that it be removed from the Register and deemed never to have been made.
76. The Decision recorded that there had been no response from the Proprietor to either of the official letters dated 26 May 2021 and 12 August 2021. Both letters were identified in the Decision as having been sent by “signed for delivery”. The declaration of invalidity was made on the premise that the Invalidity Application and the Default Notice had been validly served by post at the Proprietor’s registered office address in Melbourne.

### **Appeal against the Registrar’s Decision dated 29 March 2022**

77. The Proprietor now appeals to an Appointed Person under Section 76 of the 1994 Act contending that the Hearing Officer decided to treat it as not opposing the Invalidity Application under Rule 41(6) without being “**fully aware of all the facts and circumstances of the case**”. The thrust of its case on appeal is that the Hearing Officer invalidated its International Registration (UK) in the mistaken belief that it had been given a proper opportunity to defend the registration against the Invalidity Application and had failed for no good and sufficient reason to do so within the period of 2 months prescribed by that Rule.
78. It is, in principle, open to the Proprietor to challenge the Hearing Officer’s Decision for being unsustainable in the light of facts and circumstances which needed to be considered and addressed in order to arrive at a just and fair determination c.f. Consolidated Developments Ltd v Cooper (TIN PAN ALLEY Trade Mark) [2018] EWHC 1727 (Ch) (Henry Carr J) at paras. [3], [6], [10(i)] and [11] to [17].
79. The evidence on which the Proprietor relies in support of its Appeal has been filed without objection. It establishes that Koustas & Co Pty Ltd received the Registrar’s

Decision dated 29 March 2022 by post in Australia on 26 April 2022 and forwarded it to the Proprietor the same day. This, according to the evidence filed on its behalf, was the first that the Proprietor knew of the existence of the Invalidity Application. It immediately took steps to instruct Marks & Clerk LLP to act on its behalf in the Registry proceedings. The papers before me indicate that they filed a Form TM33 (Appointment or change of representative) at the UKIPO by email at 16:52 GMT on 26 April 2022 with their London office address identified as the Proprietor's Rule 11(4) **"address for service"**.

80. At their request, the Registrar sent them a copy by email of the Applicant's Form TM26(I) and Statement of Grounds on 24 May 2022. This was, so far as I can see, the first point in time at which a copy of the Invalidity Application could be taken for the purposes of Rule 41(5) to have been **"sent"** by the Registrar to the Proprietor at a Rule 11(4) **"address for service"**. I consider that the manner and circumstances in which the Registrar delivered the Invalidity Application by email to the Proprietor's trade mark attorneys of record satisfied the requirements for permissible electronic communication under Rule 79(1) and can be taken to have rectified the procedural irregularity which had previously occurred with regard to service of it under Rule 41(5). Two days later, on 26 May 2022, the Proprietor's attorneys filed a Form TM8 (Defence and counterstatement) on its behalf. Measured from the date on which the Invalidity Application had been **"sent"** to them by the Registrar, this was well within the two month period specified in Rule 41(6).
81. If the attempt to effect service of the Invalidity Application out of the jurisdiction by means of the official letter of 26 May 2021 was (as I consider it was) invalid, the period for filing a defence to the Applicant's claim for invalidity can and, in my view, should be taken to have commenced under Rule 41(5) on 24 May 2022 and been completed under Rule 41(6) on 26 May 2022.
82. I was at one stage minded to act upon the evidence filed by the Proprietor by setting aside the Hearing Officer's Decision and returning the parties to the position which existed immediately prior to the issue of the Default Notice so as to enable them to present all aspects of their respective arguments as to what should and should not

happen next under Rule 41(6) for substantive determination by a different hearing officer.

83. As well as opening up the general question whether there were ‘extenuating circumstances’ or ‘compelling reasons’ for permitting the Proprietor to defend the Invalidity Application, that would have given rise to a substantial issue as to the operative effect of Rule 76 on the one hand and the operative effect of Rules 41(6) and 77(5) on the other. Rule 76 provides that: **“(1) The registrar shall extend any time limit in these Rules where the registrar is satisfied that the failure to do something under these Rules was wholly or mainly attributed to a delay in, or failure of, a communication service. ... (3) In this rule “communication service” means a service by which documents may be sent and delivered and includes post, facsimile, email and courier.”**
84. It would also have been liable to give rise to an application by the Proprietor for extension of the two month period prescribed by Rule 41(6). That is a time limit listed in Schedule 1 to the 2008 Rules and non-compliance is an irregularity which can only be rectified on the restricted basis stated in Rule 77(5): **“A time limit listed in Schedule 1 (whether it has already expired or not) may be extended ... if, and only if, — (a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the registrar, the Office or the International Bureau; and (b) it appears to the registrar that the irregularity should be rectified.”**
85. On further consideration I have come to the conclusion that it would not be reasonable or realistic to send the parties back to the Registry to pursue their arguments in relation to all of these various matters in circumstances where I have decided on this Appeal that the Invalidity Application and the Default Notice were in any event not validly served and that the procedural irregularity which occurred with regard to service under Rule 41(5) has been rectified.

## **Determination**

86. For the reasons I have given the Proprietor's Appeal is allowed, the Hearing Officer's Decision and Order are set aside and the Applicant's claim for invalidity of International Registration (UK) No. WO1541304 is remitted to the Registrar for further processing in accordance with the provisions of the 1994 Act and the 2008 Rules on the basis that the procedural irregularity with regard to service of the Invalidation Application under Rule 41(5) was rectified in May 2022.
87. Since I consider that the usefulness of the proceedings before me is from a practical point of view liable to depend on the outcome of the proceedings as whole, I direct that the costs of the Appeal be treated as costs incurred in the registry proceedings and dealt with by the Registrar in the usual way at the conclusion of the claim for invalidity.

Geoffrey Hobbs QC

16 August 2022

Ms Kerstin Gilbert of Marks & Clerk LLP appeared on behalf of the Proprietor.

Mr Piers Strickland of Waterfront Solicitors LLP appeared on behalf of the Applicant.

Mr Mark King, Deputy Director (Tribunal), provided a written statement of position on behalf of the Registrar.