

O/1015/24

TRADE MARKS ACT 1994

IN THE MATTER OF THE FOLLOWING TRADE MARK REGISTRATION NO.
UK00918140782:

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IN CLASSES 9, 35, 36 AND 42

IN THE NAME OF X-SPOT GLOBAL LIMITED

AND

APPLICATION NO. 94945 TO RECTIFY THE REGISTER

BY HUOBI GLOBAL LIMITED

BACKGROUND AND PLEADINGS

1. On 23 January 2024, the comparable mark shown on the cover page of this decision was assigned from Huobi Global Limited (“the applicant”) to X-spot Global Limited (“the proprietor”) for the following goods and services:

Class 9 Computer software for blockchain technology; Computer software for cryptocurrency; Computer software for digital currencies; Computer software for cryptocurrency asset management; Encoded magnetic cards; Computer peripheral devices; Computer software for e-wallets; Time recording apparatus; Pedometers; Data communications apparatus; Digital photo frames; Eyeglasses; Batteries, electric; Data communication instruments.

Class 35 Outdoor advertising; Business information; Accounting; Compilation of information into computer databases; Personnel recruitment; On-line advertising on a computer network; Marketing; Organization of exhibitions for commercial or advertising purposes; Provision of an on-line marketplace for buyers and sellers of goods and services; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.

Class 36 Currency exchange services; Investment of funds; Banking; Financial guarantee services; Financing services; Issuance of tokens of value; Stock exchange quotations; Real estate management; Providing financial information via a web site; Electronic funds transfer.

Class 42 Computer programming; Scientific research; Authenticating works of art; Platform as a Service [PaaS]; Installation of computer software; Data conversion of computer programs and data [not physical conversion]; Software as a service in relation to computer software for blockchain technology (SaaS); Provision of online computer software for cryptocurrency; Provision of online computer software for digital

currencies; Provision of online computer software for cryptocurrency asset management; Industrial design; Cloud computing.

2. The comparable mark has a filing date of 18 October 2019 and a registration date of 22 May 2020. It was also not applied for in the UK in the normal way. Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date and registration date of the EUTM from which it derives.

3. On 13 May 2024, the applicant filed a Form TM26R ("Application to rectify the register") and a supporting witness statement, claiming that the register should be rectified in accordance with section 64 of the Trade Marks Act ("the Act") because "there is no valid evidence of the assignment of ownership dated 12/01/2024".

4. As the application for rectification was made by a person other than the registered proprietor, it was necessary to serve the application on the proprietor in accordance with rule 44(2) of the Trade Marks Rules 2008 ("the Rules"). Accordingly, on 7 June 2024, the Registry served the Form TM26R and its supporting witness statement on the proprietor, setting a deadline of 7 August 2024 to file a counterstatement and evidence or submissions.

5. On 28 August 2024, an official letter was issued stating that no counterstatement had been received by the above deadline and therefore it was the Registry's preliminary view to treat the rectification as undefended. The letter also stated that if either party disagreed with the preliminary view, they were to request a hearing on or before 11 September 2024. However, neither party requested a hearing.

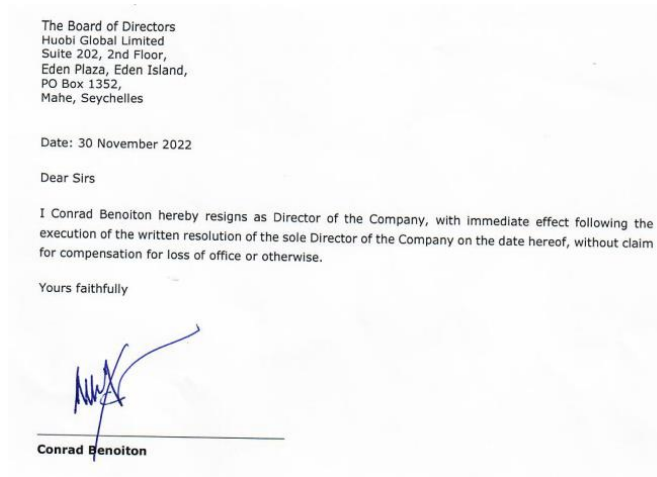
EVIDENCE

6. The applicant is represented by Forresters IP LLP, and its evidence consists of the witness statement of Paolo Andrea Pravadelli dated 3 May 2024. Mr Pravadelli is the

director of the applicant, a position which he has held since 30 November 2022. Mr Pravadelli's statement is accompanied by 10 exhibits. I note the following from the evidence:

- a) The comparable mark was created from EU registration number 018140728 ("the original EUTM").
- b) The original EUTM was filed in the name of the applicant on 18 October 2020. This is confirmed within the EUIPO filing receipt contained within **exhibit 1**.
- c) The original EUTM was registered on 22 May 2020, and its EUIPO registration certificate is contained within **exhibit 2**.
- d) Both the EUIPO filing receipt and registration certificate show that the owner of the original EUTM was the applicant.
- e) **Exhibit 3** contains screenshots from the EUIPO database. The database shows that a "total transfer" was recorded on "04/10/2022". Therefore, Mr Pravadelli states that the applicant remained as the registered owner of the original EUTM up until 4 October 2022, which means that they were the legal owner of that mark on IP completion day (31 December 2020).
- f) **Exhibit 4** contains a copy of the original EUTM's "Recordal application EUTM Total Transfer" filed at the EUIPO on 23 September 2022. It shows that the current owner was the applicant, and that the original EUTM was to be transferred to the proprietor.
- g) **Exhibit 5** contains a copy of an assignment agreement for the original EUTM dated 22 September 2022, between the director of the applicant (Conrad Serge Benoiton) and the director of the proprietor (Ma Kwan Ho).
- h) I also note that the assignment agreement contained within **exhibit 5** declares that the assignor (the applicant) assigned all the "rights title and interest and

- m) Mr Pravadelli states that at no point in time has the applicant had a director named “Conrad Beniton”, which is the name stated on the above agreement.
- n) Mr Pravadelli also states that the applicant has never represented itself as “HUOBI GLOBAL LIMITD”, which is the company name stated on the above agreement next to Conrad Beniton’s signature.
- o) **Exhibit 9** contains a signed registration letter, dated 30 November 2022, by Conrad Benoiton to the Board of Directors for the applicant, as follows:




The Board of Directors
Huobi Global Limited
Suite 202, 2nd Floor,
Eden Plaza, Eden Island,
PO Box 1352,
Mahe, Seychelles

Date: 30 November 2022

Dear Sirs

I Conrad Beniton hereby resigns as Director of the Company, with immediate effect following the execution of the written resolution of the sole Director of the Company on the date hereof, without claim for compensation for loss of office or otherwise.

Yours faithfully



Conrad Beniton

- p) **Exhibit 10** contains an extract from the Seychelles Financial Services Authority’s Register of Directors. Conrad Serge Benoiton’s “date of cessation” as director for the applicant is listed as “30/11/2022”. I also note that Paolo Andrea Pravadelli has a “date of appointment” of “30/11/2022”.
- q) Mr Pravadelli states that Conrad Benoiton was not authorised to execute the agreement contained within **exhibit 8** since he was no longer a director of the applicant, and that the authenticity of the agreement is questioned by the applicant.
- r) Mr Pravadelli also states that the applicant is also pursuing other legal actions against the proprietor, including the alleged fraudulent signature and evidence shown above.

DECISION

7. The power to rectify the register is set out in section 64 of 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.”

Sufficient interest

8. The applicant must have a sufficient interest to apply for rectification. The applicant was the former proprietor of the trade mark before the transfer of ownership was recorded. I therefore accept that the applicant has sufficient interest.

Is it an error capable of correction?

9. In order to determine this, both assignment agreements need to be assessed.

The 2024 Assignment

10. Where an application is filed to record the assignment, the information provided on the Form is taken at face value. The Registrar does not investigate or otherwise seek to establish the legality of the claim to change of ownership unless the recordal of change of ownership is challenged. When the ownership is challenged, it is incumbent on the proprietor to show that the mark was transferred to the proprietor under a valid assignment. Section 24(3) of the Act is as follows:

“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.”

11. When the proprietor filed the Form TM16, they ticked the box that indicated that an assignment had taken place. Therefore, on this basis, for the assignment to be effective, it must be in writing and signed by the assignor (or their representative). This was evidenced as an “Assignment of Trademarks” dated 12 January 2024, which was filed alongside the Form TM16. However, I note the following issues with the assignment document:

- 1) The agreement was signed by “Conrad Beniton”.
- 2) Conrad Benoiton was once the director of the applicant, and the correct spelling of his name is evidenced in **exhibits 5, 9 and 10**.
- 3) Conrad Benoiton resigned as director of the applicant on 30 November 2022, as evidenced by **exhibits 9 and 10**.
- 4) Therefore, the agreement contains the misspelling of a director’s name, which at the time the agreement was executed and signed, was no longer acting as a

director (as they had resigned), and he therefore did not have the power to assign the comparable mark.

12. Taking all of the above into account, I find that the “Assignment of Trademarks” agreement dated 12 January 2024 is not legally valid and therefore cannot be relied upon by the proprietor.

The 2022 Assignment

13. As the 2024 assignment cannot be relied upon, I will determine if the 2022 agreement covered the assignment of the comparable mark.

14. Albeit Mr Pravadelli drew my attention to section 16 of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I note that this section is mirrored by Schedule 2A, paragraph 16 of the Act. Mr Pravadelli argues that this section establishes that a legal transfer and assignment of an EU trade mark registration after 31 December 2020 does not cover the legal transfer and assignment of its comparable UK registration. However, I note that the wording of Schedule 2A, paragraph 16 of the Act is as follows:

“16(1) This paragraph applies where before IP completion day an existing EUTM (or any right in it) is the subject of an assignment (a “relevant assignment”) which immediately before IP completion day is not recorded in the EUTM Register.

(2) Section 25 applies in relation to a relevant assignment as if it were a registrable transaction affecting a comparable trade mark (EU), subject to the modification set out below.

(3) An application under section 25(1) may only be made by—

(a) a person claiming to be entitled to an interest in or under a comparable trade mark (EU) by virtue of a relevant assignment of the corresponding EUTM; or

(b) the proprietor of the comparable trade mark (EU).”

15. Therefore this section of the Act covers assignments that occurred before IP completion day, and in this case, the assignment of the original EUTM took place after IP completion day. Consequently, this section is not relevant.

16. Whilst the content of the assignment agreement states that “all the rights, title and interest and obligations which arise” from the original EUTM were assigned to the proprietor, the “rights arising” from the original EUTM would not have covered its comparable mark. This is on the basis that the 2022 assignment agreement was signed 21 months after IP completion day, when the comparable mark was created from the original EUTM, forming two distinct and separate property rights. If the applicant wanted to assign the comparable mark to the proprietor, they would have included and listed this right within the 2022 assignment agreement. However, only the original EUTM was listed.

17. Moreover, the last paragraph of the assignment agreement states that “*the parties have executed this Agreement as of the date hereinbefore set forth an appoint as Representative before the EUIPO, Ms. Vali Sakellarides*”. This agreement was also only sent to the EUIPO, which resulted in the transfer of ownership shown in **exhibit 6**. Therefore, if this agreement intended to also assign the comparable mark, it would have been submitted before the UKIPO (which it was not).

CONCLUSION

18. As neither of the assignment documents, dated 2022 and 2024, can be relied upon by the proprietor, the rectification has succeeded.

19. The register will be rectified to record Huobi Global Limited as the proprietor, as was the position prior to the filing of the contested Form TM16.

COSTS

20. No request for costs has been made and I make no order in this regard.

Dated this 24th day of October 2024

L FAYTER

For the Registrar