

BLO/319/20

TRADE MARKS ACT 1994

IN THE MATTER OF

Registration No. 2 246 267

In the name of Gay Christie

And application for rectification under No 84816 by

Jill Jacobs

## **CORRECTION OF DECISION DATED 11<sup>TH</sup> JUNE 2020.**

1. It has come to my attention that the decision issued 11<sup>th</sup> June 2020 (BL O/319/20) contained two repeated typographical errors. The reference to the trade mark LOTTIE BERK should have read LOTTE BERK and the reference to LOTTIE BERK EXERCISE COMPANY LIMITED should have read LOTTE BERK EXERCISE COMPANY LIMITED. These errors are clearly capable of correction under Rule 74 of the Trade Marks Rules 2008. However, as they appear throughout the previous decision, the decision in full is hereby corrected and re-issued. This does not reset the appeal period which runs from the date of the original decision, that is, 11<sup>th</sup> June 2020.

### **Background**

2. The trade mark LOTTE BERK was applied for on 21<sup>st</sup> September 2000 in the name of Lotte Berk Exercise Company Limited under number 2 246 267 and was registered on 29<sup>th</sup> June 2001 in respect of *physical fitness instruction and teaching; health education; provision of health club facilities; provision of instruction courses relating to health and fitness; advisory and consultancy services relating to all the aforesaid services* in Class 41.
3. On 18<sup>th</sup> January 2019, an application to amend the register to record a change of ownership of the trade mark was filed on Form TM16 by Murgitroyd & Company, the representatives of Gay Christie. The effective date of assignment was 1<sup>st</sup> December 2016. The assignment was duly recorded in the register and had the effect of assigning the owner of the registered trade mark from Lotte Berk Exercise Company Limited to Gay Christie.
4. On 19<sup>th</sup> March 2019, Hanna IP on behalf of Jill Jacobs, filed an application to rectify the register, stating that the application for assignment was invalid as the assignor, Lotte Berk Exercise Company Limited had been dissolved at the effective date of assignment and as such was unable to carry out such an assignment. The owner of the trade mark should therefore revert to the assignor.
5. As the application for rectification was made by a person other than the registered proprietor, it was necessary to serve the application on the registered proprietor in accordance with rule 44(2) of the Trade Marks Rules 2008. This was done on 19<sup>th</sup> June 2019 to the address for service recorded on the Register and it was stated in the accompanying letter that the registered proprietor would be allowed six weeks in which to file a Form TM8 and counterstatement. If none was filed, then any opposition to the application

for rectification may be deemed withdrawn. The registered proprietor failed to respond and therefore the application for rectification has not been contested. Even though it is not contested, I must still be satisfied that the register does stand in error before I can allow any rectification.

## EVIDENCE

6. In a witness statement, dated 21<sup>st</sup> May 2019, Mr John Hanna of Hanna IP explained:
  - Lotte Berk Exercise Company Limited applied for voluntary dissolution of the company at Companies House via the filing of a form DSO1 (shown at Annex A);
  - A First Gazette Notice for voluntary strike off of the company, dated 20<sup>th</sup> September 2016 as issued by the Registrar of Companies is shown at Annex B.
  - A Final Gazette Notice showing the effective date of dissolution of this company (6<sup>th</sup> December 2016) is shown at Annex C.
  - Annex H contains information from proceedings undergoing at the EUIPO. Contained therein is the Form TM16 filed at the UK IPO together with the underlying transfer document detailing the transfer of the LOTTE BERK trade mark from the company to Gay Christie. This transfer document is dated 17<sup>th</sup> January 2019 and is claimed to have a retrospective effect, with the effective date of transfer purported to be 1<sup>st</sup> December 2016.
7. Mr Hanna also filed written submissions which I will not summarise but which have been fully taken into account.

## DECISION

8. Section 64 of the trade Marks Act 1994 deals with the rectification of the register. It reads:

“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.”

9. I note that the applicant for rectification is currently defending its EU Trade Mark Application in opposition proceedings brought by the registered proprietor. As such, it is clear that it has sufficient interest in bringing this application for rectification.

## The assignment

9. In this regard, I note the contents s.24 of the Trade Marks Act 1994 which relates to assignments of registered trade marks. The relevant sub-sections state (emphasis added in bold):

24. - (1) A registered trade mark is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property.

(1A)<sup>1</sup> A contractual obligation to transfer a business is to be taken to include an obligation to transfer any registered trade mark, except where there is agreement to the contrary or it is clear in all the circumstances that this presumption should not apply. It is so transmissible either in connection with the goodwill of a business or independently.

(2) An assignment or other transmission of a registered trade mark may be partial, that is, limited so as to apply-

(a) in relation to some but not all of the goods or services for which the trade mark is registered, or

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<sup>1</sup> 31 Added by the Trade Marks Regulations 2018 (SI 2018/825) (SI 2018/825) into force 14 January 2019

(b) in relation to use of the trade mark in a particular manner or a particular locality.

**(3) 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.**

Except in Scotland, this requirement may be satisfied in a case where the assignor or personal representative is a body corporate by the affixing of its seal.

(4) The above provisions apply to assignment by way of security as in relation to any other assignment.

(5) A registered trade mark may be the subject of a charge (in Scotland, security) in the same way as other personal or moveable property.

(6) Nothing in this Act shall be construed as affecting the assignment or other transmission of an unregistered trade mark as part of the goodwill of a business.

10. Further, I note the contents of a decision of the IPO in BL O/205/15, at paragraph 26 which states:

“26. .... Given the express provision within section 24 of the Act, it is clear to me that in order for a trade mark registration to be assigned, it must be executed in writing. It will then become effective once it is signed or at an agreed subsequent date, and not retrospectively”.

11. The situation in this previous decision concerned an oral assignment at an earlier date than that shown on the written documentation. Hence the claim for a retrospective effect (which was denied).

12. In the case before me, the registered proprietor has filed no defence. Crucially, there is no evidence before me (written or otherwise) which explains what gave rise to the retrospective effect of the assignment. In the light of no defence nor evidence to the point, I consider that the assignment cannot be retrospective in nature and as such took effect from the date of the document of transfer, namely 17<sup>th</sup> January 2019. The assignor company had been dissolved for some considerable time prior to this (the effective date being 6<sup>th</sup> December 2016). In view of the forgoing, I am prepared to accept that the register does stand in error and that it is right that the error be corrected. The error is that the assignment is invalid.

13. I therefore direct that the register be corrected; that the name of Gay Christie shall be removed as proprietor and that Lotte Berk Exercise Company Limited shall be substituted in its place. The effect of my decision is that the recordal

of the change of ownership to Gay Christie shall be deemed never to have been made.

## **COSTS**

14. The applicant for rectification has been successful and so is entitled to a contribution towards its costs. I award the applicant the amount of £300 to reflect the evidence filed in support of its application.

15. I therefore order Lotte Berk Exercise Company Limited to pay Jill Jacobs the sum of £300. This sum is to be paid within two months of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 11<sup>th</sup> day of June 2020**

**Louise White**

**For the Registrar  
The Comptroller-General**