

O-760-21

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK REGISTRATION NUMBERS 3185498, 3185641 and 3080588
IN THE NAME OF KORDA DEVELOPMENTS LIMITED
AND
APPLICATION FOR RECIFICATION THERETO UNDER NO. 84834
BY FOX HOLDINGS LTD

BACKGROUND

1. The trade marks listed in the cover page of this decision (“contested marks”) stand registered in the name of Korda Developments Limited (“Korda”).
2. On 29 January 2021, Birkett Long LLP (“Birkett”), acting on behalf of Korda, filed a Form TM16 requesting to record the transfer of ownership of the contested marks from Fox Holdings Ltd (“Fox Holdings”) to Korda. In support of the application, Birkett also filed a copy of the deed dated 28 January 2021 that assigned the contested marks from Fox Holdings to Korda. On 9 February 2021, Neil Ashley of Paladin, representing Fox Holdings, filed another TM16 to record the transfer of the contested marks from Fox Holdings to Clifford Royston Fox (“Clifford Fox”). As Mr Ashley alleged that the contested marks were unlawfully transferred to Korda, the Registry advised Mr Ashley to file a TM26R to rectify the register to show Fox Holdings as the proprietor of the contested marks. Accordingly, a Form TM26R was filed on 30 March 2021. Fox Holdings provides the following details in support of the application for rectification:

“The trade marks were fraudulently transferred to Korda Developments. That transaction has since been unwound.”

3. As the application was made by a person other than the proprietor, it was necessary to serve the application on the proprietor in accordance with Rule 44(2) of the Trade Marks Rules 2008. The Registry, therefore, served the Form TM26R on Birkett. In a letter dated 10 May 2021, Birkett responded to the application; the relevant details from their letter are given below:

“We take issue with the apparent and unsubstantiated allegation of fraud made on the form. We do, however, wish to have the assignment rescinded and hope that this brief note will relieve the lawyer acting for Fox Holdings limited of the need to substantiate his allegation. Please therefore take this note as permission to restore the marks to the ownership of Fox Holdings limited.”

EVIDENCE

4. In support of the application for rectification, Fox Holdings filed a copy of a deed of assignment executed between Fox Holdings and Clifford Fox on 4 February 2021 transferring the contested marks to Clifford Fox.

DECISION

5. 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.”
6. Based on the evidence, I am prepared to accept that Fox Holdings has sufficient interest to bring these proceedings.
7. As Fox Holding has challenged the validity of the agreement dated 28 January 2021, and in response, Korda has offered to rescind the agreement, it is reasonable to infer that there is an intention of the parties to void the agreement. Korda also does not dispute who is the rightful owner of the contested marks. In the circumstances, the recordal of Korda as the proprietor of the contested marks is an error on the Register.
8. The evidence also shows that, on 4 February 2021, Fox Holdings assigned the contested marks to Clifford Fox. Therefore, the register must be further amended to show Clifford Fox as the current proprietor of the contested marks.

CONCLUSION

9. I direct that the recordal of the assignment of the contested marks from Fox Holdings Ltd to Korda Developments Ltd be considered null and void. I also direct that the contested marks should be recorded as being in the ownership of Fox Holdings Ltd. The register should be further updated to record the assignment of the contested marks from Fox Holdings Ltd to Clifford Royston Fox with 4 February 2021 as the effective date of assignment.

COSTS

10. I do not consider that the circumstances of the case justify an award of the costs, particularly bearing in mind that Korda had no objection to the application for rectification. I, therefore, make no award of costs.

Dated this 13th day of October 2021

Karol Thomas

For the Registrar

The Comptroller-General