

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION N° 11003
BY NORTH WIND YARD S.L. FOR
RECTIFICATION OF THE ENTRY ON THE REGISTER
IN RESPECT OF TRADE MARK N° 2169583
STANDING IN THE NAME OF FULLER DEVELOPMENTS LIMITED AND ALSO FOR
A DECLARATION OF INVALIDITY

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in respect of Trade Mark N° 2169583
standing in the name of FULLER DEVELOPMENTS LIMITED

BACKGROUND

1. Trade Mark registration N° 2169583, NORTHWIND, was applied for on 17 June 1998 in the name of Fuller Developments Limited and was registered on 4 December 1998 in that name.
2. By an application filed 6 August 1999, North Wind Yard S.L, (“the applicants”), applied for rectification of the register, under section 60 of the Act, by the substitution of the name of the applicants for that of the registered proprietor, i.e. from Fuller Developments Limited to North Wind Yard S.L. This is based on their claim that the registered proprietor was not in fact the legal proprietor but their agent/representative in the United Kingdom. In the alternative, the applicants state that the registered mark should be declared invalid under Section 47 of the Trade Marks Act 1994 as it was registered contrary to Sections 3(3)(b), 3(6) and 5(4) of the Act.
3. A copy of the application was sent to the registered proprietors’ agent on 23 August 1999, setting a period of three months within which the registered proprietor could file a defence. Nothing was received from the registered proprietor by the due date and subsequently, on 8 March 2000, the registrar wrote to the parties stating that as no defence had been filed the applicants were being invited to file evidence to substantiate their case.
4. On 10 March 2000 the agent for the registered proprietor wrote stating that they had never received the registrar’s letter of 23 August 1999 and that they knew nothing of this application. They requested that the period for filing a defence be reset. The Trade Mark Registry then corresponded with the Royal Mail who confirmed that the letter, which had been sent by recorded delivery, had been delivered and signed for at the office of the agent for the registered proprietor. The Trade Mark Registry therefore declined to reset the period for filing a defence and the application proceeded accordingly.
5. The applicants subsequently filed evidence. This comprised an affidavit by Enrique Ribot, Managing Director of the applicants, and seven exhibits. These show that the applicants are the registered proprietor of registered Spanish trade mark N° 855466, N W NORTH-WIND and device. The exhibits also demonstrate the relationship between the applicants and registered proprietor, although no actual agency agreement was exhibited. By way of illustrating this relationship, amongst the exhibits there is a document, which forms part of exhibit ER5, which is an agreement relating to the sale of a Northwind 50 yacht “Silver Lining”, dated 18 September

1998, and referring to an earlier agreement dated 18 December 1996. The parties to this agreement are Mr Michael Oram (the purchaser), North Wind Yard S.L. (the applicants), Northwind Yachts Limited, Deacons Boatyard Limited and Fuller Developments Limited (the registered proprietor). In this agreement it clearly states that Northwind Yachts Limited, Deacons Boatyard Limited and Fuller Developments Limited are acting as agents for North Wind Yard S.L. in the supply of this yacht. Further exhibits suggest that there are links between these three companies and that Mr G R Fuller, a director of Fuller Developments Limited, was involved as an agent in the supply of at least four Northwind yachts, built by the applicants for sale to purchasers in the United Kingdom.

6. No hearing was requested and therefore this decision has been taken after a careful study of the pleadings and evidence filed in these proceedings.

DECISION

7. I first turn to consider the grounds of rectification under Section 60 of the Act, which states:

60. - (1) The following provisions apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Convention country.

(2) If the proprietor opposes the application, registration shall be refused.

(3) If the application (not being so opposed) is granted, the proprietor may-

(a) apply for a declaration of the invalidity of the registration, or

(b) apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.

(4) The proprietor may (notwithstanding the rights conferred by this Act in relation to a registered trade mark) by injunction restrain any use of the trade mark in the United Kingdom which is not authorised by him.

(5) Subsections (2), (3) and (4) do not apply if, or to the extent that, the agent or representative justifies his action.

(6) An application under subsection (3)(a) or (b) must be made within three years of the proprietor becoming aware of the registration; and no injunction shall be granted under subsection (4) in respect of a use in which the proprietor has acquiesced for a continuous period of three years or more.

8. First of all I must determine whether North Wind Yard S.L. have the qualifying status required by Section 60(1) of the Act. That is, are they, as applicants for rectification, the proprietor of the mark in a Convention country, and is the registered proprietor their agent or representative?

9. The applicants are domiciled in Spain and are the registered proprietors of a Spanish trade mark registration. Although not identical to the registration in suit, the Spanish trade mark does contain the words NORTHWIND as the dominant feature. As such they do, in my view, qualify as the proprietor of a similar trade mark in a Convention country (see TRAVELPRO Trade Mark [1997] RPC 864).

10. From the evidence supplied I am satisfied that the mark NORTHWIND is used in relation to yachts and is associated with the applicants, normally with some appellation common in this field. That is, with a non-distinctive element which relays to persons with knowledge of this field a specific identifier, e.g. the numeral 50 which relates to the overall length of the yacht hull, and thus the mark NORTHWIND acts as the identifier for a design of yacht in the 50 foot class. The evidence of this is in the form of a promotional brochure produced by the applicants, an advertisement and two articles in the magazine "YACHTING WORLD" (January 1997) and several builders certificates. I am satisfied therefore that persons with a knowledge of yachting will associate the mark NORTHWIND with the applicants.

11. Whether the registered proprietor is or was the agent or representative for the applicants is a little more difficult to determine. As I have said earlier, the applicants have not provided a copy of a formalised written agency agreement between the applicants and the registered proprietors, only evidence in the form of letters between the parties and purchase agreements. Further, the applicants refer to the "Fuller Group of Companies", and whilst it can be shown that members of the Fuller family are directors of a variety of companies the applicants have not shown that such a "Group of Companies" exists in a formal sense. Thus the letters are from two people, whom the applicants allege are representing the registered proprietor, under a variety of company letterheads, none of which is that of Fuller Developments Limited. However, in the documents which constitute the sale agreement for the yacht "Silver Lining", referred to earlier, Fuller Developments Limited are clearly identified as one of three companies acting as agent for the applicants. Additionally, in a letter dated 5 November 1998, a Mr N W Guenier writes to the applicants on behalf of Northwind Yachts Limited (one of the other companies identified as agents) stating:

"Please check your records. We are no longer your Agents and have not ordered a Northwind 55."

12. In a later letter, dated 14 October 1999, after the date this application for rectification was made, Mr Guenier clarifies the situation in the following words:-

"Northwind Yachts Limited ("the Company") Registered in Jersey on 20.8.90. Registration No: 48159.

I write in order to clarify the Company's relationship with yourselves. For the record I am both a director and co-shareholder (with Mr. Fuller) in the Company.

The Company was incorporated to act as agents of Northwind Yard SL and its predecessors in title to the Northwind name, as agents for yacht sales in the UK.

From time to time certain activities in relation to the UK agency were undertaken by two other Companies (Fuller Development Limited and Deacons Boatyard Limited), in which Mr. Fuller is a majority shareholder or beneficial owner. These activities were never formalised in writing - but throughout, the companies at all times acting as agents for Northwind Yachts Limited in fulfilling their agency arrangements with Northwind Yard SL, and its predecessors in title to the Northwind name. At no stage were any of these companies trading on their own behalf in relation to any sales or representations they may have made or purported to make in relation to the Northwind yachts produced by Northwind Yard SL.”

13. From the evidence before me, it appears that Mr G R Fuller is involved with all three companies, and any agency agreement had been with Northwind Yachts Limited. Northwind Yachts Ltd then contracted work on an informal agency basis to Fuller Developments Limited (the registered proprietor). Northwind Yachts Limited, in effect, had a sub-agency arrangement with Fuller Developments Limited. In all of the circumstances, I am prepared to accept that Fuller Developments Limited were, at the material time of filing the trade mark in suit, acting as an agent for North Wind Yard S.L. *via* Northwind Yachts Limited, and as such, on the balance of probability, were fully aware of the origins of the mark NORTHWIND.

14. The applicants were unaware that the mark had been applied for in the United Kingdom and did not therefore oppose the application for registration as specified by section 60(2) of the Act. After registration, by letter dated 10 March 1999, the registered proprietor notified the applicants for rectification that the mark was registered and stated that the applicants would be denied use of the mark in the United Kingdom. This letter is exhibited in the applicants evidence, exhibit ER7. The applicants subsequently applied for rectification under section 60(3)(b) of the Act within the period specified by section 60(6) of the Act.

15. In summary, taking all of the above into account I am satisfied that:-

- (a) the applicants for the rectification of the registration are the proprietors of a trade mark in Spain, which is a Convention country (see section 60(1) and section 55);
- (b) the respective trade marks are similar;
- (c) the current registered proprietors were the applicant's agents;
- (d) that the registered proprietors were aware of the origins of the trade mark they registered.

16. Therefore, I hold that the applicants for rectification are the rightful proprietors of trade mark registration No. 2169583. The trade mark register must therefore be rectified by the substitution of the name North Wind Yard SL, whose address is:

P° de Juan Borbon,
s/n Muelle de Levante,
Puerto be Barcelona 08039
Barcelona
Spain

for that of Fuller Developments Ltd, whose address is:

First Floor,
Motor House,
The Grange,
St Peter Port,
Guernsey
Channel Islands.

17. Having decided in favour of the applicants on the issue of rectification I do not need to go on to consider the alternative remedy requested in their statement of case, ie a declaration of invalidity.

18. In their statement of case the applicants requested an award of costs and as they have been successful in these proceedings they are entitled to a contribution towards their costs. Having regard to the circumstances of these proceedings; that the fee paid when launching these proceedings was associated only with the declaration of invalidity, that the proceedings were undefended, that this decision has been taken from the papers filed and not following a hearing, but that evidence has had to be filed by the applicants; I order the registered proprietor to pay the applicants the sum of £300. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 05 day of June 2001

M KNIGHT
Acting for the Registrar
The Comptroller General